

**CLERK'S COPY.**  
**TRANSCRIPT OF RECORD**

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**Supreme Court of the United States**

**OCTOBER TERM, 1938**

**No. 51**

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**ARMSTRONG PAINT AND VARNISH WORKS,  
PETITIONER,**

**vs.**

**NU-ENAMEL CORPORATION, AN ILLINOIS CORPO-  
RATION, AND NU-ENAMEL CORPORATION, A  
DELAWARE CORPORATION**

---

**ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT  
OF APPEALS FOR THE SEVENTH CIRCUIT**

---

**PETITION FOR CERTIORARI FILED MAY 12, 1938.**

**CERTIORARI GRANTED OCTOBER 10, 1938.**

IN THE

**Supreme Court of the United States**

OCTOBER TERM, A. D. 1937.

\_\_\_\_\_  
No. \_\_\_\_\_  
\_\_\_\_\_

**ARMSTRONG PAINT AND VARNISH WORKS,**

*Petitioner,*

*vs.*

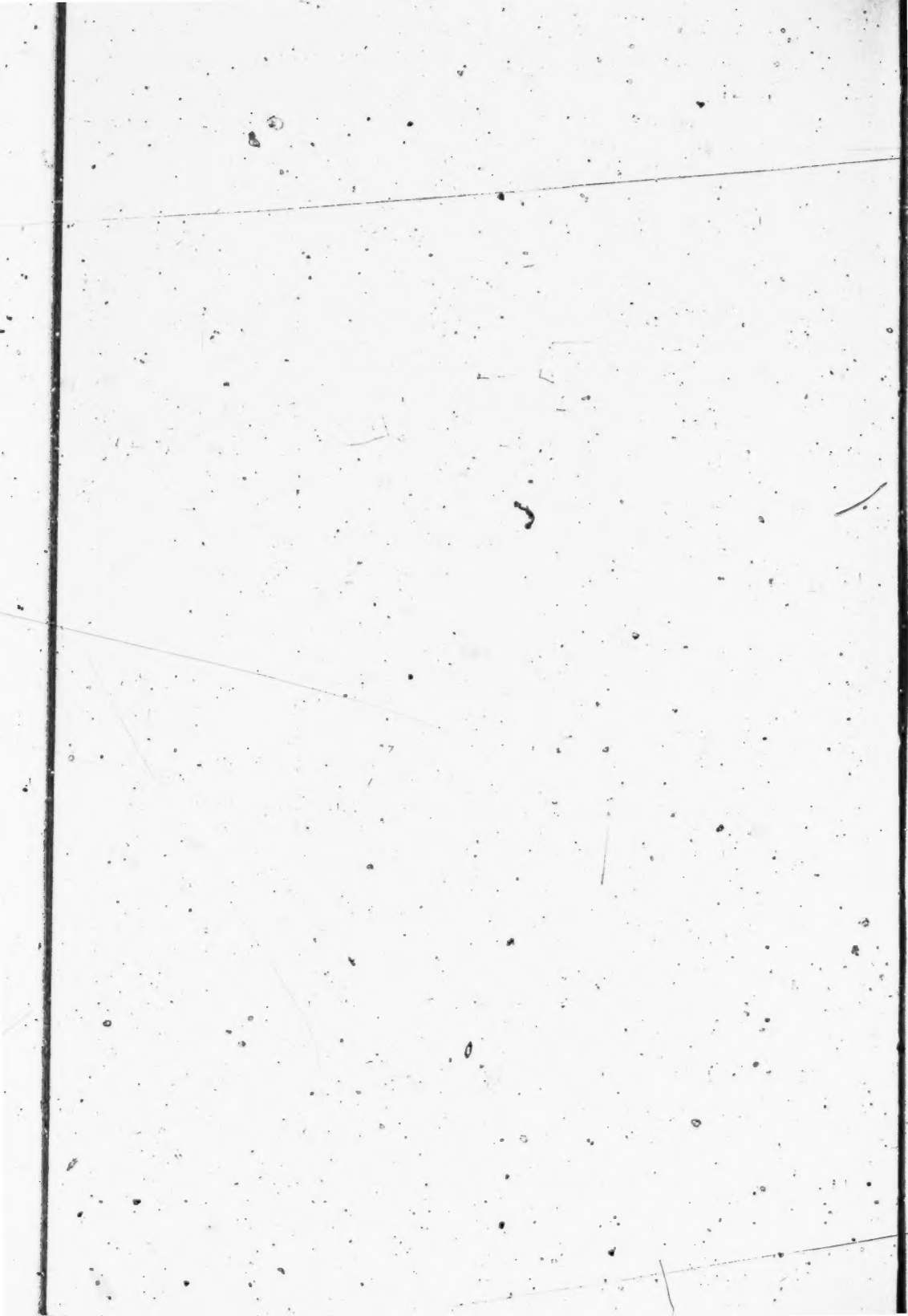
**NU-ENAMEL CORPORATION, PLAINTIFF, AND  
NU-ENAMEL CORPORATION, INTERVENER,**

*Respondents.*

\_\_\_\_\_  
ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES  
CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

\_\_\_\_\_  
**RECORD**  
\_\_\_\_\_





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TRANSCRIPT OF RECORD

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IN THE  
**United States Circuit Court of Appeals**  
**For the Seventh Circuit**

---

No. 6268

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NU-ENAMEL CORPORATION, PLAINTIFF, AND  
NU-ENAMEL CORPORATION, INTERVENER,

*Appellants,*

vs.

ARMSTRONG PAINT AND VARNISH WORKS,

*Appellee.*

*Counsel for Appellants:*

MR. EDWARD R. ROGERS,  
MR. WILLIAM T. WOODSON,  
MR. JAMES H. ROGERS,

*Counsel for Appellee:*

MR. MOSES LEVITAN,

Appeal from the District Court of the United States for the Northern District  
of Illinois, Eastern Division.

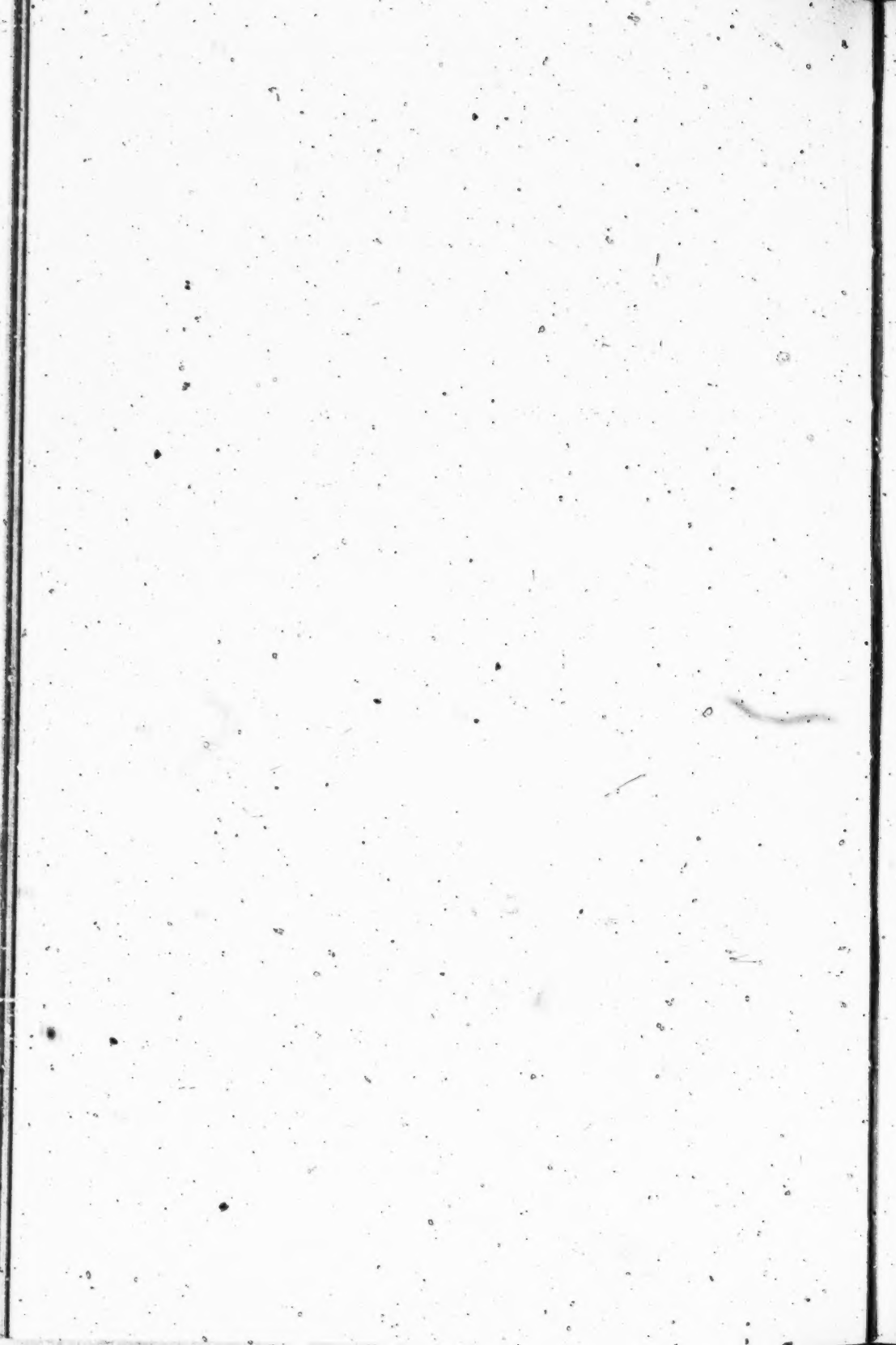
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TRANSCRIPT OF RECORD FILED MAY 13, 1937.

PRINTED RECORD

FILED

JUL 16 1937



IN THE  
**United States Circuit Court of Appeals**  
**For the Seventh Circuit**

---

**No. 6268**

---

**NU-ENAMEL CORPORATION, PLAINTIFF, AND**  
**NU-ENAMEL CORPORATION, INTERVENER,**

*Appellants,*

*vs.*

**ARMSTRONG PAINT AND VARNISH WORKS,**

*Appellee.*

*Counsel for Appellants:*

**MR. EDWARD S. ROGERS,**  
**MR. WILLIAM T. WOODSON,**  
**MR. JAMES H. ROGERS,**

*Counsel for Appellee:*

**MR. MOSES LEVITAN,**

---

**Appeal from the District Court of the United States for the Northern District**  
**of Illinois, Eastern Division.**





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Benson, K. Y. ....	107, 104
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1      Pleas in the District Court of the United States for the Northern District of Illinois, Eastern Division, begun and held at the United States Court Room, in the City of Chicago, in said District and Division, before the Honorable Charles E. Woodward, District Judge of the United States for the Northern District of Illinois, on sixteenth day of January, in the year of our Lord one thousand nine hundred and thirty-seven, being one of the days of the regular December Term of said Court, begun Monday, the 21st day of December, 1936, and of our Independence the 161st year. Placita.

Present:

Honorable Charles E. Woodward.

William H. McDonnell, U. S. Marshal.

Henry W. Freeman, Clerk.

IN THE DISTRICT COURT OF THE UNITED STATES,

Northern District of Illinois,

Eastern Division.

Nu-Enamel Corporation,  
*Plaintiff,*

and

Nu-Enamel Corporation,  
*Intervenor,**vs.*Armstrong Paint & Varnish  
Works,

No. 14284.

Be It Remembered, that the above-entitled action was commenced by the filing of the following Bill of Complaint, with exhibits attached, in the above-entitled cause in the office of the Clerk of the District Court of the United States for the Northern District of Illinois, Eastern Division, on this the 9th day of January, 1935.

IN THE UNITED STATES DISTRICT COURT.

\* \* (Caption—14284) \* \*

## BILL OF COMPLAINT.

To the Honorable Judges of Said Court in Chancery Sitting:

Plaintiff, Nu-Enamel Corporation, is a corporation organized and existing under and by virtue of the laws of the State of Illinois, with its principal office in Chicago, Illinois.

Defendant, Armstrong Paint & Varnish Works, is a corporation organized and existing under and by virtue of the laws of the State of Illinois, with its principal office in Chicago, Illinois, and is a resident and inhabitant of the Northern District of Illinois and the Eastern Division thereof.

This is a suit arising under the trade mark laws of the United States.

For its cause of action, plaintiff states:

1. Plaintiff is the successor of Nu-Enamel Paint Co. Inc. Plaintiff and its predecessor since 1922 have been engaged in

the business of selling paints, varnishes and floor wax under the trade mark "Nu-Enamel." The business of the plaintiff has grown from small beginnings in the year 1922 to a large and prosperous business. Plaintiff owns and operates throughout the United States and foreign countries more than three thousand (3,000) retail stores in which plaintiff's products are sold exclusively. Plaintiff's stores are operated under the name "Nu-Enamel" and plaintiff's said products under the trade-mark "Nu-Enamel" have been extensively advertised throughout the United States and foreign countries. A specimen of plaintiff's label on which its trade mark "Nu-Enamel" is displayed is filed herewith as PLAIN-  
4 TIFF'S EXHIBIT A.

2. Plaintiff's products have met with popular approval and as a result of plaintiff's extensive sales and advertising, the name "Nu-Enamel" has come to mean and is understood to mean, throughout the United States, including the State of Illinois and the City of Chicago, the plaintiff and plaintiff's products only and the word "Nu-Enamel" is a mark by which the goods of the plaintiff are distinguished from other goods of the same class.

3. Plaintiff, after due and proper proceedings in that behalf, duly registered its trade mark "Nu-Enamel" in the United States Patent Office on November 14, 1933, No. 308024. Said registration is valid and subsisting, uncanceled and unrevoked and plaintiff is the owner thereof. A certified copy of said registration is filed herewith as PLAINTIFF'S EX-  
HIBIT B.

4. Defendant, Armstrong Paint & Varnish Works, within the last few months, has put upon the market paints and varnishes which it sells under the designation "Nu-Beauty Enamel." A specimen of defendant's label on which the name "Nu-Beauty Enamel" is displayed is filed herewith as  
PLAIN-  
TIF-  
F'S EXHIBIT C.

5. Plaintiff is informed and believes and states the fact to be that defendant adopted the name "Nu-Beauty Enamel" as a trade mark for its products, with full knowledge of the prior and extensive use by plaintiff of the trade mark "Nu-Enamel."

6. As a result of defendant's use on its goods of the colorable imitation, "Nu-Beauty Enamel," of plaintiff's registered trade mark "Nu-Enamel" retail merchants are enabled to and do substitute and pass off defendant's products bearing the name "Nu-Beauty Enamel" as and for the products of the plaintiff.

*Bill of Complaint.*

7. Plaintiff alleges that the name "Nu-Beauty Enamel" is a colorable imitation of plaintiff's registered trade mark "Nu-Enamel" and is an infringement thereof, and unless restrained by this court that defendant will continue to infringe plaintiff's registered trade mark to plaintiff's irreparable injury.

8. Plaintiff's products bearing the trade mark "Nu-Enamel" are sold in interstate commerce and plaintiff is informed and believes and states the fact to be that defendant's products bearing the name "Nu-Beauty Enamel" are sold in interstate commerce; that defendant's use of the designation "Nu-Beauty Enamel" is without the license or consent of the plaintiff and that the goods of the defendant are of the same descriptive properties as those set forth in plaintiff's registration.

Plaintiff therefore prays:

1. That the defendant may be required to answer this bill of complaint but not under oath, answer under oath being hereby waived.

2. That defendant, its agents, servants, employees, privies, successors and assigns, and all holding by, through or under it, may be at first during the pendency of this suit and afterwards, perpetually enjoined and restrained:

(a) From using in the sale of paints and varnishes, or similar goods, the words "Nu-Beauty Enamel" or any name including the words "Nu-Enamel" or any other colorable imitation of plaintiff's registered trade mark "Nu-Enamel."

(b) From otherwise infringing plaintiff's registered trade mark.

3. That the defendant may be required to account to the plaintiff for all profits realized by it from the sale of products bearing the name "Nu-Beauty Enamel" and for all damages sustained by plaintiff on account of the infringement aforesaid and plaintiff prays that said damages may be trebled.

4. That the defendant have and recover from the defendant the costs of this suit, and that plaintiff have such other and further relief as to the court may seem equitable.

5. Plaintiff prays the usual process of this court directed to the defendant, Armstrong Paint & Varnish Works, 1330 South Kilbourn Avenue, Chicago, Illinois, requiring it to be and appear before this Honorable Court on a day certain



*Bill of Complaint.*

5

therein named, to answer this bill of complaint and abide the further order of the court.

Nu-Enamel Corporation,  
By C. L. Lloyd,  
*President.*

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,  
*Solicitors for Plaintiff.*

7 State of Illinois }  
County of Cook } ss.

Charles L. Lloyd, being duly sworn on oath, deposes and says:

I am President of the Nu-Enamel Corporation, the plaintiff herein and make this verification in behalf of the plaintiff. I have read the above and foregoing bill of complaint and know the contents thereof and the same is true of my own knowledge, except as to the matters therein stated to be alleged upon information and belief and as to those matters I believe it to be true.

C. L. Lloyd.

Subscribed and sworn to before me this 21st day of December, 1934.

(Seal)

Howard L. Lampa,  
*Notary Public.*



enables - Nu-Enamel is the very best for automobiles that it is possible to apply. It is prepared especially for the automotive market for the inexperienced to obtain results by following a few simple rules.

Use and Kitchen - Nu-Enamel will give a service in these rooms. It can be washed clean, although usually just a damp cloth in it. Nu-Enamel withstands steam, acid and cleaning powders, brine, etc.

Use - Just one coat of Nu-Enamel over paint will transform the worn-out piece to sparkling addition to your room. It will stand hot pans, and will not stain from fruit or other beverages.

Nu-Enamel is an ideal finish for boats, for cracks, chips, or peels under wood or expansion. Clear Nu-Enamel is ideal for wood or metal surfaces.

ONE HUNDRED U. S. MEAS.  
"THE COAT OF ENDURING BEAUTY"

## NU-ENAMEL



**Nu-Enamel Corporation**  
CHICAGO, U.S.A.

### DIRECTIONS

Do not remove the old paint, unless it is cracked, chipped, or in very bad condition.

Sandpaper the surface smooth with Nu-Enamel 400 wet-dry sandpaper. Wash thoroughly with Nu-Enamel THINER to remove all grease, oil, wax, etc. Use a good grade tooth brush. Rubbing it in Nu-Enamel THINER. Shake the can before using in Enamel. Do not wipe brush on a rag as it will pick up lint.

### DO NOT SHAKE

To remove all dirt, dust and grit, wipe surface with Nu-Enamel TAG-BAG just before painting. Brush the surface in heavily with entire section of brush being painted. It is covered. The edge of the brush is the top of the can and go back over painted surface with a horizontal stroke, picking up all excess enamel. If possible, brush with vertical stroke downward-sweeping stroke with a horizontal stroke on a vertical surface. Do not brush any more than is necessary.

If the surface being painted is very rough, use THINER or a special primer. Nu-Enamel THINER THINER is suitable as an undercoat.

THE first step in the process of planting is the selection of the site. The site should be chosen on the basis of the soil, the climate, and the availability of water. The soil should be fertile and well-drained. The climate should be suitable for the growth of the plant. The availability of water should be sufficient to meet the needs of the plant.

THE second step in the process of planting is the preparation of the soil. The soil should be plowed and then harrowed. The plowing should be done in the fall, and the harrowing should be done in the spring. The soil should be kept free of weeds and other unwanted plants.

THE third step in the process of planting is the selection of the seed. The seed should be chosen on the basis of the soil, the climate, and the availability of water. The seed should be fertile and well-drained. The climate should be suitable for the growth of the plant. The availability of water should be sufficient to meet the needs of the plant.

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Registered Nov. 14, 1933

Trade-Mark 308,024

# UNITED STATES PATENT OFFICE

Nu-Enamel Corporation, Chicago, Ill.

Act of March 19, 1920

Application July 29, 1933. Serial No. 340,333

## NU-ENAMEL

### STATEMENT

The Commissioner of Patents:

Nu-Enamel Corporation, a corporation duly organized under the laws of the State of Illinois, having its principal place of business at South Clark Street, Chicago, Illinois, has created and used the trade-mark shown in the accompanying drawing, for MIXED PAINTS, VARNISHES, PAINT ENAMELS, PREPARED LACQUERS, STAINS, LACQUERS, LIQUID CREAM FURNITURE POLISHES, AND COLORS GROUND IN OIL, in Class 16, Paints and Varnishes' materials, and presents herewith five specimens showing the trade-mark as actually used by the applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of March 19, 1920.

The trade-mark has been continuously used and applied to the said mixed paints, varnishes, enamels, stains, lacquers, and colors ground in oil since March, 1925, on liquid cream furniture polishes since August 1, 1928, and on prepared shellacs since November 1, 1929.

The trade-mark is applied or affixed to the goods by printing the mark upon the containers of the goods.

The applicant is the owner of the trade-mark

registered by Charles L. Lloyd, doing business as Nu-Enamel Paint Company, of Dallas, Texas; No. 225,101, dated March 8, 1927, and succeeded by The Nu-Enamel Paint Company, a corporation duly incorporated under the laws of Texas, applicant having succeeded the said predecessors and acquired all of their respective trade-marks and good will.

The mark has been in bona fide use for not less than one year in interstate commerce by the applicant and its predecessors in business, Charles L. Lloyd, doing business as Nu-Enamel Paint Company, of Dallas, Texas, and Nu-Enamel Paint Company of Texas, a corporation, duly incorporated under the laws of Texas.

The undersigned hereby appoints Joshua R. H. Potts, whose post-office address is 160 North LaSalle Street, city of Chicago, State of Illinois, its attorney, to prosecute this application for registration, with full powers of substitution and revocation, to make alterations and amendments therein, to receive the certificate, and to transact all business in the Patent Office connected therewith.

NU-ENAMEL CORPORATION,  
By CHAS. L. LLOYD,  
Its President.

Exhibit 2

Received Nov 14 1933

# UNITED STATES PATENT OFFICE

Patented November 14, 1933

Serial No. 1,111,111

Inventor: [Name]

NUBAMET

STATEMENT

1. This invention relates to a method of...  
2. The method of the present invention...  
3. The method of the present invention...  
4. The method of the present invention...  
5. The method of the present invention...  
6. The method of the present invention...  
7. The method of the present invention...  
8. The method of the present invention...  
9. The method of the present invention...  
10. The method of the present invention...



# Plaintiff's Exhibit C

**No. 841**  
**BLACK**  
 3% Carbon Black  
 93% Spar Varnish  
 100%

**STIR THOROUGHLY  
 FOR FIVE MINUTES  
 USE A NEW BRUSH  
 Do Not Shake Can**

**NET CONTENTS**      **DIRECTIONS**      **QUARTER PINT**

**PAINTED SURFACES** — Sandpaper the old finish first with No. 1 Sandpaper until the glass is removed, then with No. 00 Sandpaper until smooth. Wipe off all dust up over with No. 1000 Very Fine Cloth and apply Nu-Beady Spar Varnish. Repeat. If the old finish is extremely dark and the new color much lighter, a coat of Nu-Beady Undercoat should be applied before the primer and sanded smooth when dry.

**UNPAINTED SURFACES** — Sand smooth, dust, apply one coat Nu-Beady Undercoat. When thoroughly dry, sand with No. 00 Sandpaper so over with Nu-Beady Put-Up Cloth and apply Nu-Beady Enamel.

Be sure to get folds of string. Detailed Directions and Read is Carefully

**ARMSTRONG PAINT & VARNISH WORKS CHICAGO**

Plaintiff's Exhibit 3

PLAINTIFF'S EXHIBIT 3

PLAINTIFF'S EXHIBIT 3

PLAINTIFF'S EXHIBIT 3

13 And on, to wit, the 13th day of July, 1936, came the Defendant by its attorneys and filed in the Clerk's office of said Court its certain Amended Answer to Bill of Complaint, with Exhibit "A" attached, in words and figures following, to wit:

Filed July 1936.

14 IN THE DISTRICT COURT OF THE UNITED STATES.

\* \* \* (Caption—14284) \* \* \*

THE AMENDED ANSWER OF ARMSTRONG PAINT & VARNISH WORKS TO THE BILL OF COMPLAINT OF NU-ENAMEL CORPORATION.

Defendant, Armstrong Paint & Varnish Works, a corporation, pursuant to leave of court heretofore granted, files herewith its amended answer to the bill of complaint of Nu-Enamel Corporation.

(1) Defendant has no knowledge as to whether or not plaintiff is the successor of Nu-Enamel Paint Co., Inc., or that plaintiff and its predecessors since 1922 have been engaged in the business of selling paint, varnish and floor wax under the trade-mark "Nu-Enamel", or that the business of the plaintiff has grown from small beginnings in the year 1922 to a large and prosperous business, as set forth in Paragraph 1 of said bill of complaint, and defendant demands strict proof thereof.

Defendant denies that plaintiff owns and operates throughout the United States and foreign countries more than three thousand (3,000) retail stores, in which plaintiff's products are sold exclusively, as set out in Paragraph 1 of said bill of complaint. Defendant has no knowledge that plaintiff's stores are operated under the name "Nu-Enamel".

15 and that plaintiff's said products under the name of "Nu-Enamel" have been extensively advertised throughout the United States and foreign countries, as set out in Paragraph 1, and demands strict proof thereof.

(2) Defendant admits that the name "Nu-Enamel" has come to mean and is understood to mean, throughout the United States, including the State of Illinois and the City of Chicago, the plaintiff and plaintiff's products only and the word "Nu-Enamel" is a mark by which the goods of the plaintiff are distinguished from other goods of the same class.

(3) Defendant admits that plaintiff registered its trade-

mark "Nu-Enamel" in the United States Patent Office on November 14, 1933 as No. 308024. Defendant denies that said registration of the alleged trade-mark "Nu-Enamel" is valid and subsisting, and denies that the plaintiff is the owner of a valid and subsisting trade-mark "Nu-Enamel," as set out in paragraph 3 of the bill of complaint.

Further answering, defendant states that "Nu-Enamel" is a phonetic misspelling of the descriptive and generic term "New-Enamel"; that under and by virtue of the trade-mark laws of the United States of America, said term "Nu-Enamel" as applied to enamel and kindred products cannot lawfully and validly be the subject of an appropriation as a trade-mark, and that, therefore, the registration by the plaintiff of its alleged trade-name "Nu-Enamel" is of no force and effect, and plaintiff did not thereby, under the laws of the United States of America, acquire a valid trade-mark in the words "Nu-Enamel."

(4) Defendant denies that within the last few months prior to the filing of the bill of complaint herein it had put on the market paints and varnishes which sold under the designation of "Nu-Beauty Enamel", but defendant states that it had put on the market enamels only which it sold under the designation of "Nu-Beauty Enamel" with the label substantially as filed with the bill of complaint as plaintiff's "Exhibit C."

(5) Defendant denies that it adopted the name "Nu-Beauty Enamel" as a trade-mark for its products with full knowledge of the prior and extensive use by the plaintiff of the alleged trade-mark "Nu-Enamel"; that on the contrary, defendant states that it adopted and conceived the name "Nu-Beauty" in connection with enamel and kindred products many years prior to the filing of the bill of complaint herein and long before it had heard of the alleged trade-mark or trade-name "Nu-Enamel" or the products of the Nu-Enamel Co.

(6) Defendant denies that "Nu-Beauty Enamel" is a colorable imitation of "Nu-Enamel" and defendant denies that by defendant's use of "Nu-Beauty Enamel," retail merchants are enabled to, and did or do substitute and pass off defendant's products bearing the name "Nu-Beauty Enamel" as and for the products of the plaintiff, is set out in Paragraph 6 of the bill of complaint.

(7) Further answering, defendant states that "Nu-Enamel" is a phonetic misspelling of "New-Enamel"; that

said term "Nu-Enamel" is a generic and descriptive term by which enamel and other kindred products in the paint and lacquer line may properly be described where said enamel or kindred product in the paint and lacquer line is a new kind of enamel or kindred product, or an improved type of enamel or kindred product; that by reason of the generic quality of the term, "Nu-Enamel," as applied to enamel and kindred products, plaintiff could not and cannot appropriate unto

itself the exclusive right to the use of the words "Nu" for  
17 "New" in connection with the word "Enamel" nor prevent others from rightfully describing their product with the words "Nu" either with the word "Enamel" or with other words used in conjunction therewith.

(8) Defendant admits the allegations set forth in Paragraph 8 of the bill of complaint.

(9) Further answering, defendant states that in the year 1922 and for many years prior thereto, the word "Nu" was, throughout the United States, used together with other words, either hyphenated or otherwise, to designate and describe different brands of enamels, paints, varnishes and kindred products; that the said word "Nu" since 1922 and prior thereto has been and now is used extensively throughout the United States in describing and designating brands of paints, varnishes, enamels and kindred products, and in each of said instances the word "Nu" has been and now is used as a phonetic spelling of the word "New"; the particulars as to which are set forth and listed in the bill of particulars heretofore filed herein, and by reference specifically made a part hereof; that the word "Nu" as used by the plaintiff in connection with its alleged trade-mark or trade-name "Nu-Enamel" was adopted by the plaintiff and is now used by the plaintiff to designate the word "New"; that the adoption by the plaintiff of the alleged trade-mark, trade-name or brand "Nu-Enamel" did not constitute a novelty or innovation in the enamel, paint and varnish industry.

(10) Further answering, defendant states that the plaintiff is not entitled to any relief in this, a court of equity, for the reason, among others, that plaintiff comes into this court with unclean hands. Defendant states that the plaintiff's label, Exhibit A, attached to the bill of complaint, appears,

and at the time of the filing of the bill of complaint ap-  
18 peared on all of the products sold by the plaintiff; that said label bears upon it the statement, prominently and boldly printed, that "one coat covers"; that said statement



"one coat covers" is a representation to the public and to prospective purchasers and consumers of "Nu-Enamel" products that under all circumstances and as to all colors of said "Nu-Enamel" products, on the cans of which said label is attached, it is not necessary for the person using said "Nu-Enamel" products to apply more than one coat of same and that one coat of said "Nu-Enamel" products will completely cover the surface to which it is applied without the necessity of any additional coat or coats. Defendant states that the statement "one coat covers" is a fraudulent misrepresentation to the public and to purchasers and consumers of said "Nu-Enamel" products, to which said label is attached, for the reason that, under many circumstances and as to many colors and tints of said "Nu-Enamel" products, it is not a fact nor is it true that one coat will completely or adequately cover the surface to which it is applied or that only one coat of said Nu-Enamel product is necessary; that said facts are known to the plaintiff.

(11) Further answering, this defendant denies that this court has any jurisdiction over the subject-matter set forth in the said bill of complaint.

(12) Defendant, praying under this answer all advantage to which it would be entitled upon a motion to dismiss, denies the right of plaintiff to any of the relief prayed for in said bill of complaint or to any relief herein whatsoever, and prays that said bill be dismissed with plaintiff's costs.

Armstrong Paint & Varnish Works,  
By Mitchel Goldsmith,

*Pres.*

Moses Levitan,  
Harry H. Krinsky and  
James J. Glassner,  
*Solicitors for Defendant.*



## "EXHIBIT A."

Attached to amendment to answer of  
Armstrong Paint & Varnish Works.

Nu-Cement: First use stated July 2, 1934 by Technical Finishes Corp., Chicago, Illinois.

Nu-Craft: For Enamel, by J. E. Harris Co., Wooster, Ohio.

Nu-Glo: First use stated 1934, by Indianapolis Varnish & Paint Co., Indianapolis, Indiana.

Nu-Life: First use stated February 18, 1932, by The Lehon Co., Chicago, Illinois.

Nu Process: First use stated December 1, 1934, by Impervious Paint & Varnish Co., Philadelphia, Pa.

Nu-Var-Co: First use stated January 23, 1934, by Scriver & Quinn, Inc., Los Angeles, Calif.

Nufin: First use stated September 30, 1935, by Roy Elwood Roth, doing business as Roth & White, Lancaster, Pa.

Nulaco Brand: First use stated May 4, 1933 by Nudeal Laboratories Co. Inc., New Paltz, N. Y.

Nuodite: First use stated April 10, 1935, by Nuodex Products, Inc., Elizabeth, N. J.

Nu-Agen: First use stated April 1, 1919, by Benjamin H. Arnheim, Pittsburgh, Pa.

Nubelac: First use stated October 7, 1924, by Nubian Paint & Varnish Co., Chicago, Ill.

Nubian: First use stated May 16, 1906, by Binney & Smith Co., New York, N. Y.

Nu-Blac: First use stated about 1916, by Atlantic Varnish Works, Inc., Richmond Va.

Nubrite: First use stated September 1, 1914, by Nubrite Mfg. Co., St. Louis, Mo.

Nucarto: First use stated January 1, 1918, for automobile paint, by Wheeler Varnish Works, Chicago, Illinois.

Nu-Clean: First use stated June 11, 1929, by Nu-Enamel Paint Co. Inc., Dallas, Texas.

Nu-Da: First use stated April 10, 1928, by Indianapolis Paint & Color Co., Indianapolis, Indiana.

Nudene: First use stated January 1, 1934 by Schorn Paint Mfg. Co., Seattle, Wash.

Nueco: First use stated July, 1920, by Foy Paint Co. Inc., Cincinnati, Ohio.

20 Nu-E-Co: First use stated 1915 by The Foy Paint Co., Cincinnati, Ohio.

Nu-Element: First use stated March 1932, by Mathews Paint Co. Inc., Los Angeles, Calif.

Nu-Era: By Louisville Finishing Products Co., Louisville, Ky.

Nu-Fender: First use stated October, 1925, by Burnett Chemical Co., Los Angeles, Calif.

Nu Finish: First use stated 1923, by Utley Paint Co. Inc., New Orleans, La.

Nu-Flat: First use stated May 20, 1926 by Phelan-Faust Paint Mfg. Co., St. Louis, Missouri.

Nu-Flor: First use stated January 1, 1921, by Tanner Paint & Oil Co., Richmond, Va.

Nu-Floor: By A. C. Horn Co., Long Island City, N. Y.

Nu-Flor: First use stated October 1, 1906, by Hockaday Co., Chicago, Ill.

Nu-Floren: First use stated 1920, by Tanner Paint & Oil Co. Inc., Richmond, Va.

Nu-Fun: First use stated March, 1929, by Progress Varnish Co., Inc., Louisville, Ky.

Nu-Glaze: First use stated September 21, 1929, by The Glidden Co., Cleveland, Ohio.

Nuglo: First use stated July 1909, by Harrr H. Juelg, New York, N. Y.

Nu-Glos: By Atlantic Varnish Works, Richmond, Va.

Nu-Gloss: First use stated 1914, by Lampton, Crane & Ramey, Louisville, Ky.

Nu-Gloss: First use stated December 17, 1923 by Nu-Gloss Auto Painting System, Kansas City, Mo.

Nugloss: First use stated January 1, 1906 by The R. M. Hollinghead Co., Camden, N. J.

Nu-House: First use stated October 2, 1931, by Atwater Paint Co., Los Angeles, Calif.

Nu-Iron: First use stated June 1, 1914, by Nu-Iron Mfg. Co., York, Pa.

Nu-O-Lac: First use stated November 15, 1921, by Glidden Co., Cleveland, Ohio.

Nukal: First use stated February 1906, by Rexora Mfg. Co., Detroit, Michigan.

21 Nukalite: Rexora Mfg. Co., Detroit, Mich.

Nu-Kar: First use stated February 24, 1922, by Dean & Barry, Columbus, Ohio.

- Nu-Kitchen: First use stated October, 1925, by Burnett Chemical Co., Los Angeles, Calif.
- Nu-Kolor-Di: First use stated January 15, 1919, by Peaslee-Gaulbert Co. Inc., Louisville, Ky.
- Nukôte: First use stated January 10, 1905, by Pratt & Lambert, Buffalo, N. Y.
- Nulac: First use stated May 1, 1914, by Sillers Paint & Varnish Co., Los Angeles, Calif.
- Nu-Lac: First use stated 1923, by Norfolk Paint & Varnish Co., Atlantic, Mass.
- Nu-Lac: First use stated March 1, 1920 by The Nu-Lac Co., Fort Wayne, Indiana.
- Nu Lac: Sta-Bright Manufacturing Co., Chicago, Ill.
- Nulco Commercial: The National Pigments & Chemical Co., St. Louis, Mo.
- Nulco Extra Gliders: The National Pigment & Chemical Co., St. Louis, Mo.
- Nulco Primer: The National Pigment & Chemical Co., St. Louis, Mo.
- Nu-Leather: First use stated September, 1920, by The Morgan Co., Peoria, Illinois.
- Nulife: First use stated since 1915, by Mutual Paint Mfg. Co., St. Louis, Missouri.
- Nulife: (with design) First use stated April 1, 1914 by Nulife Products Co., Titusville, Pa.
- Nu-Like: First use stated December 1, 1919, by Asper-Martin Co., Sioux City, Iowa.
- Nu-Lino Leum: First use stated October 1925 by Burnett Chemical Co., Los Angeles, Calif.
- Nu-Lite: First use stated 1928, by Paint Engineers, Inc., Chicago, Illinois.
- Nu-Lite: First use stated April, 1929, by North Jersey Paint Co., Wallington, N. J.
- NuLustre: First use stated December 1, 1912, by Boston Varnish Co., Boston, Mass.
- Nu-Lustre: First use stated December 2, 1923 by Nu-Lustre Products Co., Inc., New Orleans, La.
- Nu-Lyk: First use stated June 15, 1904, by Inland White Lead Co., Chicago, Ill.
- 22 Nu-Namel: First use stated November 20, 1924 by Utley Paint Co. Inc., New Orleans, La.
- Nuodex: First use stated May 13, 1932, by Nuodex Products Co. Inc., Newark, N. J.

Nu-O-Leum: First use stated June 20, 1934 by The A. Wilhelm Co., Reading, Pa.

Nu Paint: First use stated April, 1925, by Utley Paint Co., Inc., New Orleans, La.

Nupam: By Progress Paint Mfg. Co., Louisville, Ky.

Nu-Paste: First use stated 1933, by Foy Paint Co. Inc., Cincinnati, Ohio.

Nu Pigment: By Sampson Paint & Color Co., Richmond, Va.

Nu-Pigment: First use stated 1926, by Progress Paint Mfg. Co., Louisville, Ky.

Nupro: First use stated April, 1917, by New Process Chemical Co., Inc., New York, N. Y.

Nu-Ra: First use stated May 17, 1932, by Nu-Ray Waxcoat Corporation, Brooklyn, N. Y.

Nu-Ray: First use stated May 1, 1919, by Nu-Ray Polish Mfg. Co., Provo, Utah.

Nu-Rex: First use stated July 1, 1928 by Nu-Rex Products Co., Milwaukee, Wisc.

Nurinkle: First use stated 1909, by R. F. Johnston Co., Cincinnati, Ohio.

Nu-Roof: First use stated October 1, 1930 by Burnett Chemical Co., Los Angeles, Calif.

Nuroff: The Acorn Refining Co., Cleveland, Ohio.

Nuroof: First use stated 1916, by The Star Paint & Varnish Co., Cleveland, Ohio.

Nu-rufe: First use stated 1923, by Pensacola Paint & Chemical Co., Pensacola, Fla.

Nuseal: First use stated January 1, 1931 by McCloskey Varnish Co., Philadelphia, Pa.

Nushine: First use stated July 1, 1905, by Dozier & Gay Paint Co., Jacksonville, Fla.

Nu-Shine: (with picture of sun and the phrase "it has never checked yet"): First use stated January 1, 1915, by Frank P. Smith, Huntington, Ind.

Nu Shyne Sope Olish: First use stated September 1, 1921 by Nu-Shyne Sope-Olish Co., Philadelphia, Pa.

Nu-Sink (with design): First use stated June 1, 1914 by Charles C. Burnett, Los Angeles, Calif.

23 Nu-Skin: First use stated August 10, 1924 by Standard Finish Co., Los Angeles, Calif.

Nu-Spede: First use stated April 24, 1929 by Lowe Brothers Co., Dayton, Ohio.

- Nuspirits: First use stated 1916 by John Briggs & Co., Boston, Mass.
- NuStuff: First use stated January 8, 1912 by Benjamin Lauber, Chicago, Illinois.
- Nu-Style: First use stated February 4, 1929 by Stille-Young Corp., Chicago, Ill.
- Nu-Su: First use stated August 14, 1928, by Nu-Su Products Co., Denver, Colo.
- Nu Sun: First use stated March 2, 1927, by Nu Sun Co., Wilson Dam, Ala.
- Nusurface: By The Acorn Refining Co., Cleveland, Ohio.
- Nursurface H. R. Black: By The Acorn Refining Co., Cleveland, Ohio.
- Nu-Surfas: First use stated February 1, 1933, by C. C. Chartier, Chicago, Illinois.
- Nu-Tex: First use stated January 15, 1931 by Indianapolis Paint & Color Co., Indianapolis, Ind.
- Nu-Tex: First use stated December 10, 1926, by McLaren Sawyer, St. Louis, Mo.
- Nu-Thot: First use stated May 1, 1920 by The Mountain States Rubber Co., Denver, Colo.
- Nu Tint: First use stated March 1, 1928 by California Paint Co., Oakland, Calif.
- Nu-Tona: By W. W. Lawrence & Co., Pittsburgh, Pa.
- Nu-Top: First use stated March 1, 1934 by Peninsular Paint & Varnish Co., Detroit, Michigan.
- Nu-Trim: First use stated June 6, 1933, by Stanco, Inc., Wilmington, Del.
- Nu-Tro-Fil: First use stated July 21, 1929 by Continental Chemical Corp., Watseka, Ill.
- Nu Turps: First use stated January 16, 1907 by The Chas. H. Moore Oil Co., Cincinnati, Ohio.
- Nuvalu: First use stated April 15, 1926 by The Stille-Young Corp., Chicago, Ill.
- Nuvar: First use stated May 15, 1921, by The Gilbert Spruance Co., Philadelphia, Pa.
- 24 Nu Var: First use stated April 1, 1924, by Parlett Varnish Co., Inc., Baltimore, Md.
- Nu-Vernis: First use stated 1924, by Hilo Varnish Corp., Brooklyn, N. Y.
- Nuvogue: First use stated December 18, 1908, by The Tripod Paint Co., Atlanta, Ga.
- Nuwal: First use stated January 1911, by R. F. Johnston Co., Cincinnati, Ohio.



Nuwal Magic Gloss: First use stated January 1914, by R. F. Johnston Co., Cincinnati, Ohio.

NuWax: First use stated March 3, 1931 by Felco Products & Mfg. Co., New York, N. Y.

Nu-Way: First use stated January 1925, by Mutual Paint Mfg. Co., St. Louis, Mo.

Nuway: First use stated October 6, 1924 by the Nuway Mfg. Co., Long Island City, N. Y.

Nuway-Finish: First use stated March 9, 1925 by White Paint Co., St. Louis, Missouri.

Nu-Wheel: First use stated October 1925 by Burnett Chemical Co., Los Angeles, Calif.

Nuwrite: By Benjamin Moore & Co., Chicago, Ill.

Nu-Wood: First use stated 1926, by Devoe & Reynolds Co. Inc., New York, N. Y.

Jan. 11,  
7.

25 And on, to wit, the 11th day of January, 1937, came the Intervenor by its attorneys and filed in the Clerk's office of said Court its certain Petition for Leave to Intervene, in words and figures following, to wit:

26 IN THE DISTRICT COURT OF THE UNITED STATES.  
\* \* (Caption—14284) \* \*

PETITION BY NU-ENAMEL CORPORATION OF DELAWARE FOR LEAVE TO INTERVENE IN THE ABOVE ENTITLED SUIT.

To the Honorable Judges of said Court in Chancery Sitting:  
Nu-Enamel Corporation, your petitioner, respectfully alleges and shows as follows:

1. Said petitioner was incorporated under the laws of the State of Delaware on March 8, 1935, and is a resident and inhabitant of said State, with its principal business office in Cleveland, Ohio.

2. The above entitled cause was commenced in this Court on January 9, 1935, by the filing of a bill of complaint, by Nu-Enamel Corporation of Illinois. The writ of subpoena was served on the defendant herein on January 17, 1935. Defendant filed a motion to dismiss the bill of complaint on January 22, 1935. Said motion was granted by this Court on February 2, 1935. Thereupon the plaintiff filed, on April 11, 1935,



an appeal to the United States Court of Appeals for the Seventh Circuit, and on February 17, 1936, said order granting defendant's motion to dismiss was set aside and the cause remanded to this Court, directing that the bill of complaint be reinstated. Defendant filed its answer on March 13, 1936, and on April 30, 1936, filed its amended answer.

3. Plaintiff, at the time of the filing of the bill of complaint, was engaged in the business of selling paints, varnishes and floor wax under the trade-name "Nu-Enamel," and had registered said trade-mark in the United States Patent Office on November 14, 1933, number 308,024. The defendant, subsequent to the use and registration of the trade-mark "Nu-Enamel" by plaintiff, adopted and began to use the name "Nu-Beauty Enamel" as a trade-mark for products similar to those of plaintiff's. Plaintiff alleged that the words "Nu-Beauty Enamel" were a colorable imitation of plaintiff's registered trade-mark "Nu-Enamel" and an infringement thereof, and filed the aforesaid bill to enjoin the defendant from using in the sale of paints and varnishes, or similar goods, the words "Nu-Beauty Enamel" or any other colorable imitation of plaintiff's trade-mark "Nu-Enamel."

4. Petitioner has an interest in the litigation in the above entitled cause against the defendant herein, arising out of the facts that subsequent to the filing of the original bill herein on January 9, 1935, the plaintiff herein, on or about March 30, 1935, sold its property, assets, business and good will, including the trade-mark "Nu-Enamel" and the registration thereof to your petitioner, and your petitioner is now the owner of and in possession of said property and is carrying on the business formerly conducted by the plaintiff, and petitioner is now the owner of the trade-mark "Nu-Enamel."

28 5. The interest of your petitioner in the above entitled cause is such that its intervention in this cause is necessary to the protection of its interests, as alleged in the attached bill of intervention.

6. The reason why the petitioner has not hitherto applied for leave to intervene is that plaintiff's counsel in the cause was unaware of the fact, until a very recent date, that plaintiff had sold, assigned and transferred to the petitioner its business, assets and trade-marks, as set out in the amended bill of intervention.

7. On or about March 30, 1935, plaintiff, Nu-Enamel Corporation of Illinois, changed its corporate name to Enameline

Products Corporation; its charter remains otherwise unchanged.

8. Wherefore, petitioner prays that this Court make an order granting it leave to file the attached bill of intervention herein against Armstrong Paint & Varnish Works, and for such other and further relief as to this Court seems just and equitable.

Nu-Enamel Corporation,  
By C. L. Lloyd,

*President.*

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,

*Attorneys for Plaintiff.*

29 State of Illinois, { ss.  
County of Cook. }

C. L. Lloyd, being duly sworn, deposes and says:  
I am President of Nu-Enamel Corporation, petitioner herein, which is a Delaware corporation. I have read the above and foregoing petition and know the contents thereof, and the same is true of my own knowledge, except as to the matters therein to be alleged upon information and belief, and as to those matters I believe it to be true.

C. L. Lloyd.

Subscribed and sworn to before me this 11th day of January, 1937.

(Seal)

Mildred E. Peckham,  
*Notary Public.*

My commission expires May 25, 1938.

30 And afterwards, to wit, on the 11th day of January, 1937, being one of the days of the regular December term of said Court, in the record of proceedings thereof, in said entitled cause, before the Honorable Charles E. Woodward District Judge appears the following entry, to wit:

*Abstract of Testimony.*

25

31 IN THE DISTRICT COURT OF THE UNITED STATES.  
\* \* (Caption—14284) \* \*

Entered Jan  
1937.

ORDER.

This Cause coming on to be heard upon the petition of the Nu-Enamel Corporation of Delaware, for leave to intervene in the above entitled cause, and the Court having read said petition and having heard the arguments thereon,

It Is Hereby Ordered that said petitioner, the Nu-Enamel Corporation of Delaware, be granted leave to intervene in the above entitled cause and assert any and all such rights as it may have under the law.

Enter:

Charles E. Woodward,

*Judge.*

Dated January 11, 1937.

68 And on, to wit, the 3rd day of May, 1937, came the Plaintiff and Intervenor by their attorneys and filed in the Clerk's office of said Court their certain Abstract of the Testimony, in words and figures following, to wit:

Filed May  
1937.

69 IN THE UNITED STATES DISTRICT COURT.  
\* \* (Caption—14284) \* \*

ABSTRACT OF THE TESTIMONY.

Filed May 3, 1937. Henry W. Freeman, Clerk.

70 C. L. LLOYD, Cleveland, Ohio, President of Nu-Enamel Corporation, the intervenor and Enameline Products Corporation, the original plaintiff, testified as follows:

*Direct Examination.*

Nu-Enamel Corporation is a corporation of Delaware. Enameline Products Corporation, is a corporation of Illinois. The Nu-Enamel Corporation of Illinois changed its name to Enameline Products Corporation in March, 1935. The business of the Nu-Enamel Corporation is the manufacture and

sale of paints and enamels. The Nu-Enamel Corporation of Delaware was organized in March, 1935. The Nu-Enamel Corporation of Illinois sold its business to Nu-Enamel Corporation of Delaware. The Nu-Enamel Corporation of Delaware now operates the business. The Enameline Products Corporation is still in existence. The business of the Nu-Enamel Corporation of Delaware is manufacturing and selling paints and enamels. I caused the Delaware Corporation to be created. We were putting out a stock issue and on advice of counsel changed the corporation from Illinois to Delaware, because it broadened our powers as a corporation. The counsel who advised me to do that was not the same counsel representing me in this suit. (The witness produced a certified copy of the contract of sale of the assets of the Nu-Enamel Corporation of Illinois to the Nu-Enamel Corporation of Delaware. The document was offered in evidence and marked PLAINTIFFS' EXHIBIT D.)

I established the business of these parties plaintiff back in the latter part of 1922 or the first part of 1923. I was employed by the Fac-Try-Lyk Paint Company in New Orleans. I worked for them until the latter part of 1922 or the first part of 1923. At that time I had a chance to take over that business, which was a very small business, and I operated the business under Fac-Try-Lyk for a short time. I later found that the word Fac-Try-Lyk was owned, as well as I remember by some cement company, and I changed the name to Nu-Enamel.

The trade name of the products of Fac-Try-Lyk was Fac-Try-Lyk paint, and the company was Fac-Try-Lyk Paint Company, so I changed that to Nu-Enamel instead of Fac-Try-Lyk. I changed the brand name to Nu-Enamel instead of Fac-Try-Lyk. I fix the time when I changed that name as the latter part of 1922 or the first part of 1923. My method of distribution was through dealers such as hardware stores, drug stores and filling stations, and through agents. The agent had his car painted in twenty-four colors, and that car would be parked on a corner and they would demonstrate the paint and sell it to the public from the street corner.

I operated along that line up until 1925 or 1926. Then I started out discontinuing the agent on the corner and continued the selling through hardware stores, drug stores and filling stations, and began to establish exclusive stores, such as we have to-day. We have continued the method through the dealer and through the stores up until the present date, when

we have some three thousand dealers throughout the United States, together with three hundred stores—approximately three hundred stores, and have jobbers in twenty-one foreign countries.

I began as Charles L. Lloyd, doing business as the Fac-Try-Lyk Paint Company, and later changed it to Charles L. 72 Lloyd, doing business as Nu-Enamel Paint Company.

When I took over the business of the Fac-Try-Lyk Paint Company, my method of distributing my products was through dealers and through agents, that is the man with the painted car. We would get the car painted in twenty-four colors, parked on a corner, demonstrate the paint and sell it to the public. (Witness produced a picture of a car of many colors, which was a picture of the car used by him at the present time.) The car used in 1922 or 1923 was similar to that; the colors might have been changed a little bit on it, but it is practically the same color scheme as then. (The picture of the car identified by the witness was received in evidence as PLAINTIFFS' EXHIBIT E.)

(Counsel for defendant objected to testimony of this witness concerning a painted automobile. The court overruled the objection and permitted the testimony to go subject to the objection.)

Cars similar to the one shown on this Exhibit E are in use at the present time. Approximately two hundred are on the streets of the United States at the present time. At the time of the filing of the bill, in 1935, there were around two hundred. I myself sold the products from a colored car in 1922 or 1923. The products sold were paint, varnishes, enamels, top dressing, sandpaper and paint remover. The brand used on products first sold from cars was Fac-Try-Lyk. That brand was discontinued either the latter part of 1922 or the first part of 1923, somewhere in there. I can't be very definite on it.

Then I adopted a brand name or trade mark Nu-Enamel. I and my successors in business have used that name continuously from 1922 or 1923 to date and are using it at the present time. The name Nu-Enamel was affixed to the products sold from automobiles back in 1922 or 1923. The name

Nu-Enamel was affixed to the products by printing it on 73 the label which was attached to the package. It was stamped on the brushes. (The witness identified the type of label and the wording that he used on the merchandise, Nu-



Enamel, that he sold. The label was offered in evidence and marked PLAINTIFFS' EXHIBIT F.)

The name of the company appeared on these labels. The name was Nu-Enamel Paint Company, up until it was incorporated about 1927. On the automobile from which I sold the various products which I enumerated, there was the name Nu-Enamel and the word One Coat Covers and Leaves No Brush Marks. I sold the products from automobiles from the beginning in 1922 or 1923 up until 1925 or 1926, when I abandoned the agent idea and discontinued selling from the car. When I took over the business from the Fac-Try-Lyk Paint Company, I employed salesmen to sell my products. They sold both as agent and dealer; mainly the agent, that is a man that was parked on the corner, with his painted car. They sold products from an automobile similar to the manner in which I sold them. I employed about fifteen salesmen in 1923. At the end of 1926 and the beginning of 1927, I had one hundred agents and salesmen. In talking about the man with the painted car, I called him an agent or salesman. There were one hundred of them. In 1926, I was selling throughout the South and in a good many states, I imagine they covered Illinois; and a good many states throughout the Southwest,—Northwest. I operated my business under the name of Charles L. Lloyd, doing business as Nu-Enamel Paint Company, I would say, to be safe, from 1923 up until 1927, when the business was incorporated under the laws of Texas. The name of that corporation was Nu-Enamel Paint Company, Inc.

We were putting out the following products under the name Nu-Enamel, prior to the filing of the suit in 1935:

74 Modern finish, 1923, that is enamel; enamelized paint, 1931; flat white varnish, 1931; top dressing, 1923; varnish stain, 1932; utility black, 1932; thinner, 1933; wood powder, 1934; floor finish, 1932; bronze liquid, 1935; patching plaster, 1934; wax, 1934; remover, 1923; linoleum finish, 1933; polish, 1932; casein paint; glue and mineral colors, 1935; liquid solder, 1932; oil colors, 1933; brushes, 1923; metallic finish, 1935; tack rags, 1932. (The products identified by the witness were received in evidence as PLAINTIFFS' EXHIBITS G to G-23.)

(Defendant's counsel objected to the introduction in evidence of the various products of the plaintiff. The objection was overruled and the list of products was admitted subject to the objection.)



The volume of sales of products sold by plaintiffs and their predecessors bearing the brand or trade-mark Nu-Enamel since 1933 have been:

1933 — \$566,354.79; 1934 — \$1,448,441.50; 1935 — \$1,341,986.89; Eleven months of 1936 — \$1,226,039; or a total of \$4,282,836.18 during the four years.

My records are not complete prior to those years. The geographical sales of products bearing the trade-mark Nu-Enamel cover every state in the Union. There is an exclusive Nu-Enamel store in every town in the United States of over 100,000. There might be an exception of one or two. That would be 99 per cent correct. And in every town or a good many of the towns down to 5,000 we have dealers, less than three thousand dealers scattered over the country, more or less an equal distribution throughout the United States as well as twenty-one foreign countries.

There are some stores that handle our product exclusively.

There are approximately three hundred exclusive stores.

75 Twenty-five or thirty are located in Chicago, Evanston, Oak Park and the suburban part of it. The stores which

handle Nu-Enamel products exclusively operate under the name Nu-Enamel. That name appears on the window or above the valance, or on the valance. The majority of these stores have Neon signs displaying the name Nu-Enamel. (The witness identified a photograph of a typical Nu-Enamel store, which was offered in evidence as PLAINTIFFS' EXHIBIT H.)

(The witness identified a Nu-Enamel ad to stick on windows of the stores of dealers, and on automobiles. The sticker was offered in evidence as PLAINTIFFS' EXHIBIT I.)

The Nu-Enamel Corporation does not own these three hundred stores that handle Nu-Enamel products exclusively. The stores are owned by the individual operators. The Nu-Enamel Corporation supplies the products for these stores exclusively.

The Nu-Enamel Corporation of Delaware advertises its products at the present time, which are sold under the name Nu-Enamel. Its predecessors in business advertised.

Prior to 1935, the time of the filing of this suit, the stores which sold Nu-Enamel products were supplied these products by the Nu-Enamel Corporation of Illinois. The Nu-Enamel Corporation of Illinois and its predecessors advertised Nu-Enamel products. The methods which plaintiffs and their predecessors have advertised their products under the

trade-mark Nu-Enamel have been window demonstrators, a girl in the window, painting samples and talking over the mike, telling the people about Nu-Enamel and its qualities, painted automobiles, painted in twenty-four colors, a couple of hundred of those running around over the country; through the radio, newspapers and magazines, street car cards, bus cards; bill boards and other such mediums. We have a fairly accurate record of the figures of the amount spent for advertising. Window demonstrators are employed for fifteen to twenty-five dollars and thirty dollars a week. Not all the stores carry window demonstrators but we will say \$100,000 a year is spent in that direction. That is in addition to the painted cars running around through the country and we have contracts with dealers and jobbers where they go 50-50 with us, with the advertising appropriation. If we spend one dollar, they agree to spend one. Our end of the advertising was:

1933, \$41,664; 1934, \$143,599.98; 1935, \$145,738. According to our contract with our dealers, they agreed to spend \$200,000, that would be \$400,000 for 1933 and 1934. That is in addition to the \$100,000 a year that is paid the window demonstrators. We estimated that would be \$200,000-\$600,000.

The witness identified the following advertisements used by his companies prior to 1935:

Window display, street car cards, Elevated Railway Station posters, color cards, a directory of Nu-Enamel products and newspaper advertising.

The Nu-Enamel Corporation, which was the Illinois Corporation in 1935, was advertising in newspapers at that time. Dealers and distributors handling these products were advertising prior to 1935. (The advertising material identified by the witness was received in evidence as PLAINTIFFS' EXHIBIT J.

77 (A certified copy of the Nu-Enamel registration was received in evidence and marked PLAINTIFFS' EXHIBIT K.)

That registration was taken out by the Nu-Enamel Corporation of Illinois.

The trade mark registration, a copy of which has just been offered in evidence was sold and assigned by the Nu-Enamel Corporation of Illinois, to the Delaware Corporation, at the time the other assets were sold to the Delaware Corporation, around March 1935.

The products, namely, paints, varnishes, enamels, top dress-

ings, paint brushes, which we put out in 1922 under the trade mark Fac-Try-Lyk, and later under the trade-mark Nu-Enamel were not new nor different from similar high grade products put out by others. The products which we put out in 1922 or 1923 under the trade-mark Nu-Enamel were the same products that we had formerly put out under the trade-mark Fac-Try-Lyk. It was a continuation of the business but we changed the trade-mark. I myself have not obtained any patent for making our products. My company does not own any patent for making its products.

The statement "A Coat of Enduring Beauty" displayed over the name "Nu-Enamel" on the can was being displayed on our cans at the time this suit was filed. We have used that slogan in connection with our business since 1925 or 1926. We had the slogan "enduring beauty" in there and "indestructible beauty" at one time. We have shown the word "beauty" over and above the trade-mark Nu-Enamel on a good many of the packages since 1926, but not on everything.

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*Cross-Examination.*

I adopted the trade-mark Nu-Enemal in 1922 or the first part of '23. I very likely signed the statement in Exhibit K—"The trade-mark has been continuously used and applied to the said mixtures, paint and so forth, since March, 1925." The signature to Defendant's Exhibit 1, being a certified copy of the wrapper of my application for trade-mark made March 8, 1927, No. 225,101, is my signature. That is also my signature on the photostat of an affidavit signed Charles L. Lloyd. I made the statement in that affidavit to the effect that the trade-mark has been continuously used and applied to said goods in applicant's business since March, 1925. I have made the same statement in our advertisements and circulars which we issued to our salesmen and distributors. That is the statement I make in our printed and mimeographed circulars. In the bill which we filed in this cause, we stated that he had used it since 1922. I signed the bill. In this bill I also stated that the Nu-Enamel Corporation of Illinois on January 9, 1935, owned and operated 3000 stores. We do not own 3000 stores, we have 3000 dealers, approximately 3000 dealers throughout the United States. The statement in the sworn bill filed in this case that the Nu-Enamel Corporation of Illinois owned and operated 3000 stores on January 9, 1935 is

not a true statement. The statement, that I or my predecessors have used Nu-Enamel since 1922 as set out in the complaint and sworn to is correct.

On January 9, 1935, Nu-Enamel Corporation of Illinois did not manufacture any of the products that I have introduced in evidence. The O'Brien Products Company manufactured those. On January 9, 1935, Nu-Enamel Corporation owned no factories. The corporation had their products manufactured by the O'Brien Company, located at South Bend, Indiana.

When I adopted the word Nu as attached to Nu-Enamel I did it because it was simple, easy to remember. I didn't know what the word Nu meant. I looked it up the other day, that means the 13th letter of the Greek alphabet, or White Star. I adopted the name because it was simple. I came very near adopting Old Oak. I did not make a choice between the word Old or Nu, I had 20 or 30—. I had in mind adopting the words Old Oak, along with a number of other names. That just appealed to me, Nu-Enamel. It has no meaning at all, as far as I know, except the 13th letter of the Greek alphabet, White Star. That is not what I intended to mean. The meaning on January 9, 1935 was a name separate, Nu-Enamel, from other paint companies' products. It meant the name of our stores. It is an important word in our corporate name, Nu-Enamel Corporation, and our trade-mark. I had no intention of using it as a phonetic spelling or shortening of the word new; not in the beginning nor ever did I have that meaning in mind. At no time did I intend that the word Nu, in Nu-Enamel, should have any meaning other than Nu-Enamel, not New. I was about 23 years old, right off the farm back there. In 1935 it meant my trade-mark. It separated my trade-mark from any other paint or material. It was the name of my stores.

I do not recall if it was Mida & Wallace that I applied through for registration of Nu-Enamel under the trade-mark Act of 1905. It was a Chicago firm as well as I remember. I remember having applied in 1927 for the registration of Nu-Enamel under the trade-mark Act of 1905. I do not recall the Commissioner of Patents refusing the registration on the ground that Nu-Enamel was a descriptive word. I didn't go into that. I turned it over to Mida & Wallace. I do not recall filing a new application under the 1920 Act. I turned it over to the attorneys. I don't know anything about filing. My attorneys may have told me I couldn't regis-



ter Nu-Enamel under the 1905 Act because it was a descriptive word but I don't recall.

It is correct to say that at no time did I intend to convey the meaning that Nu means New.

I have stores in France. The French name for Nu-Enamel is Novemail. I do not know if the French word Nov comes from the word meaning new or not. In answer to the question "Now if you say Nu-Enamel is intended to designate your product, why didn't you use the name Nu-Enamel on your French stores?", the witness replied, "I am not familiar with English, much less French." We do not use Nu-Enamel as the name of our store, we use Nov-Email. I do not know if that is the French translation of Nu-Enamel. No one ever told me what Nov-Email means. I think it is Nu-Enamel. I do not know if it is Nu-Enamel translated into French. I understood that Nov-Email meant Nu-Enamel, our trademark. That is my impression. I never studied Latin, I finished school in the fourth grade. The word novice in English means an amateur, novelty means some toy or something to play with, novel mean a book; I don't know what the adjective novel means. I just got through telling you that I finished in fourth grade, that is, schooling, you can tie me up in English. I know about a hundred common words in the English language.

81 The word Modern on the can of Nu-Enamel (witness was shown one of plaintiffs' exhibits) means up-to-date. Up-to-date, up to the minute. I define Nu-Enamel as a modern finish. I intended to convey the fact that it is a modern finish, right up to the minute; along the line of the best grade of duPont, Sherwin-Williams or any other. That is not on every label but is on this particular one. Nu-Enamel, a modern finish, is on the label attached to the bill of complaint in this suit.

I have stores in China but don't ask me the Chinese name for Nu-Enamel. I do not know what word is used in Chinese to advertise Nu-Enamel. I don't know whether I could even read the Chinese translation of Nu-Enamel. I wouldn't know it if I saw it in print. We also have some stores in India but I do not know what the name for Nu-Enamel is that we use in our stores in India. I do not know what the Indian equivalent of Nu-Enamel is. I don't know whether I could pronounce it if I saw it in print.

I worked for some paint company in New Orleans before I went in business for myself. I can't say that I ever heard

of the Utley Paint Company in New Orleans. I am not familiar with the Utley trade-mark Nu-Enamel. I never heard of New Enamel as a trade-mark for paint or automobile polish. I never heard of a concern called National Paint Company in New Orleans using it.

I still say that Nu, as far as I am concerned, never was intended to mean or convey any impression to the public that it meant New. It was just easy to remember. I don't know where I got the name. I know the boys and my friends  
82 submitted a list and that name appealed to me and I selected it. It appealed to me much better than the word Old Oak.

The legend "Coat of Enduring Beauty" on our can was used since 1926. Any good paint that will give a coat of beauty that will last, I can well and truthfully advertise that that paint naturally, or any covering can give it a coat of enduring beauty, if it is good paint and lasts good as long as the other. My statement about Nu-Enamel products giving the article to which it is applied a coat of enduring beauty, is a statement indicating high quality merchandise. If beauty is a slogan of ours, then anyone who has a high quality merchandise who would tell the public that their paint or enamel will give the article a beauty, or make it beautiful, would be more or less of an infringement.

Plaintiffs' Exhibit G is a can of enamel, Nu-Enamel, our product, white. The surface will have a lot to do with whether one coat of white always covers the surface to which it is applied. The label says, one coat covers, on the can of white enamel, and with the proper surface, yes, it will cover it, one coat. We tell that to the public in our direction sheet and I think we do on the label, I will have to read this thing here. You couldn't get a little larger one here, could you. Smooth, smooth with 60 sandpaper. If you smooth the surface with sandpaper that is a proper instruction, and apply one heavy coat of it. One coat of white will cover a piece of black, ebony, wood if you sandpaper it, if it is a proper surface. I can make it cover. Counsel could make it cover if you let  
83 me prepare the surface for him. I wouldn't say any surface, no. On the proper surface it will cover but I don't say that on our label, not in those terms; over the proper surface, if you will get out direction folder. The direction folder is part of the can, part of the selling instructions to apply the paint. "One coat covers," legend appears on all



colors of Nu-Enamel, the enamel product which we get out. "One coat covers," appears on every can.

I do not know how they tell the salesmen to demonstrate it. Maybe they tell the salesmen to demonstrate only with jade green because it covers better than other colors. I don't say how well one coat covers. Maybe jade green is a particular color that will cover better than other colors. It would be perfectly all right if it did. There is nothing on the large sticker which we use in front of our store "One coat covers, Nu-Enamel" about one coat covering only as to certain colors. The folder comes in, if you get a can, here is a complete instruction with the can just how to prepare that surface that that coat will cover. The can itself doesn't say anything about printed instructions that go with the can. The seller instructs her to prepare the surface. I said any color on the proper surface. It is a fact that I have built up my business of Nu-Enamel largely on this one coat covers idea.

"Q. As a matter of fact, I believe you attempted, before the Federal Trade Commission in Washington, to get a monopoly on that slogan, one coat covers?

A. We did in New York, in the Supreme Court.

Q. In the state of New York?

A. Yes.

Q. On unfair competition?

A. We got it in New York in the Federal Court. The Nu-Enamel tried it.

Q. I am talking about your attempt to get a monopoly on the slogan, one coat covers.

A. I don't know that we tried it before the Federal Trade Commission. We tried several lawsuits and always won."

Over the proper surface any one of the Nu-Enamel colors will cover. To the public I tell that one coat will cover and I tell you with the proper surface it will. There is no qualification on that sign as to the color and surface to be applied. You couldn't expect to put that out in a Neon sign, it costs too much money. I intend to have the public believe that, in any event, over the proper surface, one coat of Nu-Enamel will be sufficient to hide the surface underneath. We don't say that on the can but get our direction folder that goes with the can and you will find it.

(Witness was shown DEFENDANT'S EXHIBIT 2, being a piece of Nu-Enamel literature, and asked what the title on the cover, Nu Ideas, meant.)

He replied "Nu ideas." I don't know what they meant by that, I really didn't put that on there. This is the first time I ever saw it. Our advertising department put it out. Very likely I have seen it but I wouldn't say I have or I haven't. I know what is contained in this mimeographed pamphlet got out by our advertising department, I imagine it is just what it infers there, Nu ideas. I just say that it is a piece of our literature. As far as ever seeing it, I don't know whether I have or haven't. I don't know just what the words indicate. We always try to get as close to our trade as we can.

(DEFENDANT'S EXHIBIT 3 was offered for identification and shown to witness, being a magazine of Nu-Enamel Corporation.)

That is Nu-Enamel Magazine, we call it, Nu-Enamel Nus, issued since 1930. The title of it is Nu-Enamel Nus. We use the word Nu to tie it in to our trade-mark as many 85 times as we possibly can, our trade-mark Nu-Enamel.

(Witness was shown DEFENDANT'S EXHIBIT 4, being an issue of Nu-Enamel Nus of December 20, 1935, and had his attention called to the first column on page 15, Nu Dealers, and asked what he meant by that.)

"We call Nu-Enamel dealers, Nu-Enamel Dealers, we carry that into that slogan." These dealers listed in this column are new dealers who have recently become dealers of Nu-Enamel. We list every month in our Nu-Enamel Nus, Nu-Enamel new dealers. The purpose of this volume is to tie in our trade-mark, Nu, Nu Dealers. These are dealers who were new dealers at the last issue of the Nu-Enamel Nus. They are recent dealers.

I know what the word n-e-w- in the English language means, according to how it is used. I don't know unless you use it as new. Its meaning in connection with characterizing our recently acquired dealers is, I would say, they are Nu Dealers. Throughout our literature we refer to everything that is new as Nu, such as a new idea, as Nu, because it is our idea to capitalize on the trade-mark as much as possible. When we are writing in there we call a good many things in a sentence Nu, new. I wouldn't say we had a new, Nu factory. Referring to Nu Dealers, the recently acquired dealers, they are dealers recently appointed; recently appointed dealers. They are spelled N-u Dealers. That is our system to carry out our trade-mark in everything we can in our own organization. I have testified that if the surface is properly prepared, white enamel which is sold by Nu-Enamel will cover with one coat.

(Witness was shown DEFENDANT'S EXHIBIT 7 for identification, entitled "Sales Suggestions for Nu-Enamel Dealers and was interrogated concerning quotations from said pamphlet.)

I have very likely seen this before. This is a document 86 that plaintiff Nu-Enamel Corporation of Illinois, plaintiff distributed to their salesmen but I don't know when it was distributed—I don't know whether it was distributed on or before January 9, 1935.

The witness was asked about the following statements appearing in Def's. Ex. 7:

"If the transposition isn't too great, light colors will cover dark colors."

He replied, "Ivory and white sometimes will not cover a darker surface in one coat but will with two."

Cans of ivory and white enamel which Nu-Enamel Corporation of Illinois sold on or before January 9, 1935, state that one coat covers. In dealing with amateurs at times the salesmen have to tell them. The salesmen will know the proper surface. You have to hold the salesmen down. Really with white and ivory you have to tone that down.

(Witness's attention was called to DEFENDANT'S EXHIBIT 8 for identification, being a pamphlet "Suggested sales talk for use with demonstrating kit," and asked if he had ever seen it before. His attention was called to page 3 of said pamphlet marked Exhibit 8 for identification, listing items that go to make up salesmen's demonstrating kit. Item No. 2 lists three bottles, cans of paint, brush, color panels and so forth. No. 4 lists jade "one coat covers".)

Jade "one coat covers" means maybe that it covers better than other colors. In regard to page 4, instructions to salesmen to remove one can of paint (jade) to a position readily accessible for use later, may mean that jade covers better than other light colors. However, we state on all our cans that one coat covers. As to the instructions on Page 5 "Nu Enamel is easy to apply; one coat will cover and you want to prove that theory; here open up a two-ounce can of jade; take demonstration panel in your hand; dip brush in enamel, get plenty on and hand brush to the prospect", we don't say that one coat will cover better than others. I will say that maybe jade green covers better than other light colors. Very likely we instruct salesmen to use only green. The salesmen are 87 called on to use other cans too. The Nu-Enamel Corporation of Illinois might have suggested to the salesmen

that they use jade green, I don't know. It is in our sales department, the demonstrator might have put it in. That is the only explanation I can give and I am guessing at that. I have department heads. The sales department or advertising department is responsible for the type of advertising we get out.

One of the common forms of advertising Nu-Enamel products is by window displays and demonstrators. The usual window set-up that we have with our demonstrators and signs is painted samples, such as tables, chairs, doors and fenders. We have a girl in the window of the stores demonstrating the product and telling the public about it, how it works on furniture, and how it works on automobiles; and house paint, and so forth. Just a general lecture on paints, the use of paints, and instructions for using paints. We have in most of our stores, or many of them, large signs "Nu-Enamel. One coat covers." "No brush marks." We have Neon signs in many of our stores, "Nu-Enamel. One coat covers." These demonstrators are in the window working on some article or piece of wood or metal applying Nu-Enamel with a brush. This demonstrator is also surrounded in the window with articles like drop leaf tables, half painted. Drop leaf tables, chairs, fenders, wash bowls, toilet seats, most everything you can use paint on. The whole demonstration and advertising display is for the purpose of showing the public how the public which buys the Nu-Enamel or Nu-Enamel products can apply our Nu-Enamel and make it appear like the articles as they are in the window. It is more or less of instructions, a line of educational work to the public, showing them how to paint. It is the purpose to show them they can use it like the samples that the demonstrator has. We don't have any special professional painters. Those girls are all hired. In a good many cases those girls paint those articles that we have in the window. In a number of cases they are painted by some paint shop. In a good many cases those articles with

88 which our demonstrators are surrounded are painted by the demonstrator or manager of the store. We have a fellow out here somewhere on the West side that painted some of these articles for us two or three years ago. It is Mr. Williams of the Alco Manufacturing Company. He is supposed to paint them with a brush. I don't know if those articles which are displayed in our windows, have the enamel applied with a spray gun. My instructions are to apply it



with a brush. Those articles are not rubbed down with pumice stone and worked to give them a good polish.

The surface will have a lot to with whether these articles are painted with more than one coat. If the surface is smooth you use one coat, if it requires a primery they have to use two. The Alco Manufacturing Company, or the concern in South Bend applies to the ordinary old chair a primer and one coat. That is our instruction. I didn't watch them paint. We have those articles, old chairs half painted and old screen half painted and old toilet seat half painted in the window around the demonstrator and in the same window we have the sign, Nu-Enamel one coat covers. I didn't say they used a spray, I said they used a brush. I didn't watch them when they were painting them but you can get a better job with a brush. If the surface is right, the kitchen chairs and the tables have one coat on them. Some of them have one coat of enamel, others have a coat of primer.

We have that kitchen chair in the window with the same words, that is our signs on it and trade-mark Nu-Enamel, one coat covers; we have a demonstrator in the window painting a piece of wood or metal, some article in the same window. The purpose of that advertising is to have the onlooker believe that he can cover with one coat.

89 I don't know as we do have a sign in front of these articles that are displayed, stating that this article has a primer and more than one coat but the girl gives the instructions in the demonstration. We have a sign attached to the article which shows one coat.

We have a store on Dearborn Street between Madison and Washington, in Chicago. I have not seen that store lately. Not in the last three or four months. I do not know whether that store has any sign attached to any articles that are displayed stating that it has more than one coat. In twenty-five per cent of the instances these display articles, such as chairs and tables, automobile doors, fenders, are sold by the Nu-Enamel Corporation to other dealers. Twenty-five per cent of the dealers can go in and buy their samples, order their samples there: We urge our dealers to paint their own.

(Witness was shown DEFENDANT'S EXHIBIT 1 bearing date November 20th, an issue of Nu-Enamel Nus.)

This magazine is sent to Nu-Enamel dealers, Nu-Enamel salesmen and distributors. At the top of the page is a photograph or reproduction of a Nu-Enamel Neon sign "One coat covers." That is the type of sign which appears commonly

on our Nu-Enamel stores, and which we are urging our Nu-Enamel dealers and distributors to purchase. In the left hand corner of the same page appears a reproduction of six display articles, automobile door, toilet seat half painted; an automobile door partly painted; a fender partly painted; a kitchen chair partly painted; end table partly painted and a drop leaf table partly painted. These are display articles which we have in the past and are now having manufactured by some outsiders.

90 These display articles were in many instances manufactured by the Alco Company of Chicago.

On the right hand lower corner appears a sidewalk hanging sign, Nu-Enamel, rather a reproduction modern finish, one coat covers. No brush marks. It reads "We cannot stress too highly the value of half painted articles" reading from the bottom of the page; "we can't stress too highly the value of half painted articles for window display purposes." And we say "the display pieces which are most important in helping to increase the sale of Nu-Enamel, these can be purchased at reasonable prices as listed under advertising. Send in your order thru your distributor." We tell our dealers and distributors that we have these display pieces on hand.

I very likely have seen the price list which is gotten out and published and distributed by the Nu-Enamel, or was distributed by the Nu-Enamel Corporation of Illinois, the plaintiff, listing these various display articles with their prices.

On page 14 of Defendant's Exhibit 1, Nu-Enamel Nus of November 20, 1934, is a reproduction of a circular or card headed "Nu-Enamel Advertising Supplies", which is our price list of Nu-Enamel advertising supplies. It has the heading "Mr. Dealer, do you have these items. At the bottom it reads "Every Nu-Enamel dealer should have the items checked. If he don't have them see your distributor at once." This price list is distributed to our distributors, salesmen and dealers. In it is dealers displays, kitchen chair \$4.75 which we sell to our dealers and distributors: We got to set the price high enough so they will paint them themselves. Kitchen chair, \$4.75; toilet seat \$2.50; auto door \$5.00. We send these circulars out quite regularly to our dealers and distributors.

We have devoted in the Nu-Enamel Nus of November 20, 1934, approximately two pages advertising these various display items, the importance of them. These display articles



which are advertised for sale in our magazine are painted with a primer and one coat.

I signed the bill of complaint filed in this case. Paragraph 4 states "Defendant Armstrong Paint & Varnish Works within the last few months has put upon the market paints and varnishes which it sells under the designation of Nu-Beauty Enamel." I have seen almost the entire line of Armstrong Paint and Varnish but I don't recall seeing a can of varnish right now. I would say that I have not seen a can of paint manufactured and sold by the Armstrong Paint and Varnish Works or some other company with a label on it, Nu-Beauty Enamel. Paint is not Beauty Enamel. I have seen all the different types of paints that Armstrong makes, they have got a good many of them. I don't recall that I have ever seen a can of varnish with a label Nu-Beauty Enamel on it. I don't remember each item but I remember seeing the full line.

We have dealers or distributors in Algeria and Tunis. I don't know what name Nu-Enamel is sold under in Tunis. It is not sold in Algeria under the name Novemail. I don't know what name Nu-Enamel was sold in November, 1924 in Brussels, Belgium. I took a trip to Europe a couple of years ago and visited all of our stores or some of them. In the issue of November 20, 1934 of Nu-Enamel Nus, marked DE-92 DEFENDANT'S EXHIBIT 1 of this date; in the upper right hand corner is what purports to be a photograph of a Brussels store selling Novemail. That refreshes my recollection as to what name is used in selling Nu-Enamel in Brussels, Belgium—Novemail. There is also a store in Tunis, North Africa, where Novemail is used as the name of our product Nu-Enamel.

DEFENDANT'S EXHIBIT 2 of this date, is a copy of Nu-Enamel Nus (March 15, 1934), a magazine issued, published and circulated by the plaintiff in this case, Nu-Enamel Corporation of Illinois. DEFENDANT'S EXHIBIT 3, Nu-Enamel Nus of September 20, 1934, was published, issued and circulated by the plaintiff in this case. DEFENDANT'S EXHIBIT 4, is a copy of Nu-Enamel Nus of December 20, 1934, published, circulated and distributed by the plaintiff in this case.

We advertise on the seats of the buses which are used in Chicago. The sign on the back of those seats reads "Nu-Enamel. No brush marks. One coat covers."

I testified yesterday that one of the reasons for organizing

the Delaware Corporation was that we were floating a stock issue. That was on or prior to March 1935, about the time this suit was filed. The reason suit was filed was not to get an adjudication or attempted adjudication of our trade-mark for the purposes of that stock issue. We were under the impression that we owned it.

The ads on the back of the seats of the buses were used by us on or before January 9, 1935.

The copies of Nu-Enamel Nus of January 20, 1935, February 20, 1935, March 20, 1935, April 20, 1935, May 20, 1935, June 20, 1935, July 20, 1935, August 20, 1935, September 20, 1935, October 20, 1935, November 20, 1935, December 20, 1935, May 20, 1936, June 20, 1936 and October 20, 1936 are the 93 issues of the magazine published, circulated and distributed by the plaintiff in this case as of the dates mentioned.

#### *Redirect Examination.*

(A circular, reading at the bottom "Armstrong Paint and Varnish Works, Chicago," was here identified as PLAIN-TIFF'S EXHIBIT L.)

The Federal Trade Commission has taken no action against me for using the slogan "One Coat Covers."

The Nu-Enamel Corporation had a suit, in the Supreme Court of the State of New York, against Nate Enamel Company, Inc., and others, in the year 1935. That case went to the Appellate Division of the Supreme Court of the State of New York.

I don't recall any complaint that one coat did not cover.

(A certified copy of the registration of the trade-mark Nu-Enamel registered March 8, 1927, No. 225101 was received in evidence as PLAINTIFF'S EXHIBIT M.)

I testified on direct examination that in 1922 or 1923 I was putting out paints, varnishes, enamels, top dressings, tack rags, and paint brushes under the trade-mark Fac-Try-Lyk and that I changed my trade-mark from Fac-Try-Lyk to Nu-Enamel. The products which I continued to put out under the trade-mark Nu-Enamel were the same products that I had previously put out under the trade-mark Fac-Try-Lyk. These were the same products that had been made and sold by the Fac-Try-Lyk Paint Company since 1919. There were several names suggested to me for trade-marks and I adopted the name Nu-Enamel. I dropped the trade-mark Fac-Try-Lyk be-

cause. I had a complaint from some concern that they were the prior user of that trade-mark. It was as a result of 94. that complaint that I had to adopt a new trade-mark and I adopted Nu-Enamel.

*Recross Examination.*

I stated that as far as I know there were no complaints about one coat covers. In 1935 we had between two and three thousand dealers. In addition thereto we had general merchandise people selling Nu-Enamel, sold in hardware stores, paint stores and novelty stores, throughout the United States, Canada and Europe. I wouldn't know about all of the complaints. I would know of but a very few, if any were made. Purchasers in New Zealand wouldn't write to me in Chicago complaining that one coat would not cover.

When I was in New Orleans I never heard of a trade-mark or trade name Nu-Enamel used by the Nu-Enamel Paint Company of New Orleans, La.

95 DR. R. A. TESCHAN, Milwaukee, Wisconsin, testified on behalf of plaintiffs, as follows:

*Direct Examination.*

I am Dr. R. A. Teschan, Milwaukee, Wisconsin, an M. D. physician and surgeon. I am practicing my profession in Milwaukee. I am a graduate of Marquette University School of Medicine. I have heard of paints or varnishes or enamels put out under the name Nu-Enamel. I first heard of them in the early part of 1935. I conversed with friends regarding Nu-Enamel for refinishing furniture. In March, 1935, I stepped into a demonstrating store selling Nu-Enamel and observed the use of Nu-Enamel in the finishing of furniture. The store demonstrating the product was a Nu-Enamel store, selling Nu-Enamel products exclusively. The name Nu-Enamel was on the store window. Plaintiffs' Exhibit G is the product that I have been familiar with. It is the product I saw demonstrated in the Nu-Enamel store. I have bought a can of paint or enamel thinking it was Nu-Enamel and it turned out to be something else. I made the purchase at Gimbel's in Milwaukee in June, 1935. At the time I bought that product, I thought I was buying the Nu-Enamel which I

was familiar with and had seen demonstrated in a Nu-Enamel store in Milwaukee. I used the product. Following the completion of refinishing some of my office furniture, I had invited a friend, Mr. Seifert to come to the office and see the completed job. I had spoken of the use of Nu-Enamel in the refinishing of this furniture, and he spotted the can and said "Why this is not Nu-Enamel, it is New-Beauty Enamel."

Whereupon I did express surprise.

96 The New-Beauty Enamel display in Gimbel's was similar to the Nu-Enamel display I had seen previously in that it consisted of a series of display and sales shelves, also demonstrators, demonstrating the qualities of the product for sale. The display and demonstration was similar to that I had seen in the Nu-Enamel store.

#### *Cross-Examination.*

This can is like the can that I bought at Gimbel's Department Store. It was Ivory. I purchased a half-pint. I painted my office furniture a short interval each day for about three days. I did not apply a brush in the can of New-Beauty Enamel similar to the can which Mr. Woodson showed me on Direct Examination. After I completed the finishing of my office furniture I called on my friend Mr. Seifert. He spotted immediately that this was New-Beauty Enamel. I had this can in my possession for several days, but did not spot the fact that this was New-Beauty Enamel. I am now familiar with the Nu-Enamel cans. I had seen them before I went to Gimbel's to buy enamel. I had seen this type of can. I was not cognizant of the color at the time. I had paid attention to the Nu-Enamel name only. When the salesman or saleswomen at Gimbel's handed me a can of New-Beauty Enamel I didn't look at it. I requested a certain color and I received the package. I probably asked for a half pint can of ivory enamel. That is probably what I requested.

97

#### *Redirect Examination.*

I do not have the container for the New-Beauty Enamel that I purchased. This New-Beauty Enamel was on display where one could help himself to it in Gimbel's.

(The New-Beauty Enamel can which the witness said resembled the can which he purchased in Gimbel's was marked for identification as PLAINTIFFS' EXHIBIT 1.)

*Recross Examination.*

The display in Gimbel's was of the nature of an enclosure on the first floor of the store having its walls lined with a series of shelves, these shelves containing paint cans. It was different from other paint stores in that there was a demonstration going on. The demonstration consisted of someone painting some articles. There is nothing unusual about enamel being demonstrated by applying it to a piece of furniture.

*Redirect Examination.*

When I was using this can of New-Beauty Enamel I did not notice the name New-Beauty Enamel. I thought that I had bought Nu-Enamel probably because of an unconscious auditory recording of the term "Nu". In Gimbel's I saw the word "New-Beauty" displayed in and about that counter. I understood that the products that were being displayed there were the same products that I had seen displayed in the Nu-Enamel store.

98 EARL SEIFERT, Milwaukee, Wisconsin, testified as follows:

*Direct Examination.*

I am a patent draftsman with Wheeler, Wheeler & Wheeler. I know Dr. Teschan who has just testified. I am familiar with Plaintiff's Exhibit G and recall the name Nu-Enamel. I think probably the first time I saw the words Nu-Enamel was on automobiles that were painted with the word Nu-Enamel on them. The automobiles I refer to were similar to that shown on Plaintiff's Exhibit E. I have seen automobiles with the name Nu-Enamel displayed on them as it is shown on that, approximately three or four years. I heard Dr. Teschan testify. His testimony was true in respect to the statements made in my presence. The package of enamel which the doctor showed me was similar to Plaintiffs' Exhibit 1. He had told me that he had been decorating his furniture with Nu-Enamel, and when I got up to his office I saw that can and I told him that he was not using Nu-Enamel but was using New-Beauty Enamel. The Doctor expressed surprise.



*Cross-Examination.*

When I went up to the Doctor's office I saw the can there, I found the can myself. I saw it right away.

- 99 JERRY O. EDWARDS, Cleveland, Ohio, Secretary of the Nu-Enamel Corporation of Delaware, called on behalf of plaintiffs, testified as follows:

*Direct Examination.*

I am J. O. Edwards of Cleveland, Ohio, Secretary of the Nu-Enamel Corporation of Delaware. I was Secretary of the Nu-Enamel Corporation of Illinois. I went with the company in February 1932. I have had dealings with the Weco Manufacturing Company of Chicago in regard to painting window displays for Nu-Enamel stores. W-e-c-o or W-a-c-o, whatever it was. I gave that company instructions as to how these window displays should be painted. I talked with the manager of the company, Mr. Willins. The instructions were all verbal.

These articles were painted by brush. In my opinion the better job would be by brush than by spraying. Spraying would be faster.

*Cross-Examination.*

The Waco Manufacturing Company made display articles for Nu-Enamel Corporation from the spring of 1932. They are not making them now. The Waco Manufacturing Company is located in Chicago. I have been there about half a dozen times but it is three or four years ago now. When I was there I spent practically all day. They made the articles I refer to for a period of two or three years. They are not now making the ones mentioned. They are making a bathroom display. The display is a piece of Masonite which we use to display Nu-Enamel. I don't know what they use it 100 for. They use it in the window. I do not know how many coats the Waco Manufacturing Company used on or before January 1935. I know what they used the day I was out there. One coat of Nu-Enamel over a properly prepared surface. If it was an old chair for example, and in good shape, like this one, one coat went right on over it. If

it was an old chair they put a primer coat underneath. The chair did not have any coat of primer or other covering on it at all. I wouldn't know the exact number of chairs I saw them paint the last time I was there. I did see spray machines at the plant of the Waco Manufacturing Company.

*Redirect Examination.*

Some Nu-Enamel stores buy their window display material from us and some of them paint it themselves. There is an advantage in their painting it themselves. In the first place it is cheaper, economical; next, many times when they are shipped they are scarred, they are handled improperly. Those are the two main advantages. I have seen many of them do it with brushes. I never saw one of our stores using a spray gun.

*Recross Examination.*

Articles appear in the Nu-Enamel Nus under my name. I have never written any of them. Other than the testimony this morning I wouldn't recall seeing any articles in Nu-Enamel Nus urging dealers to buy these display articles from us.

101 HOWARD L. LAMPA, Central Plaza Hotel, Chicago, called on behalf of plaintiff, testified as follows:

*Direct Examination.*

I am Howard L. Lampa. I live at the Central Plaza Hotel, Chicago. I am employed as a clerk in the law offices of Rogers, Woodson & Rogers. One of the attorneys in that office instructed me to go to certain paint stores in or about Chicago and ask for Nu-Enamel, and to accept any product that was offered in response to such request. I received those instructions about the first of September, 1934. I followed those instructions and went on a shopping tour. I was accompanied by James Gill. I made notes as to what occurred on this shopping tour. I will tell you the stores I visited, what I said and what the clerk said and what I did there.

On September 8, 1934, I asked Mr. James Gill to accompany me to a furniture store under the name of S. I. Frank & Sons Company, 2412 West North Avenue, Chicago. We went to

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the store about,—well, it was about 3:20 in the afternoon of that day, and I asked the clerk for a can of Nu-Enamel, black. The clerk walked over to a rack that held a number of cans of paint and held up one and asked if that was the size I wanted and I replied that it was. He then brought the can over to me and said "It is 55 cents." I reached in my pocket, pulled a handful of change and made some remark that I would see if I was that rich. The clerk looked at the change in my hand and says "Oh, you have got a lot of money." I paid him for the can and Mr. Gill and I then left the store. The product which I bought for Nu-Enamel was Nu-Beauty Enamel. The name Armstrong Paint & Varnish Works, Chicago, was on the can.

On December 4, 1934, accompanied by James Gill, I went to a hardware store located at 3905 West 16th Street. It was about 2:35 in the afternoon. I walked in the store and asked for a small can of Nu-Enamel, black. The Clerk replied: 102 "Yes, sir" and selected a can from a rack and I handed her a dollar bill. She replied "That is 55 cents." I replied "All right." She wrapped up the can and Mr. Gill and I then left the store. This is the can I purchased at that store.

On the same day at about 4:10 in the afternoon, I went to a hardware store No. 2338 Madison Street, Chicago. I told the clerk in that store that I wanted a small can of Nu-Enamel black. She replied yes, sir, and walked over to a large display of cans and started looking around. Another clerk who overheard the conversation asked if it was a small can I wanted and she replied yes. This clerk then pointed out where the small cans were, and she selected one of them and brought it to me and told me the price of the can was 55 cents. I paid her and Mr. Gill and I left the store. This is the can I purchased. (The cans identified by the witness were received in evidence as PLAINTIFFS' EXHIBIT N-1, N-2 AND N-3.)

#### *Cross-Examination.*

Mr. Woodson instructed me to do this shopping. Mr. Woodson did not tell me to ask for black. I asked for black in each one of these instances. The reason I asked for black Nu-Enamel was that black was practically the first thing that came to my mind and is probably the best known color. I am working with Mr. Woodson in connection with this case. I



examined some exhibits. One of my duties was to prepare the exhibits in this case.

In every one of these instances, I asked for a can of Nu-Enamel. I said it clearly and distinctly. I asked for the size of the can. I got the can, size of the can that I asked for. At no time, at any of these places, was I offered a can of Nu-Enamel.

103

*Redirect Examination.*

In no instance did the clerk tell me that the product was not Nu-Enamel but Nu-Beauty Enamel.

JAMES GILL, 5508 North Avenue, called in behalf of plaintiff, testified as follows:

My name is James Gill and I live at 5508 North Avenue. I heard Howard Lampa testify in this case. I was with him when he made the purchases referred to. I was very close to him, two or three feet away. I heard what Mr. Lampa said and what the clerks said. The testimony which Mr. Lampa gave is true in every respect with regard to these purchases. (It was stipulated that Mr. Gill would testify to the same things that Mr. Lampa testified to.)

104 J. ELMER LAMPA, 5508 West North Avenue, Chicago, called in behalf of plaintiff, testified as follows:

My name is J. Elmer Lampa and I reside at 5508 West North Avenue, Chicago. I was employed to go to certain stores in and about Chicago and ask for Nu-Enamel, and to accept any product that was offered to me by the clerk in response to such request. Howard Lampa employed me. He is my brother. I was accompanied by Roy Schoen. I made notes as to what was said at these various stores. I can give a summary of my shopping tour.

On December 6, 1934, at 10:50 A. M. I entered the store of S. I. Frank & Sons, 2412 West North Avenue, accompanied by Mr. Schoen. I asked the clerk for a can of Nu-Enamel, black. The clerk said "what size, 55 or 95 cents." I said "The small one." The clerk said: "I have no small cans left, I can give it to you in half pint size, will that be all right?" I replied



"Yes." The clerk says "How much do you have to cover?" I said "Not much, but that will be all right. How much?" And he said "95 cents."

This is the can I purchased at that store; it reads Nu-Beauty Enamel.

At 11:10 A. M. I entered a hardware store at 2338 West Madison Street and asked the clerk for a can of Nu-Enamel black. The clerk said "What size, 95 or 55?" I replied "A small can". I paid 55 cents and she gave me a small can of Nu-Beauty Enamel. This is the can I purchased.

At 11:40 A. M. I entered the store of J. Krupnik, at 3905 West 16th Street. I asked the clerk for a can of Nu-Enamel black, and she walked to the front. I added "A small can."

She searched the rack for a while then hollered back and says "Pa, did you sell those two small cans of black enamel?" A voice in the rear said: "Yes." The clerk said "I have no more small cans left." I said "Give me the next size", which she did. I said "How much?" And she said "That is 95 cents" and she handed me a half pint can of Nu-Beauty Enamel. This is the can I purchased.

I identify these cans at the present time by my handwriting on them. (The cans were offered in evidence as PLAIN-TIFFS' EXHIBITS N-4, N-5 AND N-6.)

I made some calls alone for Nu-Enamel. On January 11, 1937, I entered the store of Fred Herrenbruck Hardware Company at 600 West Lincoln Avenue, Milwaukee, Wisconsin, at approximately 9:20 A. M. I asked for a can of Nu-Enamel in a dark blue. The clerk started looking over his stock and said "I have no dark blue in Nu-Enamel, but I have it in another brand which is very good, a four-hour enamel." I said "Haven't you any blue in Nu-Enamel", and he said "Yes, I have a lighter blue I will show you." He showed me a spot on the can of New-Beauty. I said "How much?" He said "65 cents." I paid 65 cents, asked for a receipt and left the store. This is the can I purchased.

At 9:55 A. M. on January 11, I entered the store of Atkinson Paint & Hardware Company at 1030 West Atlantic Street, Milwaukee, Wisconsin, and asked the clerk for a small can of Nu-Enamel peach color. The clerk handed me a can of New-Beauty. I said "How much," he said "40 cents." I asked for a receipt, paid the 40 cents and left the store.

(The cans were received in evidence and marked PLAIN-TIFFS' EXHIBITS N-45 AND N-46.)

106

*Cross-Examination.*

On the first three purchases I made I was accompanied by Mr. Schoen. I purchased black enamel. I was not told by my brother Howard to ask for black enamel, just a can of enamel. I was not told at Fred Herrenbrucks that they didn't have Nu-Enamel. I am sure that in every one of these stores to which I have testified, I asked for Nu-Enamel. I did not ask for Nu-Beauty Enamel. I was not instructed by my brother Howard to make purchases of Nu-Beauty Enamel. When I went to those stores I did not know they handled Nu-Beauty Enamel, not all of them. I didn't go into any store on these shopping tours which didn't handle Nu-Beauty Enamel. I was told by my brother Howard which stores to go to. He told me to go to specific stores, first S. I. Frank, Chicago, 2338 West Madison and also 3905 West 16th Street, Chicago. He also told me to go on January 11, 1937 to the store of Fred Herrenbruck in Milwaukee. He just asked me to go in and ask for a can of Nu-Enamel and take what they gave me. I am positive then that in every one of those stores, I distinctly and audibly told the salesperson that I wanted Nu-Enamel. I didn't say that I wanted a Nu-Enamel or name the kind of enamel and didn't say Nu-Beauty Enamel. In every one of those stores with the exception of Fred Herrenbruck's without any qualification, they handed me a can which I stated I purchased in each of those respective stores.

107 ROY SCHOEN, 1705 Central Avenue, called in behalf of plaintiff, testified as follows:

*Direct Examination.*

I am Roy Schoen and I live at 1705 Central Avenue, Chicago. I heard Elmer Lampa testify in this case. His testimony is correct. Most of the time I was right alongside of him, couldn't have been any more than a foot or two away at any time. I heard him ask for Nu-Enamel. He spoke distinctly. I heard him distinctly.

*Cross-Examination.*

I am a salesman for J. Long Chemical Company. I was asked by Mr. Howard Lampa to accompany Mr. Elmer Lampa.

108 MISS HELEN DIASIO, 733 North Central Park Avenue, Chicago, called in behalf of plaintiffs; testified as follows:

*Direct Examination.*

My name is Helen Diasio and I live at 733 North Central Park Avenue, Chicago. At the present time I am employed as stenographer for Victor Animatograph Corporation. I was employed some time ago to call at certain stores in and about Chicago and ask for Nu-Enamel, and to accept any product that was offered me in response to such request. I was employed by Mr. Howard Lampa on the 6th of January, 1936. I made a shopping tour accompanied by a young lady by the name of Isabelle Burroughs. We went into these stores and asked for a can of Nu-Enamel.

On January 6, 1936, at 3438 Lawrence Avenue, I asked for a can of Nu-Enamel and the gentleman who waited on me handed me a can of New-Beauty Enamel and I paid for my enamel and left the store.

We next went to the Admiral Electric Company, 3937 Lawrence Avenue. I asked for a can of Nu-Enamel, the gentleman handed me New-Beauty Enamel and, well, I didn't ask, but the girl with me asked for it but I have it written down here that I did that. The young lady with me asked "Is this New-Beauty Enamel" and the man said "Yes, Armstrong's New-Enamel."

At 5611 Lawrence Avenue, I asked for a can of Nu-Enamel and the gentleman walked over to a display of New-Beauty Enamel and looked around for a can. I asked him for a can of black enamel, and I said "Do you sell this for the same thing." He walked up to the New-Beauty display. He says "Yes, it is the same thing." And I didn't purchase anything here because he didn't have the color I asked for.

109 The next was Irving Park Radio, 4023 Irving Park Boulevard. I did the same. I asked for a can of Nu-Enamel, he walked over to the New-Beauty display and again he couldn't find the size I wanted so I didn't get anything there. He had New-Beauty Enamel on display. He looked through that lot of New-Beauty Enamel for the product, I asked for.

At Ristow Electric Company, 3608 Irving Park Boulevard, I asked for a can of Nu-Enamel, and the gentleman handed

me New-Beauty Enamel without an explanation. I also received a color chart at this store. This is the can I purchased there. I wrote the name on there when I left the store and the date and my initials are on the can.

At Wonder Radio Store, 3150 Irving Park Boulevard, I asked for a can of Nu-Enamel, and the gentleman gave me New-Beauty Enamel. I received no explanation whatever.

At Heinemann Brothers, 1802 Irving Park Boulevard, I asked for a can of Nu-Enamel, small size black color. The gentleman couldn't locate black, but I bought royal blue as a substitute.

At A. F. Frome, 6132 Broadway, I asked for a can of Nu-Enamel and the gentleman explained "This is the best we carry right now, it is Armstrong's New-Beauty Enamel." That is all, I left the store and didn't purchase it.

At Spiegel's, 4826 Milwaukee Avenue, I asked for a can of Nu-Enamel and the gentleman handed me New-Beauty Enamel and I purchased it.

At Milwaukee Auto Supply, 3184 Milwaukee Avenue, I asked for a small can of Nu-Enamel, and the gentleman says "We have a different kind which is called New-Beauty Enamel, this is much better," and I said "It is made by the same company"? The gentleman said: "No, this is made by Armstrong."

110 At Dave Reid's Electric Shop, 4341 Fullerton, I asked for a small can of Nu-Enamel. The gentleman handed me New-Beauty Enamel without an explanation. I purchased this.

At Armitage Appliance, 3551 Armitage, I asked for a can of Nu-Enamel again, the gentleman said: "We carry the New-Beauty Enamel. It is much better."

At Latsis Drug Store, 841 South Oak Park Avenue, Oak Park, I asked for a small can of Nu-Enamel and the gentleman handed me New-Beauty Enamel without explanation. I purchased this.

At Arbor Window Shade, 1737 East 75th St., I asked for a small can of Nu-Enamel and the gentleman walked over to the New-Beauty display and inquired if I needed a brush or a booklet. I bought the New-Beauty Enamel and the gentleman explained no difference about the brands.

At Lindgreen Radio Company, 1316 East 63rd Street, I asked for a small can of Nu-Enamel black, the clerk sold me New-Beauty Enamel. No explanation was given.

At Hdye Park Radio, 1519 East 55th Street, I asked for a



small can of Nu-Enamel, the gentleman sold me New-Beauty Enamel and gave me the stick for stirring enamel. The name New-Beauty Enamel appears on the stick.

At Grove Hardware Company, 748 East 63rd Street, I asked for a small can of Nu-Enamel, the gentleman asked me what color I wanted and I told him black. Then he asked if I wanted to buy a brush and I said no. And I paid for the New-Beauty Enamel and walked out.

At Ellison & Company, 6518 South Halsted St., I asked for a can of Nu-Enamel and the gentleman handed me a can of New-Beauty and this time explained that there was a change in the price, it is 40 cents now and used to be 55 cents, 111 so I purchased the enamel which he handed me. It was Armstrong's New-Beauty Enamel.

At Vance Color Studio, 7851 South Halsted St., I asked for a small can of Nu-Enamel, and the gentleman asked me what I was going to use it for. I said "Oh, I just wanted to use it for some painting I was going to have." He says "Do you want a brush?" I said "No." So I got the New-Beauty Enamel. This is the stick he handed me at that place.

At Beverly Appliance Company, 9100 South Ashland Avenue, I asked for a small can of Nu-Enamel and the gentleman asked me what size. I told him I wanted a quarter pint size. He walked over to the New-Beauty Enamel display and says "Let us see, now there has been a change in the price, if I can find the list. Oh, yes, it has been reduced 15 cents, it is 40 cents now." He says, "Here is your stick and everything" and handed me New-Beauty stick, pamphlet and receipt.

At Modern Home Appliance, 1739 West 63rd Street, I asked for a small can of Nu-Enamel, and the gentleman handed me New-Beauty Enamel with a pamphlet and stick and asked if I knew how to use it. He says "The pamphlet I will give you will explain how it is used. It also has a color chart with it." I paid for the New-Beauty Enamel.

At Braebec's Department Store, 2001 West 53rd Street I asked for a small can of Nu-Enamel and he asked me what price I wanted and I said just a small can. He said "All right." Then he walked over to the New-Beauty Enamel display and said "This is the best you can buy, it does a good job, my wife painted a bird cage yellow and black and it looked swell." And I got the New-Beauty Enamel.

112 At Barcel's Paint Store, I asked for a can of Nu-Enamel. The address is 3511 West 26th Street. The gentleman walked over to the New-Beauty Enamel display



and asked me if the quarter pint size is all right, then explained that there had been a reduction in price.

I didn't make any more purchases. In all the stores where I called, I asked for Nu-Enamel. I spoke distinctly. A young lady by the name of Isabelle Burroughs accompanied me.

(The purchases identified by this witness were received in evidence, as PLAINTIFFS' EXHIBITS N-8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 17-A, 18, 19, 20, 20-A, 21, 21-A, 22, 23 and 24.)

*Cross-Examination.*

In each of the twenty-three instances of purchases that I made January 6th, 7th, and 8th, 1936, inclusive, I knew that what I bought was Armstrong Paint & Varnish Company's enamel and not the enamel of the Nu-Enamel Corporation. I understood that I was getting the product that I asked for. I asked for Nu-Ena. and I was to purchase whatever was handed me. When it was handed to me I knew I was not getting the product of Nu-Enamel Company.

HOWARD LAMPA (recalled):

*Direct Examination.*

This last witness testified that she was accompanied on her shopping tour by Isabelle Burroughs. I tried to locate her last week and found she had moved with her mother to California.

113 BARBARA THORNE, 1318 Astor Street, Chicago, called in behalf of plaintiff, testified as follows:

*Direct Examination.*

I am Barbara Thorne. I live at 1318 Astor Street. I was employed at one time to shop certain stores and call for Nu-Enamel, and to accept any product that was offered me in response to such calls. I was employed by Mr. Lampa of Rogers, Woodson and Rogers. I was accompanied by Miss Gill.

I went to Markez Paint Store, 3438 Lawrence Avenue and

asked the clerk for a small can of black Nu-Enamel. The clerk walked to the display of New-Beauty Enamel and brought back a can of that product, noting something about New-Beauty Enamel, I couldn't understand the exact words, but he wrapped that up and gave it to me.

He said something about New-Beauty Enamel but I didn't get the exact words he said.

At Spiegel's Sporting Goods store at 4826 Milwaukee Avenue, I asked the clerk for a small can of Nu-Enamel color green. She approached the display of New-Beauty Enamel, asked what shade of green showing me a spool of the shade of green. After discussing the color, I decided to take a can that she offered me and she gave me a can of New-Beauty Enamel. She explained that the price was 40 cents, adding that it formerly sold for 50 cents. She gave me a stick in that store. It has the name New-Beauty Enamel on the back.

At Harley Refrigeration Company, 5611 Lawrence Avenue, I entered the store and asked the clerk for a can of Nu-Enamel. He approached the New-Beauty Enamel exhibit asking what color I wished, and I said green. He gave me this can of green New-Beauty Enamel, together with a paddle, explaining that it should be stirred thoroughly before using.

At Dave Reid's Electric Shop, 4341 Fullerton, I entered the store and asked for a can of Nu-Enamel and the clerk presented me a color chart of New-Beauty Enamel, and I selected the color red, and he gave me a can of New-Beauty Enamel, instruction chart and paddle.

At Irving Park Radio & Electric Shop, 4023 Irving Park Boulevard, I entered the store and asked for a can of Nu-Enamel. The clerk asked what color and I said red. The clerk walked to a display of Nu-Beauty Enamel, showed me the spools of different colors, and I chose Mandarin red. In wrapping a can of New-Beauty Enamel he included a paddle and explained that New-Beauty was coming out with a house paint that only required one coat. Also explained that you could put a hot pan on the paint without harming it.

At Van's Color Studio, 7851 South Halsted St., I entered the store and asked the clerk for a can of Nu-Enamel. He asked what color and I answered "white." Then he suggested Mandarin red and asked what I wished to use it for and I said the top of a table. He showed me a color spool of New-Beauty Mandarin red; said the color was correct, and he wrapped up a can of New-Beauty Enamel.

At Beverly Appliance Company, 9100 South Halsted St., I asked the clerk for a can of Nu-Enamel, he immediately repeated "Nu-Enamel, yes, how much do you want"? I answered: "A small can." He suggested we pick out the color and pointed to an exhibit of New-Beauty Enamel. After selecting the color, which was bright blue he asked if we had a ticket. I asked what ticket and he said a ticket clipped from a newspaper. I answered no, and he explained that we got a discount if he had this ticket. The receipt that I got there reads: "One can of New-Enamel, N-e-w." The word "Beauty" isn't in it.

At Ellison & Company, 6518 South Halsted St., I entered this store and asked the clerk for a can of Nu-Enamel. The clerk repeated the name, Nu-Enamel and said "This way", leading up to a display of New-Beauty Enamel. She asked the color and I answered "Pale green". She showed us the color spools, I made a selection of a color and took the can of New-Beauty Enamel, she wrapped it.

At Grove Radio & Music Store, 748 East 63rd St., I entered the store and asked for a can of Nu-Enamel. The clerk led us to the exhibit of New-Beauty Enamel pointing to the color spools and asked what color we wished. I selected a green shade. She asked me the size and I specified a small can.

At Lundgren's Radio Store, 1316 East 63rd St., I entered the store and asked for a can of Nu-Enamel. The clerk immediately went to the shelf of New-Beauty Enamel and asked what color I wished. I said bright red. She took down a can of New-Beauty Enamel of Mandarin red, and that is what I purchased. The clerk gave me a paddle in that store.

When I went into these stores and spoke to the clerks, I endeavored to speak distinctly and I did speak distinctly. I asked for Nu-Enamel and in some instances the clerks repeated after me "Nu-Enamel." (The products purchased by this witness were received in evidence as PLAIN-TIFFS' EXHIBITS 25, 26, 26-A, 27, 28, 28-A, 29, 29-A, 30, 30-A, 31, 31-A, 32, 33, 34 and 34-A.)

*Cross-Examination.*

At the time the packages or cans were delivered to me I knew in some instances that I was getting the product of the Armstrong Paint & Varnish Works, and not the product of the Nu-Enamel Corporation. In some cases when I asked for

it, I didn't see the can. Frequently I got out of the store. They just took it down and wrapped it. In a couple of cases I knew the can came from a display of New-Beauty Enamel. I first discovered it when I was out of the store and looked at my purchase.

117 BEATRICE NEWKOM, 6060 North Paulina, Chicago, called in behalf of plaintiffs, testified as follows:

*Direct Examination.*

My name is Beatrice Newkom of 6060 North Paulina, Chicago. I am employed at the present time at Kemper Insurance Company in the payroll auditing department. I was employed to shop in stores in Chicago and ask for Nu-Enamel. I was employed by Howard Lampa. I was accompanied by Lillian Jones. I made notes of my shopping.

On September 8, 1936, at 2:35 P. M. I went to the Van's Color Studio at 7851 South Halsted Street, and I asked the man to give me one can of white Nu-Enamel. The clerk repeated my question and said "Can of white Nu-Enamel." I said "Yes, please." The clerk wrapped up a can of New-Beauty Enamel and said "Forty cents" and I paid forty cents with the tax. This is what I purchased.

On the same day, at 11. 5 A. M. I went to the Latsis Drug Store, 841 South Oak Park Avenue, Oak Park, Illinois. I asked for one can of white Nu-Enamel. The clerk repeated "White" I said "Yes, please." The clerk went to the cans of New-Beauty Enamel and asked me if the 40 cent size was all right. I replied yes. He wrapped it up and I gave him forty cents. This is the can I purchased there.

On September 9, at 12:15 P. M., I went to the Riverside Electric Company at Riverside, Illinois, and asked the clerk to give me one can of blue Nu-Enamel. The clerk said "Blue Nu-Enamel". "Yes, please." The clerk showed me a sample of the color and asked me if that was what I wanted  
118 and I replied that it would be satisfactory. I paid him forty cents. This is the can I purchased there.

On September 9, at 1:55 P. M. I went to Breen Home Utilities,—McBreen Home Utilities, 156 Broadway, Melrose Park, Illinois, and asked for one can of white Nu-Enamel. The clerk said "Yes, what color." I said, "White, please." "What

size?" I replied "The smallest please". The clerk wrapped a can of paint, and I paid him forty cents. This is the can of New-Beauty Enamel I purchased there.

On September 9, at 2:50 P. M. I went to the Admiral Electric Repair Shop at 3937 Lawrence Avenue, I asked for one can of white Nu-Enamel. The clerk said "Sorry, but we are all out of white, we use it up as fast as we get it." I said "Well then give me one can of blue." The clerk showed me the card, and a sample of blue on the card, and asked me if it was all right. I said it was, and asked how much the can of paint was, and the clerk said 40 cents which I paid him. This is the can I purchased. The clerks in these stores wrapped the cans up and handed them to me. I spoke distinctly in all these stores. In none of the stores did the clerks tell me they were selling me New-Beauty Enamel and not Nu-Enamel.

(The purchases made by this witness were received in evidence as PLAINTIFFS' EXHIBITS 35, 36, 37, 38 and 39.)

*Cross-Examination.*

In each instance when I made each of these five purchases, I saw the clerk take the can that I testified to from the 119 shelf or display. I saw the can just as I see it here. I knew at the time I purchased it that I was purchasing a can of enamel not made by the New Beauty Corporation, or the Armstrong Paint & Vanish Works. I couldn't say for sure if the charts which the various clerks showed me had printed on them New-Beauty Enamel.

LILLIAN JONES, 4363 Greenwood, called in behalf of the plaintiffs, testified as follows:

*Direct Examination.*

I am Lillian Jones, 4363 Greenwood Avenue, Chicago. I just heard Beatrice Newkom testify. I accompanied her on that purchase tour. (Counsel stipulated that she would testify the same as Beatrice Newkom.)



RUTH E. ROBBINS, 1656 Farwell Ave., Chicago, called in behalf of the plaintiffs, testified as follows:

*Direct Examination.*

I am Ruth Robbins and I reside at 1656 Farwell Avenue, Chicago. I was at one time employed to shop certain stores in Chicago by Howard Lampa. He told me to go in and ask for a can of Nu-Enamel, and I was to take whatever was given to me and leave the store. I did that shopping for him, on January 9, 1934. I made notes at the time. I was accompanied by Marian Caesar.

I first went to the Ray Miller Appliance Company, 7851 South Halsted Street, Chicago, about 9:20 A. M. I went to the store and asked for a can of cream color Nu-Enamel. The clerk walked over to a rack of New-Beauty Enamel, selected a can and said he didn't have cream, but he had bisque color.

I said that was the same shade. He told me it was forty 120 cents, he made out a bill, I paid him 41 cents and left the store. This is the can I purchased. This is the receipt I received.

I then went to the Latsis Drug Company at 8414 Oak Park Avenue, Oak Park, Illinois. That was the same date at 1:45 in the afternoon. I entered the store and told the man I wanted a small can of black Nu-Enamel. He went over to a rack of New-Beauty Enamel. Said he didn't have black. I then asked for a bisque color which he had, I said I could use that for trimming. Asked him the price which he said was 40 cents and the tax, I paid him and left the store. This is the can I purchased.

The next was McBreen's Home Utilities Company, 156 Broadway, Melrose Park, Illinois. That was the same day at 4:05 in the afternoon. I entered the store and a girl waited on me. I asked for a small can of bisque color Nu-Enamel. She immediately went to a shelf and brought a can of New-Beauty Enamel. A man in the store who looked like he might be the manager or proprietor showed me a New-Beauty color chart and said "That is a fine product." I paid the girl and left the store.

*Cross-Examination.*

Mr. Lampa told me to go to these three stores. I didn't go around indiscriminately. At the time I was given the can of enamel in each case, I knew it wasn't the can I was asking for. When I asked for Nu-Enamel, I did not spell out the Nu, N-u. But I said it very distinctly, I said Nu-Enamel.

121 (The purchases identified by this witness were received in evidence as PLAINTIFFS' EXHIBITS 40, 40-A, 41 and 42.)

MARIAN CAESAR, 1436 Sherwood Terrace, Chicago, called in behalf of plaintiffs, testified as follows:

*Direct Examination.*

My name is Marian Caesar and I reside at 1436 Sherwood Terrace.

(Counsel stipulated that she would testify both on direct and cross as the former witness.)

FRANCES SMITH SWANEY, 6402 North Damen Ave., Chicago, called in behalf of plaintiffs, testified as follows:

*Direct Examination.*

I am Frances Smith Swaney, and reside at 6402 North Damen Avenue, Chicago, I was instructed by Howard Lampa to call at certain stores in Chicago and ask for Nu-Enamel. I was to accept what was offered me in response to that request. I did some shopping on January 11, 1937. Jane Hileman accompanied me.

The time was 10:20 A. M., the place McBreen's Hardware store, the address Melrose Park, 156 Broadway. We went into the store, a young woman accosted us and asked us what we would like and we told her we wanted to buy a small can of Nu-Enamel. She asked us what color and I said I would like a green. So she got out her chart and asked what color green we would like, and we chose the apple green. This is the can I purchased there. The label says New-Beauty Enamel.

At 11:30 A. M., 1-11-37, we went to 7851 South Halsted

Street, Mr. H. L. Miller Appliance Company, talked with a 122 man that I apparently took to be working there and asked him for Nu-Enamel. He repeated after us, and he sort of looked around at first, then finally came out with a chart, color chart and I showed the color I wanted, which was apple green. He went to a rack and brought out the color I asked for. This is the can I purchased. The clerk repeated after me "Nu-Enamel." I asked for Nu-Enamel and he repeated "Nu-Enamel." I made no other purchases. (The product was New-Beauty Enamel.)

(These packages were received and marked PLAINTIFFS' EXHIBITS 43 and 44.)

*Cross-Examination.*

When I went to the Miller store the clerk or salesman went to the rack from which he obtained a can. I don't recall whether the rack had on it a sign New-Beauty Enamel. I knew that it was not Nu-Enamel when I got out in the car to make my notation on the can. I didn't know it when the salesman took it off the rack. There wasn't a sign on the rack. I didn't notice what was on the color chart that was shown to me by the McBreen hardware Salesman.

JANE HILEMAN, 5759 Winthrop Ave., Chicago, called in behalf of Plaintiffs, testified as follows:

*Direct Examination.*

My name is Jane Hileman and I live at 5759 Winthrop Avenue. I heard the previous witness testify. I accompanied her when she made those purchases. I was close to her when she made those purchases, right next to her. I heard her say Nu-Enamel emphatically and distinctly.

123 W. J. NELSON, 1024 Randolph St., Chicago, called in behalf of Plaintiffs, testified as follows:

*Direct Examination.*

I am at present employed by the Nu-Enamel Corporation as sales promotional manager. I have been with the Nu-Enamel Corporation since the early part of last June. I

was previously employed by that company—not by the Nu-Enamel but by the eastern Nu-Enamel Company in New York. That is an affiliated company with the Nu-Enamel Corporation of Illinois. I was employed by that company in July of 1934 until April—no March 1st of 1935. I went to the company there with a desire to go into business as a distributor in Boston, with a Boston distributor, and my deal there fell through, after two or three weeks, I came back to Chicago. I was employed prior to being employed by the Nu-Enamel eastern company by the Duralith Corporation of New York. I had duties as assistant sales manager, and the last year as sales manager of the corporation. Prior to being employed by the Duralith Company I was with the Vacuum Oil Company from 1923 to the spring of 1931. I started in with the corporation, with the company, as special representative, and the latter five years and eight months, I was division manager of the northwest division. I was employed by the Armstrong Paint & Varnish Works, the defendant in this case. I was with that company approximately a year. My duties with that company were to employ dealers and have charge of development and sale of New-Beauty enamels. I was employed in that organization by Mr. Van Antwerp, vice-president and general sales manager of Armstrong Paint & Varnish 124 Company. Before I was employed I conferred with other officials of the company.

Mr. Van Antwerp and I had a long talk, we talked till very near 5:30 in the evening. He asked me to come back the following day at 11:30, which I did. I came back the following day and in the interim of that time to the lunch hour, he introduced me to several officials of the company and asked me to have lunch with them in the pent house, and we proceeded to have lunch. Mr. Van Antwerp introduced me to the various executives of the organization as the former sales manager of the eastern Nu-Enamel Company, and that I was no longer with the organization and he had had some talks with me. Immediately after lunch all of these eight or nine gentlemen talked at random, asked me all kinds of questions about Nu-Enamel business, its development, its procedure, its policy, sales volume, the manner of distribution, display, type of dealers we sold, why, success of same, and so forth. And we talked for possibly two hours, and when we broke up from the luncheon table, Mr. Van Antwerp asked me to return again the following day, which I did in the afternoon. And that day I was hired.

I was hired to devote all of my time and effort to the promotion, development and sale of New-Beauty Enamel. At the time he employed me he told me he was not quite ready to start it at that time, that he had some changes he was making and some things were not in quite the shape to proceed, and we set the date for June 3rd to start my employment. Mr. Van Antwerp gave me my instructions as to my duties. My instructions were to build and develop a New-Beauty department, for the Armstrong Paint Company. He explained the various set-ups of various organizations they had within the organization. He assured me there was a definite future with the organization, and I could put over this proposition, I had a very exceptional future; that their own men had tried to put this line over from the first of the year and had not succeeded. Then when I started my work, I went to Mr. Van Antwerp for instructions, and Mr. Van Antwerp turned me over to his assistant, Mr. Sappington; so Mr. Sappington and I had a talk at length, and I immediately started.

I was told that they were not capable of instructing me, with the experience I had in developing Nu-Enamel, but told me they were going to look to me for suggestions and instructions. They told me I would have to use my own initiative and they were depending on me to put this proposition over in the same manner Nu-Enamel had been put over. I was told that they had no definite policy outlined, and that Nu-Enamel had done an outstanding job in that specialty field, and that I knew more about that than they did, that I should use my own judgment, develop it and put it over on the same basis if necessary.

When we discussed policy I definitely stated there was only one way to put this thing over, and that was the Nu-Enamel way, and they said "Go ahead, do it that way." I was asked by Mr. Sappington whether I had any Nu-Enamel's sales matter and I told him I did. He said he would like to see it. I brought it the next day and gave it to him and I haven't seen it since. When I handed this to Mr. Sappington he said "Oh yes, I have seen all of that." I handed him our complete sales talk that we presented to our men, worked out by questions and answers; the manner of selecting a dealer, and how to approach, and in what manner to sell, educate the dealer to sell the merchandise.

I proceeded to develop that department on the same lines that I had, the same methods, I had used for Nu-Enamel. The methods I used out there that I had used with Nu-Enamel



were selecting particularly retail merchants that were new in the line and giving a demonstration of the product, display materials and educating them to sell not from the price per can basis, but the price per job basis.

I proceeded to employ dealers. I told the dealers that I was selling New-Beauty Enamel. When I would mention New-Beauty Enamel, the dealers would say something about Nu-Enamel. The location I picked out for a dealer was most always in the vicinity of a Nu-Enamel store or Nu-Enamel dealer. It was my practice in selling.

I have been in the stores of dealers handling New-Beauty Enamel when customers came in and asked for Nu-Enamel. Dealers would sell Nu-Beauty Enamel on calls for Nu-Enamel. I say that myself. I saw dealers in stores handling New-Beauty Enamel sell New-Beauty Enamel sell New Beauty Enamel on calls for Nu-Enamel. I saw that, I would say by most of the dealers I called back on during the promotion of the business. The dealers that I saw do this were the Walker Company in Oak Park; Riverside Electric in Riverside; the Latsis Drug Store in Oak Park. I don't remember all of the various dealers. McBreen Electric particularly, Home Appliance; Anderson Company Hardware in Sycamore; and Mochel Hardware Company in Downers Grove, who was formerly a Nu-Enamel dealer. When customers came in and asked for Nu-Enamel, they sold New-Beauty Enamel.

127 In promoting the sale of New-Beauty Enamel, I used the Nu-Enamel plan entirely. I used their sales literature verbatim with the exception of changing the name of the company. I am familiar with that color card. That is the color card used by Nu-Enamel corporation. That color card was used by Armstrong Paint & Varnish Works. I first saw the color card of the Nu-Enamel Corporation in 1934. I mentioned to Mr. Fisher, the advertising manager, the similarity of these two, the design on those two color cards. I said "That is a copy of the Nu-Enamel girl." He said "We just straightened her up a little bit and gave her the sign to hold."

(The color cards identified were offered in evidence and marked PLAINTIFF'S EXHIBIT O and P.)

The prices correspond to the prices used by Nu-Enamel. They were identically the same as Nu-Enamel prices, at the time I started my employment there. I was instructed to have the prices the same. The prices were not set by me, they were set before I came there. I had a discussion with officials

regarding the price being the same. About sixty or ninety days later, I would say, possibly in September or October, I was in Mr. Goldsmith's office, and he asked me about prices, and I told him I thought one of the most,—I had been informed about the suit, and I told him one of the most obvious things in copying was the prices of Nu-Enamel, that they were copied identically the same in price per can, and that ought to be changed, and very shortly after that, it was changed. Mr. Goldsmith is president of the company.

The Armstrong Paint & Varnish Works were receiving the house organ put out by Nu-Enamel Corporation. One of the first things Mr. Van Antwerp told me was that he 128 had a copy of that Nus away back, he was getting it from a friend of his on the South Side, and that he had followed the progress and development of the company through the Nus. Mr. Sappington said several times that Nu-Enamel had made the public enamel conscious, and that we were going out to get their share of that business created by the demand for Nu-Enamel. It was the custom in and around the offices of the Armstrong Paint & Varnish works in referring to New-Beauty Enamel to call it Nu-Enamel as often as it was called New-Beauty Enamel. It was general unless one was specific in his conversation to distinguish between the two.

Mr. Goldsmith told me, as well as Mr. Van Antwerp and Mr. Sappington, that we had to soft pedal these New-Beauty merchandising ideas until this suit was over, and that Mr. Goldsmith hesitated to go ahead with the proposition. They called Mr. Armstrong the skipper. They said the skipper was very much worried about it. They told me to tone down in carrying on the New-Beauty establishment of dealers and distributors and asked me to go into the full line, sell the full line of Armstrong products under other brand names. At one time Mr. Van Antwerp said "I don't want this copying of Nu-Enamel ideas too evident."

In calling on dealers, the more substantial dealers, such as Marshall Field, the Davis Company, and Walkers, that I had sold, I inspired the confidence of having them put my line in due to the fact that I had been formerly connected with the Nu-Enamel Company, and I showed my sales manager's card, which created respect and confidence that they knew what I was talking about.

129. That was the Nu-Enamel card that I had when I was formerly employed by the affiliated company to the Nu-Enamel Corporation. The Armstrong Paint & Varnish Works

knew that I was carrying those Nu-Enamel card. They all knew it. There was no objection made.

When they told me to slow down on this copying, or this carrying along on the same plans as Nu-Enamel, I was offered a position to promote the general line of products. I was instructed to slow down on the pushing of New-Beauty Enamel.

We had a dealer stand, or dealer set-up, color panels and all of such materials that went along, and some painted pieces, a similar display to the Nu-Enamel display. We employed demonstrators. Mr. Sappington did the hiring of most all of them. I didn't hire any of those. I had nothing to do with the handling of the demonstrators, Mr. Sappington had that. Evidently two of them that were employed were Nu-Enamel demonstrators. As far as I know they came direct from the Nu-Enamel Company. They went into the employ of Armstrong to demonstrate their New-Beauty Enamel.

I left the Armstrong Paint & Varnish Works the latter part of May, 1936. I had accepted a position with the Dudley Lock Corporation as sales manager. I accepted a position with this Lock Company before I gave up my position with Armstrong.

I entered the employment of the Nu-Enamel Corporation about the second week of June, I believe, or the third week in June, 1936. I was in the office a few days, and went to Canada immediately. I never before worked in the Chicago office. My work had been in the east.

Counsel for defendant moved that the testimony of this witness be stricken and the court permitted the testimony to remain in subject to defendant's objection.

130

*Cross-Examination.*

I commenced working for the Nu-Enamel Corporation of Delaware within a few months after I left the employ of Armstrong in May 1936. I did not tell the Nu-Enamel people of my conduct during the time I was with the Armstrong Paint & Varnish Works as sales manager pushing the New-Beauty line. I had been with the Nu-Enamel Company of Illinois, or eastern Nu-Enamel, before I entered the employ of the Armstrong Paint & Varnish works in May of 1935. I was not a plant sent over by the Nu-Enamel Company. I solicited them for a position. They did not seek me.

At the time I was told to push the New-Beauty line, it was then spelled N-e-w. This color chart marked Plaintiffs' Ex-

hibit P is spelled N-e-w. That came out after I was there. I did not see any heading on this color chart New-Beauty Enamel, spelled N-u. I compared the designation of colors on the New-Beauty color chart, N-e-w, with the designation of the colors of the Nu-Enamel color chart; the tints were not identical but the color classification was the same.

Plaintiffs' Exhibit O, a color chart of the Nu-Enamel Corporation was used in 1934 in New York. They were universally used in one part of the country or the other. I have seen color charts gotten up by the Armstrong Paint & Varnish Works to illustrate the colors for New-Beauty Enamel. I compared the designation of the colors on the two color charts. It is a fact that, in practically every instance, the colors are designated and named differently. The color on Nu-Enamel color chart is different, a different name than the color on the New-Beauty Enamel chart.

131 I remember seeing the statuettes, a reproduction of which appears on this color chart marked Plaintiffs' Exhibit P. The statuettes were all one size as far as I knew. They were used as part of New-Beauty display in various stores and also exhibited in windows. They were approximately 42 inches high. Marshall Field & Company had them in their New-Beauty display, all but the figure. The Davis Store had the figure. Many hardware, drug stores and household stores had this figure. As far as I know that reproduction of a figure that the Armstrong Paint & Varnish Works used, was in connection with the New-Beauty Enamel display.

I can't say that Mr. E. R. Armstrong, Chairman of the Board of the Armstrong Paint & Varnish Works, whom I refer to as the skipper, knew that I was calling on prospective customers of the Armstrong Paint & Varnish Works, and displaying a card that I had showing that I was sales manager for the Nu-Enamel Corporation but Mr. Sappington and Mr. Van Antwerp knew, they were my superior officers. Mr. Van Antwerp did not tell me to avoid doing anything that might appear or be looked upon as an attempt to copy the methods of the Nu-Enamel Corporation, I am positive of that. I don't know whether Mr. Goldsmith, President of the company, knew that I was calling on trade, prospective customers, and exhibiting my card as sales manager for Nu-Enamel Corporation. When I called on the buyer in the paint department of Marshall Field & Company of Chicago, I exhibited to that buyer my card showing I was formerly connected as the sales-



manager of the Eastern Nu-Enamel Corporation. He  
132 said "If you have had Nu-Enamel experience, I am will-  
ing to listen to you. I told him that I was going to put in  
a product that in the method of advertising, display and  
ability to deceive was going to approximate that of the Nu-  
Enamel product. He replied that "If this was Nu-Enamel,  
I would make the deal in a minute." He took the New-  
Beauty deal. In the display in Marshall Field & Company's  
it showed New-Beauty, spelled N-e-w. The name Armstrong  
appeared very prominently above all of the signs; similar to  
the manner in which it appears on the color card, Plaintiffs'  
Exhibit P. Everywhere the name Armstrong appeared on the  
advertisements. The word New-Beauty was the word promi-  
nently displayed on all of the advertisements and it is on  
the reverse page of this color chart.

I showed my sales manager card of Nu-Enamel when I  
called on the buyer of the paint department of the Davis Store,  
Chicago. I told him that I was now with the Armstrong Paint  
& Varnish Works in the beginning and he refused to listen  
to me. He said he was not interested in the regular paint  
line of merchandise. I told him that we were going to intro-  
duce a line that was a similar line to Nu-Enamel. I meant in  
quality and performance and merchandising. I am not in a  
position to state definitely that New-Beauty merchandise com-  
pares equally in quality with Nu-Enamel. I have been a sales  
manager and promoter for a number of years. I went through  
the plant of the Armstrong Paint & Varnish Works, before I  
went to call on customers. I visited their various laboratories  
and saw demonstrations of New-Beauty. I saw New-Beauty  
Enamel put through the various tests through which paint is  
rigidly put. I knew that New-Beauty Enamel a material

133 of very high qualities. They compared it to Nu-Enamel,  
Nu-Enamel was used as the standard of comparison of all  
enamels in the Armstrong laboratory. When I called on the  
various prospective customers, I knew, from having observed  
demonstrations in the laboratory and in the Armstrong plant,  
that it was a very good enamel. I knew Nu-Enamel was being  
manufactured by a concern called O'Brien & Company of  
South Bend, Indiana. I have never known Nu-Enamel Cor-  
poration to use any other than their own formula. In most  
all cases the Armstrong Paint & Varnish Works, in all dis-  
plays that I had anything to do with, or visited, featured  
prominently the name Armstrong over New-Beauty.

I testified that I was in certain stores of dealers in New-



Beauty Enamel and I myself witnessed transactions in which the dealers, when asked by a prospective customer for Nu-Enamel sold or delivered a can of New-Beauty Enamel. In those cases the dealer did not tell the customer it was not Nu-Enamel, but New-Beauty Enamel. I named the Walker Company in Oak Park as one of the dealers making such representations. I didn't hear one of these corps of presentable young ladies testify that she had gone to the Walker Store in Oak Park. I was in the court room when one of those same witnesses testified that she had bought New-Beauty for Nu-Enamel at the Riverside Electric Company in Riverside. I testified that Riverside is one of those stores. I also testified that Latsis Drug Company in Oak Park was one of those dealers who sold New-Beauty for Nu-Enamel, and I was in the court room when I heard one of these young ladies testify that she had purchased New-Beauty for Nu-Enamel in that drug store. I also testified that that McBreen Electric Company is one of the dealers who sold New-Beauty for Nu-Enamel and I was in the court room and heard one of these ladies so testify that she had purchased New-Beauty for Nu-Enamel. I knew they were selling it that way long before they ever called on them.

### *Redirect Examination.*

I did not know of this law suit when I applied to Armstrong Paint & Varnish Works for a position. The first knowledge I had of it came through either Mr. Sappington or Mr. Van Antwerp along in September or October, I believe, in the fall, several months after. When I went with the Armstrong Paint & Varnish Works they were charging the same price for their products that Nu-Enamel Corporation were charging, identical small packages up to gallons. I commented as to the identity in prices. I made my first comment to Mr. Goldsmith, president of the company. I told him it was the most obvious copy and that ought to be changed, it was certainly a dead giveaway, and a steal. He got red in the face and never said a word. And he said "I don't know that they are identically the same prices." That was about the time I was told about the suit, the latter part of September or October. While there I maintained the same prices on Nu-Beauty Enamel that was being charged for Nu-Enamel. That didn't continue during the entire time I was there. It changed, I can't say the exact date, but it was in the late fall of 1936.

135 MILTON C. FISHER, 426 Surf Street, Chicago, advertising manager of the Armstrong Paint & Varnish Works, called in behalf of defendant, testified as follows:

*Direct Examination.*

I am Milton C. Fisher. I live at 426 Surf Street, Chicago. I am advertising manager of the Armstrong Paint & Varnish Works. I have been with them since June, 1929. The Armstrong Paint & Varnish Works was first established in 1854 by E. R. T. A. Armstrong. He was the father of the present chairman of the board of Armstrong Paint & Varnish Works. The business has continued on, continuously from that time.

I am familiar in a general way with the volume of business done by the Armstrong Paint & Varnish Works, in, say in the year 1934. The total sales in 1934 were in the neighborhood of three and a half million dollars. Let me correct that. In 1934, they were probably around three million dollars. The sales have been around three million dollars, increasing steadily each year. I would say that in 1935 they were between three and a half and four million dollars. I cannot answer what they were in 1936 but I would say that there was probably a substantial increase over that.

The Armstrong Paint & Varnish Works is located at 1330 South Kilbourn Avenue. They have an office, factory and shipping rooms, a complete plant. I would say the buildings themselves are occupying today about four acres of land, with possibly a couple more acres that have been obtained for expansion. And the Armstrong Paint & Varnish Works also controls three or four subsidiary companies, Continental

Paint Company, Republic Paint and Chicago Paint. They  
136 are selling organizations for different lines and different types of uses.

My position is that of advertising manager for the company. I am also a stockholder of the company.

The first use of the label Nu-Beauty was for a furniture cream which we used, which we brought out in the summer of 1933, I think.

DEFENDANT'S EXHIBITS A, B and C are office record and delivery ticket and factory order for the delivery to Hibbard, Spencer, Bartlett & Company of 25 dozen Nu-Beauty furniture cream, of the date of 9-11-35. These documents come from the records in our office, from the files. In Sep-

tember, 1933, Armstrong Paint & Varnish Works sold to Hibbard, Spencer, Bartlett & Company furniture cream with the label, trade-mark or trade name Nu-Beauty.

I have seen the advertisement appearing on DEFENDANT'S EXHIBIT D (being a photostat copy of a sheet from the Chicago American of September 22, 1933) particularly the lower right hand side. I prepared the advertisement. That advertisement appeared in the issue of the Chicago American on Friday, September 22, 1933. It advertised Nu-Beauty Furniture Cream. That is the same furniture cream, the same package and label such as sold in September, 1933 to Hibbard, Spencer, Bartlett & Company.

DEFENDANT'S EXHIBIT E is a counter display card for Nu-Beauty Furniture cream. It was prepared or planned by The York Company in Aurora, Illinois at our direction. I know about the ordering of this display card. It was first used in August, 1933.

137 DEFENDANT'S EXHIBIT F is a circular provided for dealers for the sale of Nu-Beauty Furniture Cream. I prepared it. That is the same Nu-Beauty cream as sold to Hibbard, Spencer, Bartlett & Company, in September, 1933. This was sold to other dealers besides. I believe that was printed in our multigraph department.

DEFENDANT'S EXHIBIT G is a newspaper ad for Nu-Beauty Furniture Cream. I think that is the same issue of which you have the photostat. It appeared in the Evening American of September 22, 1933.

There were no other products manufactured by Armstrong Paint & Varnish Works, manufactured and sold under the label Nu-Beauty, for a year after the appearance of the Nu-Beauty Furniture Cream. A year after there were Nu-Beauty Enamel, Nu-Beauty Varnish, Nu-Beauty satin finish. The Armstrong Paint & Varnish Works never manufactured or sold varnish under the trade-mark or trade name Nu-Beauty Enamel. They sold varnish under the trade name Armstrong's Nu-Beauty Varnish.

DEFENDANT'S EXHIBIT H is a label off of a gallon can of Nu-Beauty varnish. That is the label, the type of label that we used on our varnish.

I suggested the trade-mark or trade name Nu-Beauty for our products. I got the idea about 1931 or 1932, we were asked to make a line of automobile specialties, such as top dressing, hydraulic brake fluid, and a similar package line to that, and I conceived, or rather thought up the name Nu-

Beauty, but inasmuch as it wouldn't apply to the complete line such as hydraulic brake fluid, it was a name that had no significance to such a product, we just shelved it and 138 used something else at that time. When the furniture cream was brought out, why we started using the name Nu-Beauty for the furniture cream.

I know how many different brands or trade-marks under which the Armstrong Paint & Varnish Works and its subsidiary companies sell paint, varnishes, enamels and kindred products which the Armstrong Paint & Varnish Works manufactures. I can't give you the exact number. There are various classes of names, and various special names under which various products are sold. In some cases a brand name which covers a line in general, and in some cases where a product has to do a special job, there is a coined name, the purpose of which is to indicate what the product is for, or what the product does.

The Armstrong Paint & Varnish Works intended to mean by the word "Nu", N-u, in connection with Nu-Beauty that it is a coined word for the word "New", N-e-w. The meaning of the words Nu-Beauty as applied to the line of products was a description of what the product provided for a surface. The meaning of the words Nu-Beauty as we intended them was the product or products gave the surface to which the product was used, New-Beauty.

(The exhibits identified by the witness were offered and received in evidence and marked DEFENDANT'S EXHIBITS A to H, inclusive.)

#### *Cross-Examination.*

I have been with the Armstrong Paint & Varnish Works since June, 1929. Prior to that time I was in the advertising business. I am familiar with a product sold under the trademark Nu-Enamel. It is a well known product. I have seen it on sale in stores, in and about Chicago, by the name of

Nu-Enamel. I have known of Nu-Enamel since 1932 or 139 1933, I have no definite way of fixing it in my mind. I am familiar with competitors' products. I notice them as I go by. At the time I went with Armstrong Paint & Varnish Works I don't believe I knew anything about Nu-Enamel. I have no recollection of it at the present time.

We sell the following products under the name Nu-Beauty: Nu-Beauty house paint; semi-gloss; flat wall porch and floor

enamel; enamel; satin varnish; varnish; thinner, and possibly some others. We put out products other than enamel under the name Nu-Beauty.

We began using Nu-Beauty with furniture cream, as I have testified, in 1933. That was the first product. We spelled the word new, N-u. We still put it out. Now we spell the word N-e-w. We changed in February, I believe, 1935, after this suit was filed, after the first action of the court. We changed the name from Nu-Beauty Enamel, N-u, to N-e-w Beauty Enamel in February, 1935. On all products on which we were using the word N-u Beauty, after the suit was filed, we changed to N-e-w Beauty. I can't answer as to whether that product has been a big seller. I don't think it is a popular item today.

The next product we brought out under the name Nu-Beauty was the enamel. That was a year following, that would be in 1934. In August, I would say. Those other items were added to the line under the name Nu-Beauty later. Nu-Beauty varnish was made at the same time that Nu-Beauty Enamel was made, in 1934. The rest of the line was brought out in 1935, which started in the latter part of 1935. All the products that have been added to the line, in addition to Nu-

Beauty Enamel and Nu-Beauty Varnish, Nu-Beauty Furniture Polish were added after the suit was filed in 1935.

It was in the late summer or early fall of 1934 that we came out with Nu-Beauty Enamel and Nu-Beauty Varnish.

I don't believe I could give you figures on the volume of our Nu-Beauty Enamel, volume of sales on Nu-Beauty Enamel and Nu-Beauty Varnish.

I had heard of Nu-Enamel before I suggested the name Nu-Beauty for this furniture polish and for this line of products.

The defendant in this case advertised its product which it sold under the name Nu-Beauty Enamel and Nu-Beauty Varnish in 1934 by newspapers, Shopping News in Milwaukee and circulars. We changed the spelling to N-e-w Beauty Enamel in 1935. We advertised the product under that name. We advertised it by the same methods. We ran our last advertising under the name N-u Beauty Enamel and Varnish prior to the time that the original case was dismissed in this court. The suit was filed in January; we did not run any of the advertising under the spelling N-u after the suit was filed. We changed the name from N-u Beauty Enamel to N-e-w Beauty Enamel because our attorneys informed us that the case had been dismissed, and that the dismissal would



probably stand, and the name N-u or N-e-w meant very little to us. We had little choice between the two and it meant nothing to us so that we decided, inasmuch as we hadn't at that time gone to any great expense in advertising Nu-Beauty as N-u-Beauty, that we might as well change. At the time this suit was filed, in January, 1935, we hadn't advertised extensively our products under the name Nu-141 Beauty. At that time we had, at the time the suit was filed, we were I would say doing business almost solely in Milwaukee.

I said that we adopted the name N-U Beauty Enamel and N-u Beauty Varnish late in 1934. I had charge of getting up the advertising copy for our company. I got up the copy for advertising the New-Beauty Enamel. I said yesterday that I had been familiar with Nu-Enamel since shortly after I went with the Armstrong Paint & Varnish Works. I wouldn't say shortly after, I think I said around 1931 or 1932. I wasn't familiar with the product at that time. I knew that such a company existed.

Prior to 1934, when we adopted the name N-u-Beauty Enamel, our company had been putting out enamels and varnishes under some other trade-mark. Varnishes and enamels were products in our regular line. They were putting out at that time a general line of paint products, varnishes, enamels, and lacquers and all things of that sort—a general line. The product which we put out in 1934, was not a new product; we didn't at that time add enamels and varnishes to our line of products; we had been putting those out previously. The exact date that we discontinued our products under the name N-u-Beauty was, I would say, two or three days after our attorneys advised us that the case had been dismissed and that the dismissal would probably stand.

The principal slogan we used was that it was a porcelain-like finish. We also used the slogan "One coat covers" and the slogan "Leaves no brush marks." We also used the slogan "Anyone can apply it." That advertising circular is a piece of advertisement gotten out by our company. We first got it out the latter part of 1934. That circular was discontinued, insofar as we could control its discontinuance immediately after the case was dismissed.

That circular (PLAINTIFFS' EXHIBIT Q-1) is one of our circulars. It is a continuation of that circular with a change in the name—a change of the spelling is N-e-w Beauty Enamel. It was early in February after the suit had been

dismissed that we discontinued the circular. That circular shows the slogan "One coat covers; Leaves no brush marks." Our company puts out circulars at the present time advertising New-Beauty Enamel. We still use the slogan in advertising N-e-w-Beauty "One coat covers; Leaves no brush marks." We qualify it. We now say "One coat covers most surfaces." There is no qualification on this circular in regard to "One coat covers."

When our company was using the name N-u-Beauty Enamel, there were signs displayed at the stores handling the product. The signs read "Armstrong's Nu-Beauty Enamel." I would say that a store was handling our product where the sign reads just simply, "Nu-Beauty Enamel." (Witness was shown what purported to be a photograph of a hardware sporting goods store, and his attention was called to the sign reading Nu-Beauty Enamel.) That is a circular pasted in the window. We supplied dealers handling Nu-Beauty Enamel with advertising material. We supplied the same material that we supply on all our lines. We supplied them with posters like Plaintiffs' Exhibit Q and Exhibit Q-1.

### *Redirect Examination.*

I handle the advertising for all of the products of the Armstrong Paint & Varnish Works and subsidiary companies.

When we adopted N-u-Beauty for cream, furniture 143 cream, and enamel and varnish, I was familiar or was aware of the trade-mark Nu-Enamel. At that time I was familiar with other trade-marks in the paint and allied industries with the word N-u, indicating N-e-w. I have heard of a paint manufactured and sold under the trade-mark of Nu-Wall, N-u-W-a-l-l. I probably knew it existed at or about the time I adopted the name N-u-Beauty for furniture cream. I believe I had seen the trade-mark Nu-Seal in 1934 at or before the time I got out Nu-Beauty Enamel. I believe I had seen a color chart gotten out by J. E. Harris Company, Atlanta, Georgia, bearing on it a trade-mark or trade name Nu-Craft Enamel. I had seen a color chart gotten out by the Indianapolis Paint & Color Company of Indianapolis, on the cover of which appears the words Nu-Da, as the trade-mark used by the Indianapolis Paint Company. (Color cards and pamphlets of Nu-Wall, Nu-Seal, Nu-Craft and Nu-Da were here identified and marked DEFENDANT'S EXHIBITS 1, 2, 3 and 4 of this date.)

As advertising manager of the Armstrong Paint & Varnish Works, and its affiliated companies, I keep in constant touch with circulars and advertising. We subscribe for or purchase trade magazines in the paint industry. In these trade magazines, various paints are advertised.

I have heard of Burnett Chemical Company of New Orleans, Chicago and San Francisco. At the time we adopted Nu-Beauty for enamel, I had seen or heard of Nu-Sin, Nu-Stove, Nu-Lino-Leum at or before the time we adopted Nu-Beauty. (Color charts of the above products were identified and marked DEFENDANT'S EXHIBITS 5, 6 and 7 of this date.) At or before the time we adopted Nu-Beauty for enamel, I had heard of Re-Nu-It, the trade-mark of the Wadsworth Howland Company of Chicago. (Identified and marked DEFENDANT'S EXHIBIT 8 of this date.) At or before the time we adopted Nu-Beauty, I had seen or heard of the label Nu-Fun-Enamel, used by the Progressive Varnish 144 Company, Louisville, Kentucky. (Identified and marked DEFENDANT'S EXHIBIT 9 of this date.) At or before the time we adopted Nu-Beauty as a trade-mark for enamel, I had seen or heard of the trade-mark Nu-Car-To, used by the Wheeler Varnish Works of Chicago. (Identified and marked DEFENDANT'S EXHIBIT 10 of this date.) There were other trade-marks used for paint, enamels or kindred products that I knew were in use at or before the time we adopted the word Nu-Beauty as a trade mark for enamel, other than those I was asked about. There are quite a few, I don't know whether I can recall them. There is Nu-Gloss, Nu-Glo. Nu-Gloss is used for an enamel. It was in use at the time we adopted Nu-Beauty as the trade-mark for enamel. There is N-u-B-r-i-t-e, used on paint products; also Nu-Flor, spelled two ways, N-u-F-l-o-r and N-u-f-l-o-o-r, used in connection with floor paints or floor varnishes. Nu-Wall, spelled N-u-W-a-l, used as a wall finish, Nu-Blac, spelled N-u-B-l-a-c, used on a black enamel; Nu-White, spelled N-u-W-h-i-t-e, used on a white paint. I would have to think for a long time to give you a complete list. There were several others using N-u in different combinations at that time, namely, at or before the time we adopted N-u-Beauty as a trade-mark.

I am familiar with a trade-mark book issued by the National Paint, Varnish & Lacquer Association of Washington.

(DEFENDANT'S EXHIBITS 11-36 were here offered in evidence, being labels of Armstrong Paint & Varnish Works and subsidiaries, but were refused admission by the Court.

DEFENDANT'S EXHIBIT 37, being a photograph of a window display, was offered in evidence but was refused admission by the Court.)

DEFENDANT'S EXHIBIT 38 is a circular. I prepared it—in the fall of 1934. These circulars were distributed to our dealers and distributors. These were gotten out at the time we first adopted the Nu-Beauty label, N-u Beauty label for enamel. It was used in connection with advertising material that was sold under the label and trade-mark N-u-Beauty. (Said circular was received in evidence and marked DEFENDANT'S EXHIBIT 38.)

I know Mr. Nelson who testified here yesterday. He 145 never spoke to me about any advertising of the Nu-Beauty products, N-u or N-e-w. He never spoke to me about the advertising of Nu-Beauty, N-u or N-e-w enamel, in connection with the advertising of Nu-Enamel.

#### *Recross Examination.*

I have not, to any extent, been working with Mr. Levitan in preparing the defense in this case. I have talked to Mr. Levitan about the case, yes. I have supplied him information from time to time in regard to the defense of this case. I don't recall definitely whether I talked to him about interrogatories the plaintiff filed in this case, wherein we were asked to produce evidence that the word N-u had been used in connection with paints in our trade-mark. I probably did, yes. I see the files and records of my company with regard to the advertising matter. I am head of the sales department. I didn't bring in myself the labels which Mr. Levitan has produced here this morning. They were obtained for him, but not by me. I went through the files at one time and obtained the labels Nu-Wal, Nu-Seal, Nu-Craft, Nu-Da, Nu-Kitchen, Re-Nu-It, Nu-Fin and the other names. I got those labels for Mr. Levitan after the suit was filed. Mr. Levitan asked me to collect labels in which the word N-u was used as part of a paint trade mark. He made that request after the suit was filed. In regard to Nu-Wal, I believe Johnson puts it out. Johnson in Ohio. I don't recall ever having seen it on sale. I haven't seen Nu-Seal on sale. I don't recall having seen Nu-Craft on sale. I did see Nu-Da on sale. I think it is put out by the Nu-Da Products Company, located, I think, in 146 Chicago. I have seen Nu Da on sale on 22nd Street in Cicero. It is rather difficult for me to fix the date. I

didn't pay any attention to the cans. I saw it on sale as I passed the store, I saw the display. The product was an enamel. I do not recall having seen Nu-Kitchen enamel on sale. I do not recall having seen Re-Nu-It on sale any place. I do not recall having seen on sale Nu-Fun, Nu-Car-To, Nu-Glos, Nu-Gloss, Nu-Brite, Nu-Flor or Nu-Floor, Nu-Wal, Nu-Blac.

These names are in the trade-mark book which we consult continuously and we see them there as a matter of daily routine, or weekly routine, and we more or less by looking up names, fix some of them in our mind. The names you have just called off beginning Nu-Wal, Nu-Seal, Nu-Da, I have seen from the trade-mark book and that is where I became familiar with them. The name of the book is the trade-mark register of the National Paint, Varnish & Lacquer Association. I don't know whether these products that I have mentioned are on sale at the present time, or were on sale at the time this suit was filed. I have no way of knowing if any of them were on sale in 1922 or 1923.

*Redirect Examination.*

I have seen DEFENDANT'S EXHIBIT 39, the cover of which reads "Trade-Mark Book 1927" issued by the Trade-Mark Bureau of the National Paint, Oil & Varnish Association, 12 East 41st Street, New York City. I know what the National Paint, Oil & Varnish Association is—an association of paint, varnish & lacquer manufacturers, a national association. They register names of products when you provide them with proof of use of the trade mark. Armstrong Paint & 147 Varnish Works is a member of that association. It receives these books when and as they are issued. I have had access to this trade-mark book of 1927, being Defendant's Exhibit 39. There are additional issues both before and later. This is the book, and one of the books in which I have seen many of these entries marked as trade-names with N-u used in the name in the paint, varnish & lacquer industry.



C. L. LLOYD, called in behalf of defendant, testified as follows:

*Direct Examination.*

I am the same Mr. Lloyd who testified here on behalf of the plaintiffs. I am President of the Nu-Enamel Corporation of Delaware and President of Nu-Enamel Corporation of Illinois, now called the Enameline Products Corporation.

Defendant's Exhibit 40 is a circular put out by the Nu-Enamel Corporation.

GLENN H. PICKARD, 430 Eighth St., Wilmette, Illinois, consulting chemist, called in behalf of defendant, testified as follows:

My name is Glenn H. Pickard; I live at 430 Eighth St., Wilmette. My occupation is consulting chemist, specializing in the protective coating industry. I mean covering the manufacture and evaluation and use of the raw materials and the finished products of the protective coating industry, which includes paints, varnishes, lacquers, roof coating, cement, oils, and anything, in fact; that is spread out and becomes a coating to protect the surface, or beautify it, on which it is applied. I received the degree of Bachelor of Science in 148 chemistry from Columbia University in 1904.

My first position was with the Glidden Varnish Company of Cleveland, Ohio; from there I went into a consulting laboratory in a silk laboratory; then I became assistant to the Professor of Industrial Chemistry at Columbia University, where I taught, and in 1906, I became chemist and chief manager of refineries for Spencer, Kellogg Company, who are manufacturers of linseed oil. In my work there; I became acquainted with the basic principles of the protective coating industry, because linseed oil is one of the major raw materials. I was with them for four and a half years. Then I went with George D. Wetherill & Company, manufacturers of paint and varnish in the city of Philadelphia; I was with them a year and a half, about. Then I came to Chicago as chief chemist and manager of the local plant of the American Linseed Company, doing much the same work

that I did with Spencer, Kellogg, that is making the oils, refining them, carrying them out, demonstrating their use and working out problems for the industry.

At the expiration of four years service, with them, in about 1917, I opened a consulting office, which business I have continued from that time. My work there consists of furnishing consulting service to anybody who makes and handles materials relative to the protective covering industry or the paint industry. I can list among my clients such people as the National Lead Company, E. I. DuPont de Nemours & Company, Sherwin-Williams Company, Eagle-Pitcher Lead Company, Dominion Linseed Company of Canada, Brandrian-Henderson & Company.

149 I have done work for the United States Treasury Department in the State Procurement Division. They specify that commodities that they purchase for use in certain work shall be tested and certified by me.

On January 8, 1937, Mr. Mitchell Goldsmith, president of Armstrong Paint & Varnish Works called me up and asked me if I had any time and I said yes. He said "Will you please go to one of the loop stores of the Nu-Enamel Corporation and purchase five colors of their Nu-Enamel, which he specified, then make coatings of those, determining their hiding power or covering power, and then ascertain how much of the paint you can, or whether you can put on enough of Nu-Enamel to secure complete covering in one coat, and still have a perfect coat of enamel on the surface to which you apply it."

I went to a Nu-Enamel Store, 113 South Clark Street, January 8, 1937 and purchased five cans—five half pint cans. They were white, ivory, red, maroon, and orange. I paid \$5.70 for the five half pint cans of Nu-Enamel.

I took those cans to the laboratory, opened them, thoroughly stirred them, then took what we call a hiding-power chart, which has a black and white set of squares on heavy card board paper. Then I took a can of the thoroughly stirred enamel, weighed it with a brush, then laid that board in a horizontal position, applied enough paint, enough enamel to that surface so that I could no longer distinguish the black and the white square of the hiding-power chart.

Then I re-weighed the can of paint, determined the number of grams of paint that I had applied to the surface. I took the enamel or paint and ascertained its specific gravity. From

that I determined the weight per gallon of the paint, and 150 the weight that I applied, I calculated the number of square feet per gallon that would be completely covered by that particular sample of paint.

Then I took immediately following the application in a horizontal position I took these charts and pinned them up on a wall in a vertical position. Following that I took some of the same material and went through exactly the same procedure, except I did not make an endeavor to determine the amount of paint, or to make a complete covering of the surface. I put on as much of the enamel as, in my experience in paint application, I thought would stay on that panel when it was placed in a vertical position. In other words, I put on just enough so that the flowing of the paint would not break down and cause what we call curtains, runs, sags and other film failures.

DEFENDANT'S EXHIBIT 4-1 is a typical hiding-power chart, such as is used for determining the hiding or covering power of paint of all sorts and characters in the painting industry. That measurement is made, to ascertain whether or not the paint meets the specifications that call for a certain covering power, or in the factory to see that it is up to the standard of the paint itself. This is the type of panel approved by the various departments of the United States Government. This is the very same panel I have used in making tests for the Treasury Department. It is the type of panel approved by the paint industry or the concerns that I have mentioned for whom I have made tests. Defendant's Exhibit 4-1 is the same panel, the same material, the same measurements that I used in making tests of the Nu-Enamel.

151 (DEFENDANT'S EXHIBITS 42 to 53 inclusive were here offered in evidence, being panels used in testing various colors of Nu-Enamel.)

All of the paint, enamel, or whatever product appears on these exhibits 42 to 53 is Nu-Enamel which I got from the cans purchased at 113 South Clark Street, Chicago.

This panel, Exhibit 42, represents one in which I determined the amount of paint necessary to completely obscure, in a wet condition of the paint, the wet-hiding power of the black and white squares which lie underneath.

I want to make a distinction at this time between wet hiding power and dry, because the Court can still see some black and white spots. Those are not visible when wet. We have

what we call dry hiding power and wet hiding power. This was determined wet because of much greater facility. It is the common method, ascertaining the wet hiding power over that of dry hiding power, because they dry on, and if you put on too much you can't get it off, and if you do not put on enough, and wait till it dries, you have to put on another coat, so that the trade in general has assumed the wet hiding power if a panel carries enough paint on its surface to completely hide, wet. If the amount of paint was 11.9 grams, and it had hiding power of 415.6 grams per square foot when the panel was in a vertical position,—as you can see, the paint sagged, those are what a paint man calls a curtain, similar to the old scalloped curtain in the house. There the paint sags, as you see by the curtains where it ran off. That was because there was more paint applied to that surface than the paint's own physical property was capable of holding in position, holding in a vertical position.

152 Exhibit 43 represents a panel in which I endeavored to determine, to apply, the amount of paint which would remain on the panel in a vertical position. That paint did not hide wet, and does not hide now.

I repeated exactly the same performance in reference to Defendant's Exhibit 44, with this orange paint. This had a weight per gallon of 11.2 pounds and covered 635 square feet. This was spread at the rate of 781 square feet. I am referring to Exhibit 45—that was spread at the rate of 781 square feet. It has not obscured or hidden or covered the squares on the panel.

This, referring to Defendant's Exhibit 47, is the maroon. This weighed eight pounds per gallon, and was spread at the rate of 908 square feet per gallon. That paint, except for a little running and sagging here and sliding there, does not cover in one coat.

Referring to Exhibit 46, spread at the rate of 1,000 square feet, it still almost covers and is a perfect coat of paint.

Referring to Exhibit 48, ivory Nu-Enamel. This weighed 9.7 pounds per gallon and was spread at the rate of 484 square feet. It curtained and sagged and ran down a little.

Spread at the rate of 806 and did not hide completely dry.

This panel, Defendant's Exhibit 49, spread at the rate of 863 square feet per gallon is practically a perfect panel, but did not hide the surface.

Referring to Exhibit 51, red Nu-Enamel; weight per gallon



eight pounds, spread at the rate of 300 square feet per 153 gallon. It hid the surface wet, did not hide it dry and ran and sagged very badly.

Referring to Defendant's Exhibit 50, spread at the rate of 873 square feet per gallon; it has very poor hiding power and further a little too much paint was spread or applied as shown by the curtain there on that panel. That was very poor hiding.

Referring to Defendant's Exhibit 53, this is the white. Weighed 10.4 per gallon and spread at the rate of 347 square feet per gallon. Sagged, curtained and wrinkled, and had a very heavy bead at the bottom. Doesn't hide when dry.

Defendant's Exhibit 52, spread at the rate of 530 square feet per gallon does not hide but gives, except for one small curtain, a good film.

I tested six, rather than five, colors. White, red, ivory, maroon, orange and yellow. Of these six colors, the statement "One coat covers" applies truthfully only to the maroon. I have been applying paints in all sorts of tests, analytical and physical for twenty years at least.

The average user of paint, even ordinary commercial paint, particularly the housewife or the ultimate consumer who paints household articles, might apply the paint with the same care as I did but it is very doubtful if they had the skill, because skill comes with practice.

In the store in which I purchased this Nu-Enamel I saw display signs on the walls and in the windows, on the labels of the cans and generally spread about for the observation of the prospective and actual purchaser.

154 I would say that the representation One Coat Covers, which appears on the can of white, yellow, ivory, red, orange and black is not a truthful representation. I would say that the statement one coat of any Nu-Enamel color completely removes all traces of the under paint, with reference to my tests, is an untruthful statement, not demonstrable.

#### *Cross-Examination.*

Plaintiff's Exhibit 41 is a hiding power chart. That chart is composed of coated paper. Printed with black and coated with a non-absorbent coating, probably lacquer. The test I gave these products was the standard test for hiding power that is used throughout the paint industry. I would not call



it a severe test because there are a great many instances where black must be covered by light colors in ordinary commercial painting. The covering of black and white on one surface is a severe test. Black and white gives the greatest contrast of any two colors. Therefore that is the most severe test that you give for covering qualities:

In applying Nu-Enamel I did not follow the instruction chart issued by the Nu-Enamel Company. I did not make any test of this product on furniture. I didn't make any test of Nu-Enamel by applying it to furniture in a horizontal position and leaving it to dry in a horizontal position. The only test I made was on the chart, on this hiding power chart.

I don't see how it could dry in a horizontal position in a bath tub, the paint would have certainly collected in the 155 bottom of the bath tub, having run down from the sides.

So far as applying paint in a horizontal position, yes, you can apply more because the forces of gravity which cause the flowing and sagging may present spascivity enough to hold itself in position.

Whether or not this enamel would have been more favorable if applied to surfaces without contrasting colors, depends altogether over what surface it is applied. If you applied it over a black surface in refinishing chairs and tables, it would have been not one whit more favorable. The difference between black, oak and mahogany in hiding power would be scarcely discernible. Slightly yes, but practically no.

I would say that the second set of charts, that is to say, in which I tried to apply what I thought was the proper amount of paint irrespective of whether it hid or not, would be typical of how I would apply Nu-Enamel to flat surfaces.

I know paint surfaces. I know that, for instance, on the glossy surface or a dull surface, I know the effect that I would obtain, and applying the same material on a, let us say, a glossy flat surface or a dull surface, I know the effect that I would obtain, and applying the same material on a, let us say, a glossy flat surface such as re-painting an enameled chair would be identical with the results I have obtained here.

I do not think that a person applying Nu-Enamel would ordinarily apply it to a surface of one color. You redecorate striped and decorated material of all sorts.

156 Whether or not the result would be more favorable if this product were applied to a table with a one colored top, depends upon the color. The dark colors will be visible

through the coating that you apply. In other words you have a mark to shoot at.

Sometimes in painting ordinary furniture, you would have the contrasting colors that we have on this chart.

*Redirect Examination.*

Defendant's Exhibit 54, is the can of light red Nu-Enamel I purchased on the date stated on direct examination at 113 South Clark the contents of which was used in making the test, Defendant's Exhibits 55, 56, 57, 58 and 59, being the cans of orange, maroon, ivory, white and lemon, were likewise purchased at the same place on the same date and used in making the tests above testified to.

I testified that whether or not furniture could be painted and covered with one coat of all of these six colors with the exception of maroon, depended on the color of the furniture.

In the windows of the store at 113 South Clark, I noticed particularly a radio cabinet half finished with ivory, claimed to be Nu-Enamel, and half original walnut, I think, color, a dark brown natural walnut finish. It was half covered with ivory. I saw the unfinished part of the radio. I will state that one coat of ivory Nu-Enamel would not cover the unfinished part of that cabinet.

157

*Recross Examination.*

I know from the hiding power of the enamel as demonstrated by my own experiments, that it hasn't the covering capacity to hide that type of finish in one coat on vertical surfaces in particular, but not even on horizontal surfaces. I did not see it done. That is merely my opinion.

C. L. LLOYD, called in behalf of the defendant, testified as follows:

*Direct Examination.*

DEFENDANT'S EXHIBIT 60 is Nu-Enamel Nus magazine issued on June 20, 1935, by the Nu-Enamel Corporation.

EDWARD B. KAN, Chicago, Chinese Interpreter, called in behalf of defendant, testified as follows:

*Direct Examination.*

My name is Edward B. Kan. I live in Chicago, Illinois. I am employed by the United States Government as Chinese Interpreter, in the Immigration Service. I have been Interpreter since 1909. I have had Chinese and English educations equal to High School.

On page 24 of Defendant's Exhibit 60, the characters above the word Nu-Enamel are Chinese. Word for word, the first words means "New, N-e-w". The second, any light or bright, brilliant or glossy and oil and laquer company. In other words, New Glossy Oil & Laquer Company.

153 HUGH B. SAPPINGTON, Maywood, Illinois, Ass't. Sales manager for Armstrong Paint & Varnish Works, called in behalf of the defendant, testified as follows:

*Direct Examination.*

I am Hugh B. Sappington. I live in Maywood, Illinois. I as Assistant sales manager for Armstrong Paint & Varnish Works. I have been in the paint business slightly more than 21 years. In 1915, I entered the employ of the Campbell Glass & Paint Company of St. Louis. My first position was as bill clerk. After that as a collector, then as a store clerk, then city salesman, all within a period of a few months. As city salesman, I had occasion to travel around the city of St. Louis, the vicinity and other states; I worked in St. Louis proper for about a year and a half, and on the road for the same company for another year. I have been continuously since then in the paint business except for military service.

During the period between 1915 and 1918, I saw displayed for sale or advertised, paints, varnishes, polishes and kindred articles sold with the trade-mark "Nu." I have seen an automobile paint by the name of "Nu-Back." It was manufactured by the Nu-Back Manufacturing Company of St. Louis. I saw it offered for sale in dozens of stores in the City of St. Louis and surrounding territory.

During that period I also saw advertised or offered for sale Nu-Shine, manufactured by the Nu-Shine Manufacturing Company of St. Louis. I saw it advertised in dealer stores in St. Louis.

*Cross-Examination.*

Between 1915 and February 1918, I was entirely in the paint business with the Campbell Glass & Paint Company of St. Louis. I was in the service from April 1918, forward.

The Nu-back put out by the Nu-back Manufacturing Company is a paint. Nu-Shine is a polish. I can't tell you if those companies are still in business; I haven't been in St. Louis, employed there, since 1921. I am not familiar. If they have gone out of business it would have been after 1917. I don't know how soon after.

MITCHELL GOLDSMITH, President of Armstrong Paint & Varnish Works, called in behalf of defendant, testified as follows:

*Direct Examination.*

I am Mitchell Goldsmith, 1020 North East Avenue, Oak Park, Illinois. I am President of Armstrong Paint & Varnish Works. I have been connected with that company about 28 years—since I was seventeen.

I know W. J. Nelson, at one time employed as salesman by the Armstrong Paint & Varnish Works. I have never talked to Mr. Nelson about his manner of selling our products, the sales department took care of such matters. Mr. Nelson was employed in the capacity of salesman. We employed about one hundred forty salesmen during the period from May 1935 to approximately 1936. Mr. Van Antwerp was head of the department that had to do with the salesmen. I never had any conversation with Mr. Nelson in which I told him or instructed him as to the manner in which he was to sell our New-Beauty products.

I don't recall actually having seen offered for sale or advertised, enamels, paint or kindred products prior to March 1925 which bore the trade-mark N-u, but I have seen them listed in the trade-mark books. I recall Nu-tona, manufactured by the W. W. Lawrence Paint Company of Pittsburgh. That product was applied to flat wall finish. Nu-Kote, spelled N-u-K-o-t-e, manufactured by the Pratt &

Lambert Company, Buffalo. They have a Chicago plant also, possibly others, I don't know.

I was present at the time of the luncheon when other officers of my company and I talked to Mr. Nelson on or about the occasion of his first entering our employ. Nothing was said at that time about the manner in which New-Beauty products were to be sold.

*Cross-Examination.*

Nu-Tona was put out by the W. W. Lawrence Company. I never saw the product on sale but I saw it in the book of trademarks. The name was supposed to have been used on flat wall finish. I never saw any of the product. I never saw one of the labels. I saw it in the book in the 1927 edition. I have seen it on a number of occasions since that time. The earliest I saw it was in 1927. I saw Nu-Kote at the same time. I never saw any of the product, nor any of the labels. I am not certain about what articles it was used on.

Mr. Nelson's position with our company was salesman. He sold our line of New-Beauty Enamel. That was in his department. Mr. Van Antwerp established the prices for those products. His position is that of salesmanager. He is also vice-president. I wouldn't say positively that we had any man selling New-Beauty Enamel exclusively. I believe most of the men sold other things, but I wouldn't say positively. Mr. Nelson did not, to my knowledge, have exclusive supervision of the sale of New Beauty-Enamel. He went out 161 to sell products, call on the trade. He sold New-Beauty products. He did not sell it exclusively, he sold other products. I don't know about the first few months he was in there. He was employed about a year.

JERRY KRNAK, Lyons, Illinois, called in behalf of defendant, testified as follows:

*Direct Examination.*

My name is Jerry Krnak. I live at 8018 44th Street, Lyons, Illinois. My business is painting. I have been a painter twenty-eight years continuously. I started as a furniture finisher and piano finisher and then in about 1923 I started in painting and decorating. I painted and finished furniture of



all sorts. On January 8, 1937, I bought one can of lemon color, one can of bright red, one can of orange and one can of ivory Nu-Enamel from a store at 22nd Street and 58th Avenue, between 58th and 57th, at the instruction of a friend of mine, Mr. Novak, who sent me over and asked me to demonstrate, that is, to test that enamel. (The said cans were marked for identification DEFENDANT'S EXHIBITS 75, 76, 77, and 78.)

I opened the can of lemon Nu-Enamel, DEFENDANT'S EXHIBIT 75, which I purchased at the store just mentioned, and stirred thoroughly, and applied it on with a good grade brush, an ox-hair brush. I applied it on this book rack. (Marked DEFENDANT'S EXHIBIT 79.) This can of orange I bought at the same time, at the same place, as well as this can marked light red Nu-Enamel. I followed the directions on the can in applying it. I sandpapered the side that I wanted to paint and dusted it off clean; run over with my hand to get all the grit and dust off and applied the paint on, and just as I was staring on the next panel, the first panel began to sag, the enamel began to sag in streaks and 162 edges, so I straightened it out again after I got through with the next panel, before I got through with that the first panel was sagging again, so that is the result, that is the way it looked when I got through with it.

I applied orange and the light red in the same manner.

Defendant's Exhibit 79 that I am looking at now is the book rack that I covered. I sand papered each side. I followed directions on the can exactly the way it reads. (Exhibits referred to by witness were not here offered in evidence.)

#### *Cross-Examination.*

Mr. Novak is a friend of mine. It was he who asked me to come up here. He told me to get these cans of Nu-Enamel and brush it on a piece of furniture of any kind, he just wanted to see how it covers and how it come out. So I done the best I could. I didn't really know what he wanted, so I tried the best I could to cover this, but it was impossible. I couldn't cover the wood to give it a clear coat. The enamel wouldn't cover it. I don't know what is wrong with the wood but the enamel wouldn't cover it, that is all. Material like that doesn't exactly need a primer if you have the same color background as you want to put the enamel over. But if you want to use this enamel over a dark finish, light color enamel over a dark

finish, it certainly requires a primer. If I were going to apply enamel over the same color background, I wouldn't need a primer.

163 C. B. VAN ANTWERP, 9736 South Hoyne, Chicago, Vice-president and sales manager of Armstrong Paint & Varnish Works, testified as follows in behalf of defendant:

*Direct Examination.*

I am C. B. Van Antwerp of 9736 South Hoyne Avenue, Chicago. I am Vice-president and sales manager of Armstrong Paint & Varnish Works. I have been with them since December, 1920. In May of 1935 I was Vice-president and sales manager. I know Mr. Nelson who testified here yesterday. He started June 1st 1935 on our payroll. He was employed as salesman. He applied for a position along sometime in May, I can't recall the exact date, and I went through the usual procedure that I do when I hire most of the salesmen. I never told or instructed Mr. Nelson to sell our New-Beauty, N-e-w Beauty products in any particular way. He had told me that he had been with the Eastern Nu-Enamel Company. When he applied for the position with our company, he said that he had been with the Nu-Enamel Corporation in the East, I think New York City, and he showed a card. A business card, evidencing that he had been with them. And he also showed some evidence that he had left their employ. At the time I employed him; I employed him to sell the New-Beauty products. He had told me of his fine qualifications as salesman and sales manager. I had him at a luncheon that we have every day, up in the penthouse of our factory, and I had him meet the various members of our organization, which we follow out as a custom in presenting a new man, and he orated at length on his capabilities at that time. And subsequently I questioned him in my private office, and I hired him because I thought he was a good salesman. I never asked about his secrets, so-called, of salesmanship that he had acquired with the Nu-Enamel organization.

*Cross-Examination.*

Mr. Nelson's duty was the duty of a salesman. He did not have charge of the selling of the New-Beauty products. At

that time that was all he sold. My assistant Mr. Sappington was head of that department. I might qualify that. We hadn't a separate department, it was an item in our line. Mr. Nelson was employed to sell the Nu-Beauty line, to sell that line exclusively. He sold that line. He went on the road. He covered principally Chicago and the outlying cities, and as far west as the river. His duties were to employ, to engage distributors to handle this New-Beauty line. He engaged new distributors, new outlets for us. I don't know how I would qualify many and few. I would say that he did a very good job. The number of dealers handling New-Beauty was, in Illinois and Wisconsin, in the neighborhood of a hundred, I think. I don't remember the date we had dealers in the neighborhood of a hundred. I wouldn't be able to say definitely how many accounts Mr. Nelson acquired. He did a good job of engaging new accounts. He never managed the department. I wouldn't credit the growth of the department to his salesmanship. I had several salesmen.

(Various circulars and color cards of words used as trademarks containing the word Nu, as testified to by Mr. Fisher, were offered and received in evidence over objection by plaintiffs' counsel to the effect that these names were not involved in this litigation, and were marked DEFENDANT'S EXHIBITS 1 to 10, inclusive; the New-Beauty circular testified to by witness Fisher and identified by him, was offered and received in evidence and marked DEFENDANT'S EXHIBIT 38; the 1927 issue of the trade-mark book of the National Paint, Oil & Varnish Association, testified to and identified by the witness Fisher, was offered and received in evidence and marked DEFENDANT'S EXHIBIT 39; Nu-Enamel circular, identified by Mr. Lloyd, was offered and received in evidence and marked DEFENDANT'S EXHIBIT 40; the panels, painted and unpainted, testified to by Mr. Pickard were offered and received in evidence over objection by plaintiffs' counsel, and were marked DEFENDANT'S EXHIBITS 41 to 53, inclusive; six cans of enamel, red, orange, maroon, ivory, white and lemon, were offered and received in evidence over objection by plaintiffs' counsel, and were marked DEFENDANT'S EXHIBITS 54 to 59, inclusive; page 24 of Nu-Enamel Nus of 6-20-35, was offered and received in evidence over objection by plaintiffs' counsel and was marked DEFENDANT'S EXHIBIT 60; other issues of Nu-Enamel Nus, were here offered in evidence as DEFENDANT'S EXHIBITS 61 to 74, inclusive, certain pages being extracted and

offered in evidence later in the testimony; cans of Nu-Enamel paint in lemon, light red, ivory and orange, purchased by the witness Krnak, were offered and received in evidence over objection by plaintiffs' counsel and were marked DEFENDANT'S EXHIBITS 75, 76, 77 and 78, respectively; various sizes of labels used by Armstrong Paint and Varnish Works in connection with Armstrong's Nu-Beauty Enamel were offered and received in evidence and were marked DEFENDANT'S EXHIBITS 80 to 85, inclusive; invoices and bills, of Nu-Beauty Cream sold to Hibbard, Spencer, Bartlett & Co., testified to by witness Fisher, were offered and received in evidence over objection by plaintiff's Counsel and were marked DEFENDANT'S EXHIBITS 91, 92 and 93; a stand or holder with the advertisement Nu-Beauty Furniture Cream was offered and received in evidence over objection by plaintiffs' counsel and marked DEFENDANT'S EXHIBIT 94; a circular of Nu-Beauty Furniture Cream was offered and received in evidence over objection by plaintiffs' counsel and was marked DEFENDANT'S EXHIBIT 95; photostatic copy

of page 25 of Chicago Evening American of Sept. 22, 1933, showing an advertisement of Nu-Beauty Furniture

Cream was offered and received in evidence over the objection of plaintiffs' Counsel and was marked DEFENDANT'S EXHIBIT 96; a clipping of an advertisement of Nu-Beauty Furniture Cream in the Chicago American of Sept. 22, 1933, was offered and received in evidence over the objection of plaintiffs' counsel and was marked DEFENDANT'S EXHIBIT 97; an Armstrong Nu-Beauty Varnish label testified to by Mr. Fisher was offered and received in evidence over the objection of plaintiffs' counsel and marked DEFENDANT'S EXHIBIT 98; a page of a mimeographed circular issued by the Nu-Enamel Corporation, identified by Mr. Lloyd, was offered and received over the objection by plaintiffs' counsel, and was marked DEFENDANT'S EXHIBIT 99.)

HENRI CROIZARD, 2150 West North Avenue, called in behalf of defendant, testified as follows:

*Direct Examination.*

My name is Henri Croizard. I live at 2150 West North Avenue, Chicago. I was born in Paris, France. I lived in Paris until I was about 25 or 26. I have been in this country twenty-



five years. I have been a French teacher for the past twenty-five years. I have specialized in commercial French at DePaul University in 1926 and 1927. I was an instructor of commercial French at DePaul. I am now teacher of French at the Association House, and acting supervisor of the Social Educational Program of the Works Progress Administration. I am a graduate of Sorbonne in Paris. I learned all my English practically here. (Witness was shown Plaintiffs' Exhibit 6, page 16, and asked to give the English translation of the word Novemail.) Well, first I will say that N-o-v-e is a contraction of a word which is, in that case, *nouvel*, which means new. N-o-u-v-e-l, that is n-e-w in English, meaning something just out. Email, e-m-a-i-l, means enamel. N-o-v, as I 167 told you, is a contraction of the French word new which is N-o-u-v-e-l. N-o-u-v-e-l is the original word from which the contraction no-v has been evolved, and although n-o-v is not the proper spelling of *nouvel*, any Frenchman would understand in that case it means new. The root of the French word meaning new is *nova*, n-o-v-a, which is the Latin word for new. Novelty in English comes from the same root.

The word that appears on page 23 of Defendant's Exhibit 1, being a copy of Nu-Enamel Nus of November 20, 1934, is Novemail, which means in English, New-Enamel. Spelled I would say n-e-w. French is mainly used in Brussels, Belgium. A man in Paris, a Frenchman, seeing the name Novemail in front of a paint store, on a package of paint or on a sign, would understand it to mean New Enamel, meaning that enamel that has just been put out, a special brand, of course.

168 ROBERT K. SHANNON, Washington, D. C., called in behalf of Defendant, testified as follows:

*Direct Examination.*

My name is, Robert K. Shannon. I live in Washington D. C. I am Manager of the Trade-Mark Bureau of the National Paint, Varnish & Lacquer Association, having its main office in Washington, D. C. Prior to that time it was in New York. It has been in Washington since about 1930 or 1931. This Association has been in existence for about three years, but prior to that time it was an amalgamation of existing Associations which date back a good many years prior to that. The National Paint, Oil & Varnish Association was organized in



1888. It has been in existence in its old form or amalgamated form ever since. It maintains a trade-mark division or bureau. I am in charge of that bureau. I have been in charge since I first came with the Association, which was about November, 1922. I have continuously been in charge since then, keeping the records and receiving the mail.

The main purpose of the trade-mark Bureau is to collect information about all trade names and trade-marks used in the industry. We do that so that in the event any manufacturer would like to select a new name for one of his products that he may call upon the file records of our Bureau to consult with in order to prevent, as far as possible, the likelihood of adopting conflicting names. That is the broad purpose of the Trade-mark Bureau.

We receive our information about trade-marks from three different sources, one of which is known as our listing service, and anybody in the industry can send in to us information about any trade name they use, and we will put it in our files.

Another source is securing copies of all Patent Office registration certificates pertaining to our industry.

And the third is known as our recording service whereby we will record on our files trade-marks from member companies, and with the application we have a copy of the label they use. They send us that information. They also state the date of first use on the application form itself. Those are the three sources.

It is my duty to handle the details of them and see that they are recorded in the Bureau and listed accordingly; see that the information is kept.

Listing forms are kept according to alphabetical order. Our regular recording service is kept numerically according to the number of the certificate, and the Patent Office registrations are kept numerically also, and from those records we make our card index file alphabetically of all trade names used in the industry, according to our Bureau records.

170 From time to time the Association publishes, in connection with its Trade-Mark Bureau, printed lists of trade-marks or trade names that have been listed with us. I have before me one published under date of September 15, 1919, and a supplement thereto published under date of 1920, in December, 1920. (Marked Defendant's Exhibit 1 of this date.) Those words or names contained in that book are supposed to be trade-marks for the card file records of our Association, covering the period up to the time of publication.

We have a record in the files of the National Paint Association of a Nu-Blac trade mark, registered by the Atlantic Varnish Works, Incorporated, Richmond, Virginia.

(Witness here identified certain papers marked Defendant's Exhibits 2 to 29-A of this date.)

I do not know the correct number of members belonging to the National Paint, Varnish & Lacquer Association because there are various classifications of membership. We have one class of membership called Class A, and that is for manufacturers of paints, varnishes and lacquers in the industry. A second class of membership is Class B, or raw material supply companies who sell materials to the paint manufacturers which enter into the production of their products. And then we have a Class C membership, which is composed of brokers and jobbers in the industry. We have about 700 as near as I can recall. I couldn't say with any degree of accuracy about the volume of business done in the United States by these manufacturers.

I have before me a record of the registration of the trade-mark or trade-name Nu-Blac by the Atlantic Varnish Works, Incorporated, of Richmond, Virginia.

171 Defendant's Exhibit 2 of this date is the recording certificate of the Association which is issued to a member, setting forth the facts as the registrant has furnished them to us concerning his use of the mark. A photostatic copy of the label which accompanied the application form is attached, and on the recording certificate the date of first use is stated as furnished to us by the concern.

These records are all files of the Trade-mark Bureau, of the National Association. I have charge of that Bureau. I personally got all the papers marked Defendant's Exhibits 2 to 29 from the files in the office of the Trade-mark Bureau of the National Paint Association, and brought them here personally from Washington. They haven't been out of my hands since. The recording certificate for Nu-Blac was issued on the 20th of March, 1919. The application was dated March 10, 1919. The card attached to Exhibit 2 is Nu-Blac, hyphenated. The owner, the Atlantic Varnish Works, Inc., of Richmond, Virginia. First use started about 1916. Product on which used, a leather seat dressing. The recording number in the Trade-mark Bureau, 5151, and the year 1919. As to Nu-Car-To, the application is dated November 10, 1919, by the Wheeler Varnish Works of Chicago, Illinois; the recording certificate is dated the first of December, 1919. Nu-e-

Co, I have before me the listing form dated July 10, 1922, by the Foy Paint Company of Cincinnati, Ohio, in reference to the same mark spelled, one word Nueco. I have before me an application by the same company dated the 5th of November, 1930, and the recording certificate was issued January 12, 1931. The last was Exhibits 7 and 7-A. Nu-Car-To was Exhibit 6. Nu-finish, application form dated the 9th of 172 November, 1923, by the Utley Paint Company, Incorporated, they are located at New Orleans, La. And the recording certificate for the same mark is dated January 14, 1924, Exhibit 9. That was Exhibit 9 which I just read.

Nu-Flor, Tanner Paint & Oil Company, spelled Nu hyphen Flor, Exhibit 11, application dated April 22, 1921; recording certificate of the same mark dated May 5, 1921. Tanner Paint & Oil Company, Richmond, Va.

Nu-Flor, by the Hockaday Company; Exhibit 10, registration form dated October 28, 1908, for the mark Nu-Flor by Hockaday Paint Company of Chicago.

Nu-Floor, Exhibit 12, listing dated June 29, 1922, the Tanner Paint & Oil Company, Incorporated; Richmond, Virginia.

Nu-O-lac of the Glidden Company, Cleveland, Ohio, Exhibit 13, recording certificate dated December 20, 1921.

Nu-Kar, Exhibit 14, Dean & Barry Company, Cleveland, Ohio, application dated October 18, 1931, recording certificate dated March 29, 1922.

Ku-Kolor-Di, Exhibit 15; application dated March 13, 1918 by the Peaslee-Gaulbert Company, Incorporated; Louisville, Kentucky.

Nu-Lac, application dated September 1, 1915, by the Sillers Varnish Company, Los Angeles, California, Exhibit 16.

Nu-Lac, Exhibit 17, Sta-Bright Mfg. Co., Chicago, Illinois, application dated May 16, 1912.

Nulife, one word, Exhibit 18, by the Mutual Paint Mfg. Co., St. Louis, dated July 11, 1922.

173 Nu-Like, Exhibit 19, application dated March 6, 1920, by Asper-Martin Company, Sioux City, Iowa, recording certificate is dated March 13, 1920.

Nu-luster, Exhibit 20, application dated Jan. 18, 1913, by the Boston Varnish Company, Boston, Mass. That is just the listing.

Nu-lyk, Exhibit 21, recording certificate dated July 23, 1918.

Nu-namel, application dated Nov. 25, 1924, Utley Paint Company, Incorporated, New Orleans, La., Exhibit 22.

Nu-rinkle, listing form dated August 25. Exhibit 23. By the R. F. Johnston & Company of Cincinnati, dated August 25, it looks like 1910.

Nu-roof, Exhibit 24. Listing form dated November 19, 1919, by the Star Paint & Varnish Company, Cleveland, Ohio. That is just a listing.

Nu-shine, Exhibit 25; dated September 12, 1910, by the Dozier & Gay Paint Company of Jacksonville, Fla.

Nu-spirits, there is a date stamped on this listing form of April 2, 1919, exhibit 26. For John Briggs & Company, Incorporated, of Boston, Massachusetts. There seems to be a received stamp on here for the purposes of the record, initialed, G. V. H. April 2, 1919. G. V. H. is George V. Horgan, who at that time, I believe, was secretary of the National Paint, Oil & Varnish Association.

Nu-turps, exhibit 27, application dated September 26, 1907, by the Charles H. Moore Oil Company, of Cincinnati, Ohio.

Nuvar, exhibit 28, application dated Jan. 31, 1921 by the Gilbert-Spruance Company of Philadelphia, record-174 ing certificate issued May 26, 1921.

Nuwall, exhibit 29, I have before me a copy of letter dated Nov. 12, 1914, which apparently is an acknowledgment of application from the F. F. Johnston Paint Company of Cincinnati, Ohio, and in this letter the first paragraph reads as follows: 'Referring to your application of the 9th instant, for a registration of trade-names as follows', then the first one is Nuwall, one word. Magic Gold; Nuwall for flat washable paint.

These exhibits 2 to 29 inclusive are exhibits of trade-marks and trade names used and applied for and listed by us for and on behalf of persons, firms and corporations in the paint, varnish, oil and kindred industries. In the application which came through to the Bureau from member companies advising that they have used such names, and in the cases where a recording certificate issued we always require a copy of the label showing exactly how they use the mark to be sent to the Bureau. These are the labels of which photostats appear on the respective exhibits that you have testified from. I can't say whether or not all of the applicants were in the paint, varnish, lacquer, enamel and kindred businesses—there are a good many of them there that, of course, were prior to my connection with the Association, but I do recognize some of the names. I couldn't say for sure that those in existence to-



day I know about, unless I went all over those records. There is quite a number of concerns there and I wouldn't like to say positively in the absence of any specific information myself. I do recognize, however, that there are some in there who are still in the business. I have in mind particularly the 175 Foy Paint Company of Cincinnati, Ohio, just as one illustration of that, because I am acquainted with Mr. Foy personally, myself.

I would like to point out that I was not connected with the Association in 1919, so that I would only make a guess, if it is proper for me to do that, as to whether or not the Nu-Blac appearing on page 22 of the Trade-mark list published by the National Paint & Varnish Association for 1919, is the same Nu-Blac to which I testified.

The National Paint, Oil & Varnish Association, Inc., 18 East 41st St., New York City is one of the predecessor organizations of the Association I am connected with, the name of which appears on the title page of Defendant's Exhibit 39, being the 1927 issue of the Trade-Mark Bureau of the National Paint, Oil & Varnish Association, Inc., 18 East 41st St., New York. I was connected with that association. I am familiar with the Trade-mark Bureau of the Association at that time. The date of this publication is December 31, 1926. I do not know the specific figure for the circulation of this book. The book was published and offered for sale throughout the industry, and the charge to members being \$3.00 a copy, which just about covered the cost of the publication of it and the work incident to compiling the records for printing. I have no specific sales figures before me. This is the official book that was gotten out by the Bureau of which I was in charge in 1926. That is when it was published. This book, Defendant's Exhibit 39, was available to the public, who are now members of the Association, to be purchased by them. I don't recall the price now just whether 176 we had a slight increase in price over the members or not, but so far as the 1935 Trade-mark Directory is concerned, it sells for \$3.00 to members and \$5.00 to non-members. Many of these 1927 trade-mark books were purchased by non-members.

*Cross-Examination.*

I am connected with the National Paint, Varnish & Lacquer Association. One of my duties is manager of the Trade-mark



Bureau. We have no official connection at all with the United States Patent Office, other than that we get their own registrations which they mail direct to us, covering registrations in the paint and varnish industry for Class 16. We have no authority under the law to register. We issue a recording certificate. That certificate itself just records the information that the members send us. So far as proof of some of those statements is concerned, we take that for granted. For instance, they send us a copy of the label stating,—the application is so worded that we assume that that mark is used according to the label. When he sends us, sends the first use, that is his statement and we accept that statement as such on our recording certificate. We do not make any inquiry as to his use; we don't send out investigators. To members,—by the way, the certificate itself is only issued to members, and there is a combined charge of \$3.00 for the issuance of the certificate and for the detailed report which accompanies that. These companies do not send us any proof of use such as invoices showing they have sold goods bearing that mark. They do not send us any records. They fill out an application blank which calls for certain information; calls for the name of the mark. They must enclose a label with 177 that, provided the name is in use. They must state the date they first used the mark; they must state the products upon which they do use the name, and we accept that statement as fact accordingly, and issue what is known as our recording certificate based upon that data as furnished to us by the member direct. I can't recall offhand ever seeing any of the products on sale that I have testified to, because information like that very seldom comes to my office, that is, through my particular bureau. All the information that I have given here is hearsay evidence, as far as I am concerned. We take the manufacturer's or alleged manufacturer's word for the information which he sends to us.

I recall the Foy Paint Company, as an illustration of one of these companies being in business at the present time, because I happen to know them. I have no information as to whether they are still using the marks registered with our Bureau. Other than what is furnished us in the course of the procedure I have outlined, I have no information whether or not they ever used those marks.

CHARLES L. LLOYD, recalled in behalf of defendant, further testified:

*Direct Examination.*

I am Charles L. Lloyd, president of the plaintiff and the intervenor in this case. I am the same Mr. Lloyd who has testified. I can't say that I have seen Defendant's Exhibit 30 of this date, title "Procedure for establishing Nu-Enamel dealers" but it looks like one of our pieces of literature that we send out. Page 6, Defendant's Exhibit 30-A, looks very much like a piece of literature gotten out by the Nu-178 Enamel Corporation but I can't say. I would say, as a matter of fact, that it was issued by our company. (Page 6, being Exhibit 30-A for identification, was received in evidence and marked DEFENDANT'S EXHIBIT 100.)

(The following pages of various issues of Nu-Enamel Nus were here offered and received in evidence over the objection of plaintiff's counsel and were marked DEFENDANT'S EXHIBITS as indicated:

Defendant's  
Exhibit

- 61-A Page 19 of Nu-Enamel Nus of 1-20-35.
- 61-B Page 22 of the same issue.
- 61-C Page 23 of the same issue.
- 62-A Page 11 of Nu-Enamel Nus of 2-20-35.
- 62-B Page 18 of the same issue as 62-A.
- 63-A Page 23 of Nu-Enamel Nus of 3-20-35.
- 63-B Page 30 of same issue as 63-A.
- 64-A Page 16 of Nu-Enamel Nus of 4-20-35.
- 64-B Page 23 of same issue as 64-A.
- 65-A Page 14 of Nu-Enamel Nus of 5-20-35.
- 65-B Page 16 of same issue as 65-A.
- 65-C Page 23 of same issue as 65-A.
- 66-A Page 16 of Nu-Enamel Nus of 11-20-35.
- 67-A Page 16 of Nu-Enamel Nus of 7-20-35.
- 67-B Page 25 of same issue.
- 67-C Page 26 of same issue.
- 67-D Page 27 of same issue.
- 68-A Page 16 of Nu-Enamel Nus of 8-20-35.
- 68-B Page 21 of same issue.
- 69-A Page 16 of Nu-Enamel Nus of 9-20-35.

**Defendant's  
Exhibit**

- 70-A Page 15 of Nu-Enamel Nus of 10-20-35.
- 70-B Page 21 of same issue.
- 179 70-C Page 24 of same issue.
- 71-A Page 15 of Nu-Enamel Nus of 12-15-35.
- 71-B Page 21 of same issue.
- 72-A Page 12 of the Nu-Enamel Nus of 5-20-36.
- 72-B Page 16 of same issue.
- 72-C Page 22 of same issue.
- 73-A Page 16 of Nu-Enamel Nus of 6-20-36.
- 73-B Page 22 of same issue.
- 74-A Page 12 of Nu-Enamel Nus of 10-20-36.
- 74-B Page 15 of same issue.
- 86-A Page 13 of Nu-Enamel Nus of 11-20-34.
- 86-B Page 14 of same issue.
- 86-C Page 20 of same issue.
- 86-D Page 22 of same issue.
- 86-E Page 23 of same issue.
- 87-A Page 6 of Nu-Enamel Nus of 3-15-34.
- 88-A Page 8 of Nu-Enamel Nus of 9-20-34.
- 88-B Page 10 of same issue.
- 88-C Page 11 of same issue.
- 88-D Page 16 of same issue.
- 88-E Page 18 of same issue.
- 89-A Page 14 of Nu-Enamel Nus of 12-20-34.
- 89-B Page 20 of same issue.
- 90-A Page 8 of Nu-Enamel Nus of 10-20-34.
- 90-B Page 11 of same issue.
- 90-C Page 13 of same issue.
- 90-D Page 16 of same issue.

Photostats of documents formerly marked Defendant's Exhibits 2 to 29 for identification and testified to by witness Shannon, were here offered and received in evidence over 180 the objection of plaintiffs' counsel as DEFENDANT'S EXHIBITS 101 to 129 inclusive.)

W. J. NELSON, recalled in behalf of plaintiffs, testified as follows:

*Direct Examination.*

I am the Mr. Nelson who formerly testified in this case. Plaintiffs' Exhibit Q is a circular that was furnished the dealers, Nu-Beauty dealers for distribution to the neighborhood customers. I saw that in and around the place of business of the Armstrong Paint & Varnish Works when I was there. I saw identical posters to these on display in stores of dealers.\* (Said circular was here received in evidence as PLAINTIFF'S EXHIBIT Q. The following exhibits were also received in evidence: Q-1 and Q-2, being posters of Nu-Beauty Enamel, R, a circular, T, a photograph, and T-1, document.) (Witness was shown Plaintiff's Exhibit Q-1.) That is the instruction sheet. (Witness was shown a placard.) That is a placard put out by the Nu-Enamel Corporation. I first saw it in 1933. (Placard received in evidence as PLAINTIFFS' EXHIBIT T-2.)

C. L. LLOYD, recalled in behalf of plaintiffs, testified as follows:

*Direct Examination.*

I have been in the court room this morning. I heard Mr. Shannon testify. I have never come across any of the alleged competing brands for paints or paint material or supplies which were mentioned by this witness. I do not recall having seen any of them on sale.

*Cross-Examination.*

I was in business in New Orleans from the latter part of 1922 or the first part of 1923 until the latter part of 1923 or the first part of 1924. Just the exact date I don't know.  
181 I was in business in the vicinity of New Orleans, in the paint and enamel business. I never heard of the Utley Company. I never heard of the Nu-Enamel Paint Company of New Orleans during 1923 or 1924. I never saw or heard of Defendant's Exhibit 131 for identification, being a photo-

stat of the label Nu-Namel for quick-drying auto paint. I never heard of the Utley Paint Company or the Nu-Namel Paint Company of New Orleans.

W. J. NELSON, recalled in behalf of plaintiffs, testified as follows:

*Direct Examination.*

I heard Mr. Shannon testify this morning. I have never seen any of the products on sale which he mentioned this morning.

K. Y. BENSON, called as a witness on behalf of plaintiffs, testified as follows:

*Direct Examination.*

My name is K. Y. Benson. I live in Cleveland, Ohio. I am vice-president in charge of factories of the Nu-Enamel Corporation of Delaware. I have been with that corporation since August of last year directly. I have had experience in the paint business continuously since 1913. At Louisville, Kentucky; Cincinnati, Ohio; Birmingham, Alabama; Toronto, Ontario; Chicago and Cincinnati. I have been in the firms of Louisville Paint Mfg. Co., Louisville, Ky.; Gillen Paint & Varnish Co. of Chattanooga, Tenn.; Alt & Wiborg, Toronto; Aulcraft Paints Ltd., Toronto, Ont. I have never seen nor heard of paints or paint products being on sale in the 182 markets of the United States or elsewhere under the following names:

Nu-blac, Nu-Car-To, Nu-Nulco, Nu-Finish, Nu-Floor, Nu-Flor, Nu-Florence, Nu-Hilite, Nu-Kar, Nu-Kolor-Di, Nu-Lac, Nu-Li, Nu-like, Nu-luster, Nu-lyk, Nu-Namel, Nu-lin-o-leum, Nulife, Nu-shine, Nu-spirits, Nu-turps and Nuwall.

I have been general manager up until the present, for the last 20 years, of those different companies I have been with, general manager, vice-president, or president. Since 1913 I have covered the entire south and east and some in the middle west of the United States and seven years in Canada. During that time I was familiar with the competing brands of paint and paint supplies that were on the market. I never heard of any of those brands until this morning.



*Cross-Examination.*

Prior to the past three months I never heard of any paint or similar article sold or manufactured with the word N-u preceding another word.

*Redirect Examination.*

I have heard of Armstrong using the word N-u.

*Recross Examination.*

I visited the Armstrong plant and oftentimes had lunch in the penthouse.

(At this point counsel for plaintiffs moved to strike from the files the list of names alleged to be used by various concerns as trade marks for paint, varnish, etc. Said list was filed in answer to a question in plaintiff's motion for further and better particulars and said list was included as an amendment to Paragraph 9 of defendant's answer; the grounds for motion to strike being that defendant had not proved the use of the names alleged to have been used as trade marks. The court denied this motion.)

183 FRANCES SMITH SWANEY, recalled in behalf of plaintiffs, testified as follows: .

*Direct Examination.*

I have formerly testified in this case. That is a piece of metal, metal fender. I applied the paint to it last evening. I painted it with Nu-Enamel. I got it on Clark Street. It is a product of the Nu-Enamel Corporation, from one of their stores. I did this painting myself and I followed the instructions on the can. I applied one coat with a brush direct from the can.

(Said fender was received in evidence as PLAINTIFFS' EXHIBIT U.)

These are the cans from which I obtained the paint which I applied to that fender.

*Abstract of Testimony.**Cross-Examination.*

I am employed by the Nu-Enamel Corporation. I was employed as a shopper by Mr. Lampa, of the office of Rogers, Woodson and Rogers, the gentleman who has been assisting Mr. Woodson. I did some work Monday.

DOROTHY WRIGHT, called in behalf of plaintiffs, testified as follows:

*Direct Examination.*

My name is Dorothy Wright. I live at 4530 Malden, Chicago. I am a clerk and demonstrator in Nu-Enamel stores. At present I am located at Clark Street, but am at various stores. I recognize these partly painted products. I did that painting with Nu-Enamel obtained from the Nu-Enamel store at 27 North Dearborn. They were new cans. I painted all these various objects—green and white checkerboard with black division lines; a wood strip or lath; a portion of what appears to be a back of a chair; a seat of a small chair, a child's 184 chair, and what appears to be a door to an automobile.

I applied one coat to these various objects. That is the wing of an airplane, toy. I painted that. Last night also. I used all Nu-Enamel products. I applied one coat.

(Specimens offered and received in evidence as PLAIN-TIFFS' EXHIBITS U-1 to U-6.)

*Cross-Examination.*

I painted all of these articles last night. I did this job in the basement of the Dearborn Street store. This door was standing on this end and leaning in a vertical position. This was lying down (indicating); those were horizontal (indicating). This door was in this position (indicating) and I painted it with one coat. One coat of Nu-Enamel. I did not apply any coat underneath. I merely washed the surface with some primer and applied one coat of enamel on the material as you see it. This was in a vertical position. I am employed by the Nu-Enamel Corporation.

*Redirect Examination.*

I followed the instructions printed on the Nu-Enamel cans.

K. Y. BENSON, recalled in behalf of the plaintiffs, testified as follows:

*Direct Examination.*

I have formerly testified in this case. I can identify these partly painted objects. They are part of a chair, a used chair, color black; part of a piece of linoleum, white 185 and black; bakelite cup black; part of a filing cabinet; natural wood stand with possibly a coat of shellac on top. I did the painting that appears on these objects last night. I used Nu-Enamel, from 27 North Dearborn, Nu-Enamel store. I applied one coat in each case.

(Specimens identified and received in evidence as PLAIN-TIFFS EXHIBITS U-7, U-8, U-9 and U-10.)

That is a test card put out by Krebs Pigment Company, a subsidiary company of DuPont, circulated to paint manufacturers as the standard test chart. On that I painted last night with a can of New Beauty enamel. It was sent to me by Mr. Lampa, by a boy I suppose in his office. It was a quarter pint can. The can was marked New-Beauty Enamel, put out by Armstrong Paint & Varnish Works. That is the can which I used.

(Said can was marked for identification PLAINTIFFS' EXHIBIT U-11, but was refused admission by the Court. Counsel for plaintiffs took exception to the Court's refusal to admit the offer and stated that the object in offering this exhibit was to show that the defendant's product, which it advertises as covering in one coat, would cover in one coat, when put to this most severe test.)

66 And afterwards, to wit, on the 3rd day of May, 1937, being one of the days of the regular May term of said Court, in the record of proceedings thereof, in said entitled cause, before the Honorable Charles E. Woodward District Judge appears the following entry, to wit:

May 3, 1937

IN THE UNITED STATES DISTRICT COURT.

(Caption—14284)

**ORDER APPROVING STATEMENT OF EVIDENCE.**

On this 3rd day of May, 1937, the foregoing statement of evidence in this cause having been presented to me, the same is hereby allowed and approved, and the same is hereby ordered filed as "A Statement of the Evidence," to be included in the record of appeal in the above style and numbered cause to the United States Circuit Court of Appeals for the Seventh Circuit.

Charles E. Woodward,  
*District Judge.*

Jan. 16, 1937

32 And afterwards, to wit, on the 16th day of January, 1937, being one of the days of the regular December term of said Court, in the record of proceedings thereof, in said entitled cause, before the Honorable Charles E. Woodward District Judge appears the following entry, to wit: Findings of Fact and Conclusions of Law.

33 IN THE DISTRICT COURT OF THE UNITED STATES.

(Caption—14284)

**FINDINGS OF FACT AND CONCLUSIONS OF LAW.**

In conformity with equity rules, the court herein sets forth its findings of fact and conclusions of law:

**Findings of Fact.**

1. Plaintiff and defendant at the time of the filing of the bill of complaint herein were and are now both citizens of the State of Illinois. The intervener, Nu-Enamel Corporation, is a corporation of the State of Delaware.

2. "Nu" in "Nu-Enamel", appearing on plaintiff's label, is a phonetic spelling or misspelling of the English word "new" and means "new".

3. "Enamel" is a common English word describing a paint which flows out to a smooth coat when applied and which usu-

ally dries with a glossy appearance, and has long been known as such in the paint industry and to the public in general.

4. "Nu-Enamel" used in connection with paint or enamel sold by plaintiff means "new enamel" and is a common and generic term descriptive of the product to which it is applied and of its new or recent origin.

5. "Nu" was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of "new" to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name "Nu-Enamel".

6. Plaintiff does not come into this court with unclean hands.

*Conclusions of Law.*

1. "Nu-Enamel" is not a valid trade-mark, either at common law or under the Trade-Mark Laws of the United States, namely, Trade-Mark Act of March 19, 1920 and Trade-Mark Act of February 20, 1925.

2. This Court has jurisdiction to determine the validity of "Nu-Enamel" as a trade-mark under the Trade-Mark Laws of the United States, and having found that "Nu-Enamel" is invalid as a trade-mark, this court has no jurisdiction of the issue of unfair competition or other issues in this case.

Enter:

Charles E. Woodward,  
*Judge.*

Dated this 16th day of January, 1937.

35 And on, to wit, the 16th day of January, 1937, came the Plaintiff and Intervenor by their attorneys and filed in the Clerk's office of said Court their certain Findings of Fact and Conclusions of Law, in words and figures following, to wit:



ad Jan. 16,  
1937.

35

IN THE DISTRICT COURT OF THE UNITED STATES.

\* \* (Caption—14284) \* \*

### FINDINGS OF FACT AND CONCLUSIONS OF LAW.

In conformity with Equity Rule 70 $\frac{1}{2}$ , the Court makes the following findings of fact and conclusions of law:

#### Findings of Fact.

1. Plaintiff, Nu-Enamel Corporation, as a Delaware corporation, and is a citizen of the State of Delaware. Plaintiff, Nu-Enamel Corporation, by change of name, Enameline Products Corporation, is an Illinois corporation, and is a citizen of the State of Illinois. The principal business office of the plaintiffs is Cleveland, Ohio.
2. Defendant, Armstrong Paint & Varnish Works, is an Illinois corporation; is a citizen of the State of Illinois and a resident and inhabitant of the Northern District of Illinois, Eastern Division, with its corporate and principal offices located in Chicago, Illinois.
3. This is a suit arising under the trade-mark laws of the United States, and the Court has jurisdiction over the parties and the subject matter of this suit.
- 37 4. The original bill of complaint in this cause was filed January 9, 1935, by Nu-Enamel Corporation of Illinois, now Enameline Products Corporation. Subsequent to the filing of this suit, and on or about March 30, 1935, the original plaintiff herein sold its property, assets, business and good will, including the trade-mark "Nu-Enamel" and the registration thereof to the plaintiff, Nu-Enamel Corporation, a corporation of Delaware; plaintiff, Nu-Enamel Corporation of Delaware was made a party plaintiff herein by a petition to intervene filed in this cause on January 11, 1937.
5. Plaintiffs' business was established in the latter part of 1922 or the first part of 1923 in New Orleans, Louisiana, by Charles L. Lloyd, who took over the business of the Fac-Try-Lyk Paint Company of New Orleans, Louisiana, by which company he had been employed since on or about 1919; Charles L. Lloyd, upon acquiring said business, operated it for a short time under the name "Charles L. Lloyd, doing business as the Fac-Try-Lyk Paint Company," and on or about the latter part

of 1922, or the first part of 1923, the aforesaid Charles L. Lloyd changed the name of the business to "Charles L. Lloyd, doing business as Nu-Enamel Paint Company." (Trans. 14.)

6. The Fac-Try-Lyk Paint Company was engaged in the business of manufacturing and selling paints and kindred products, namely, paints, varnishes, enamels, top dressing, sandpaper, paint remover and paint brushes, under the trade-mark "Fac-Try-Lyk." Upon acquiring the aforesaid business, Charles L. Lloyd continued to put out the products formerly put out by the Fac-Try-Lyk Paint Company under the trade-mark "Fac-Try-Lyk" until he received a complaint from some cement company protesting against his use of the name "Fac-Try-Lyk;" thereupon Charles L. Lloyd discontinued the use of the business style "Fac-Try-Lac Paint Company" and the trade-mark "Fac-Try-Lyk" and adopted the business style "Nu-Enamel Paint Company" and the trade-mark "Nu-Enamel" and continued to sell the above mentioned articles under the trade-mark "Nu-Enamel." (Trans. 13.)

7. Charles L. Lloyd's first sales under the trade-mark "Nu-Enamel" were from an automobile, painted in twenty-four colors, parked on a street car corner in Houston, Texas, in the latter part of 1922 or the first part of 1923.

8. Charles L. Lloyd, in 1922 or 1923, employed approximately fifteen salesmen, who had formerly been employed by the Fac-Try-Lyk Paint Company of New Orleans, Louisiana, to sell his products, first under the trade-mark "Fac-Try-Lyk" and later under the trade-mark "Nu-Enamel," from automobiles painted in twenty-four colors, and continued to operate his business in this manner until 1927; at that time he had approximately one hundred salesmen selling his products from the above described automobiles throughout the South, the Southwest and Northwest, and possibly Illinois. (Trans. 20.)

9. The automobiles from which Charles L. Lloyd sold his products under the trade-mark "Nu-Enamel" were marked "Nu-Enamel. One Coat Covers. Leaves No Brush Marks." (Trans. 19.)

10. In 1927 the business of Charles L. Lloyd, doing business as Nu-Enamel Paint Company, was incorporated under the laws of the State of Texas under the corporate name "Nu-Enamel Paint Company, Inc." (Trans. 20.)

11. The volume of plaintiffs' business increased from a

humble beginning in 1922 or 1923 to \$1,448,441.50 in 1934, the year prior to the date of the filing of this suit. (Trans. 24.)

12. Plaintiffs and their predecessors, and their distributors, have extensively advertised plaintiffs' products sold under the trade-mark "Nu-Enamel" by such means as window demonstrators, automobiles painted in twenty-four colors, of which there was approximately 200 on the streets throughout the United States at the time this suit was filed, by radio, newspapers, magazines, street car cards, billboards, et cetera. (Trans. 29.)

13. Plaintiffs' expenditures for advertising in 1934 were \$143,599.98; in 1933, \$145,738. (Trans. 30.)

14. In 1933 and 1934 plaintiffs and their distributors spent approximately \$800,000 for advertising. (Trans. 30 and 31.)

15. Plaintiffs and their predecessors gradually expanded their business and at the time of the filing of this suit were using the trade-mark "Nu-Enamel" on the following products: Varnish, Enamels, Top Dressing, Varnish Stain, Thinner, Wood Powder, Floor Finish, Bronze Liquid, Patching Plaster, Wax, Remover, Linoleum Finish, Polish, Casein Paint, Glue, Mineral Colors, Liquid Solder, Oil Colors, Paint Brushes, Metallic Finish and Tack Rags. (Trans. 22.)

16. Plaintiffs' products under the trade-mark "Nu-Enamel" are sold throughout the United and twenty-four foreign countries. (Trans. 24.)

17. Plaintiffs' products are sold through approximately 3,000 dealers, such as hardware, radio stores, et cetera, located throughout the United States, and in approximately 300 stores, in which plaintiffs' products are sold exclusively, some 25 or 30 of which are located in Chicago and vicinity. These stores are operated under the name "Nu-Enamel." (Trans. 14 and 25.)

18. Plaintiffs and their predecessors have, since the inception of the business, used the slogans "One coat covers" and "No brush marks," and for many years have used the slogans, "Coat of Indestructible Beauty," "Coat of Enduring Beauty" and "Easy to Apply."

40 19. The original plaintiff herein registered the trade-mark "Nu-Enamel" in the United States Patent Office on November 14, 1933, No. 308,024, and plaintiff, Nu-Enamel Corporation of Delaware, is the owner of said trade-mark and the registration thereof, and the good will connected with said trade-mark. The trade-mark "Nu-Enamel" was adopted by Charles L. Lloyd in 1922 or 1923.

20. Said trade-mark, at the time of its adoption, was new and fanciful and had never before been used as a trade-mark for the products to which Charles L. Lloyd applied it, namely, Paints, Varnishes, Enamels, Top Dressing, Sandpaper, Paint Remover and Paint Brushes.

21. The name "Nu-Enamel" has come to mean, and is understood to mean throughout the United States, including the State of Illinois, and the City of Chicago, plaintiffs' and plaintiffs' products only, and the word "Nu-Enamel" is a mark by which the goods of the plaintiffs are distinguished from other goods of the same class. (Par. 2 amended answer)

22. The name "Nu-Enamel" is a valid common law trade-mark and is the sole property of the plaintiff, Nu-Enamel Corporation of Delaware.

23. Defendant, Armstrong Paint & Varnish Works, in the Fall of 1934, and long after plaintiffs' products had become well known and popular with the trade and public, and after the name "Nu-Enamel" had become the distinctive designation of plaintiffs' products and of plaintiffs' business, and after the slogans "One Coat Covers," "No Brush Marks," "Coat of Indestructible Beauty" and "Coat of Enduring Beauty" had become associated with plaintiffs' products, began the manufacture and sale, in Chicago, Illinois and elsewhere in the United States, of an enamel which it sold under the name "Nu-Beauty Enamel."

24. Defendant, at the time it put its product upon the 41 market under the name "Nu-Beauty Enamel," used in connection with advertising the said product, the slogans "One coat covers," "Leaves no brush marks," "Anyone can apply it," and sold its product at the same price at which plaintiffs' similar product was sold; and defendant displayed and caused to be displayed at stores, handling its products, signs reading "Nu-Beauty Enamel," and defendant used other features of plaintiffs' sales plan, such as instructions for painting automobiles, et cetera; and defendant displays its products for sale at retail to the public in the manner in which plaintiffs' products are displayed for sale.

25. Shortly after the filing of this suit, defendant changed the name of its product from "Nu-Beauty Enamel" to "New-Beauty Enamel" but continued to use, in connection with the sale of its product, the slogans and other sales features used by plaintiffs in the sale of their products.

26. The use by the defendant of the words "Nu-Beauty Enamel" and "New-Beauty Enamel" are calculated to and



do confuse the public into accepting defendant's products as and for the product of the plaintiffs, and retail merchants are enabled to and do substitute and pass off defendant's product bearing the name "Nu-Beauty Enamel" and "New-Beauty Enamel" as and for the plaintiffs' product sold under the trade-mark "Nu-Enamel."

### CONCLUSIONS OF LAW.

1. Plaintiff, Nu-Enamel Corporation of Delaware, is the owner of the common law trade-mark consisting of the word "Nu-Enamel."

2. The registration of the trade-mark "Nu-Enamel" in the United States Patent Office, November 14, 1933, No. 308,024, is valid, and plaintiff, Nu-Enamel Corporation of Delaware, is the owner of said registration.

3. The words "Nu-Beauty Enamel" and "New-Beauty Enamel" used by the defendant are colorable imitations and infringements of plaintiffs' common law and registered trade-mark "Nu-Enamel."

4. The use by the defendant of the words "Nu-Beauty Enamel" and "New-Beauty Enamel," and the copying by the defendant of plaintiffs' slogans and plaintiffs' advertising and sales features constitute unfair competition with the plaintiffs.

5. Plaintiffs have been damaged by the acts of defendant and plaintiffs are entitled to an accounting.

6. Plaintiffs are entitled to a decree in conformity with these findings of fact and conclusions of law.

Enter:

*District Judge.*

Dated this ..... day of January, 1937.

43 And afterwards, to wit, on the 16th day of January, 1937, being one of the days of the regular December term of said Court, in the record of proceedings thereof, in said entitled cause, before the Honorable Charles E. Woodward, District Judge, appears the following entry, to wit: Decree,



44 IN THE DISTRICT COURT OF THE UNITED STATES.  
• • (Caption—14284) • •

Entered Jan.  
1937.

## DECREE.

This Cause came on to be heard at this term, and was argued by counsel; and thereupon, upon consideration thereof, it was Ordered, Adjudged and Decreed that the Bill of Complaint herein be and the same is hereby dismissed for want of equity.

It Is Further Ordered, Adjudged and Decreed that the defendant recover its costs herein, to be assessed against the plaintiff herein, now known as Enameline Products Corporation, an Illinois corporation, and the intervener herein, The Nu-Enamel Corporation of Delaware, and that execution issue therefor.

Enter:

Charles E. Woodward,  
Judge.

Dated Jan 16, 1937.

47 And on, to wit, the 7th day of April, 1937, came the Plaintiff and Intervenor by their attorneys and filed in the Clerk's office of said Court their certain Notice, in words and figures following, to wit:

Filed Apr.  
1937.

48 IN THE UNITED STATES DISTRICT COURT.  
• • • (Caption—14284) • •

## NOTICE.

To: Krinsky, Levitan & Glassner,  
120 South LaSalle Street,  
Chicago, Illinois.

Gentlemen:

Please take notice that on April 1, 1937, at ten o'clock A. M., or as soon thereafter as counsel can be heard, we shall appear before the Honorable Charles E. Woodward, District Judge, in the room usually occupied by him in the Federal Building, Chicago, and present a petition for appeal in the above entitled cause and ask for an order allowing appeal and approving a bond for costs on appeal. We shall at the same time

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ask for a citation. Copies of the aforementioned documents are handed you herewith.

Please take notice that on allowance of said appeal, we shall file in the Clerk's Office in said cause, said appeal papers, together with a praecipe for the record on said appeal and assignment of errors. Copies of said papers are handed you herewith.

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,

*Solicitors for Plaintiff and Intervener.*

Received a copy of the above and foregoing notice and the documents mentioned therein, this, the 31st day of March, 1937.

Krinsky, Levitan & Glassner,  
*Solicitors for Defendant.*

Apr. 1,  
7.

45 And on, to wit, the 1st day of April, 1937, came the Plaintiff and Intervener by their attorneys and filed in the Clerk's office of said Court their certain Petition for Appeal, in words and figures following, to wit:

46 IN THE UNITED STATES DISTRICT COURT.  
\* \* (Caption—14284) \* \*

### PETITION FOR APPEAL.

To the Honorable Charles E. Woodward, District Judge:

Nu Enamel Corporation, Plaintiff, and Nu-Enamel Corporation, Intervener, feeling aggrieved by the final decree entered herein on to wit: the 16th day of January, 1937, dismissing the bill of complaint, hereby pray an appeal from said decree to the United States Circuit Court of Appeals for the Seventh Circuit, for the reasons specified in the Assignment of Errors, which are filed herewith, and pray that this appeal may be allowed, and that a transcript of the record, proceedings and papers upon which said order was made, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Seventh Circuit.

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,

*Solicitors for Plaintiff and Intervener.*

Dated April 1st, 1937.

51 And on, to wit, the 7th day of April, 1937, came the Plaintiff and Intervenor by their attorneys and filed in the Clerk's office of said Court their certain Assignment of Errors, in words and figures following, to wit:

Filed Apr  
1937.

52 IN THE UNITED STATES DISTRICT COURT.

• • (Caption—14284) • •

ASSIGNMENT OF ERRORS.

Comes now Nu-Enamel Corporation, plaintiff herein, and Nu-Enamel Corporation, intervener, and file the following assignment of errors upon which they will rely in the prosecution of the appeal herewith petitioned for in said cause from the decree of this Court entered on the 16th day of January, 1937.

1. The Court erred in dismissing the bill of complaint.  
2. The Court erred in refusing to grant the relief in each and every part thereof prayed for in said bill of complaint.  
3. The Court erred in refusing to enjoin the defendant as prayed in the bill of complaint.

4. The Court erred in refusing to order an accounting of profits and damages as prayed in the bill of complaint.

5. The Court erred in decreeing that the defendant recover its costs herein..

6. The Court erred in finding and holding that the name "Nu-Enamel" is not a valid trade-mark either at common law or under the Trade-Mark Laws of the United States.

7. The Court erred in failing to find and hold that the name "Nu-Enamel" is a valid trade-mark.

8. The Court erred in failing to find and hold that the use by the defendant of the words "Nu-Beauty Enamel" and "New Beauty Enamel" as names for its product infringe the trade-mark "Nu-Enamel."

9. The Court erred in failing to find and hold that the names "Nu-Beauty Enamel" and "New Beauty Enamel" used by the defendant are deceptive and colorable imitations of the trade-mark "Nu-Enamel" and an infringement thereof at common law.

10. The Court erred in failing to find and hold on consideration of the testimony, that defendant has infringed plaintiff's and intervener's trade-mark and competed unfairly with them.

11. The Court erred in finding and holding that "Nu-

Enamel" appearing on plaintiff's and intervenor's labels is a phonetic spelling or misspelling of the word "New" and means "New."

12. The Court erred in finding and holding that "Nu-Enamel" used in connection with paint or enamel sold by plaintiff and intervenor means "New" and "New Enamel" and is a coined and generic term descriptive of the product to which it is applied and of its new or recent origin.

13. The Court erred in finding and holding that "Nu" was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of "New" to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name "Nu-Enamel."

14. The Court erred in failing to find and hold that the name "Nu-Enamel" has acquired a secondary meaning, indicating only the product of the plaintiff and intervenor.

15. The Court erred in failing to find and hold that by reason of defendant's use of "Nu-Beauty Enamel" and "New Beauty Enamel" defendant's goods have been passed off as and for the "Nu-Enamel" goods of the plaintiff and intervenor.

16. The Court erred in failing to find and hold that the defendant had copied plaintiff's and intervenor's advertising slogans and other sales features used by plaintiff and intervenor in the sale of their products and had violated their rights in so doing.

17. The Court erred in refusing to enter the findings of fact and conclusions of law tendered on behalf of the plaintiff and intervenor.

18. The Court erred in finding and holding that it had no jurisdiction of the issues of unfair competition or other issues in this case.

Wherefore plaintiff and intervenor pray that the decree herein be reversed and that the District Court of the United States for the Northern District of Illinois, Eastern Division, be directed to enter a decree for plaintiff and intervenor for an injunction, an accounting of damages and profits, and for costs as prayed in the bill of complaint.

Nu-Enamel Corporation,  
plaintiff,

Nu-Enamel Corporation,  
intervenor.

By Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,  
Their Solicitors.



49 And afterwards, to wit, on the 7th day of April, 1937, being one of the days of the regular April term of said Court, in the record of proceedings thereof, in said entitled cause, before the Honorable Charles E. Woodward, District Judge, appears the following entry, to wit:

Entered A  
1937.

50 IN THE UNITED STATES DISTRICT COURT.  
• • (Caption—14284) • •

**ORDER ALLOWING APPEAL AND APPROVAL OF  
BOND.**

Now comes the plaintiff, Nu-Enamel Corporation, and the intervener, Nu-Enamel Corporation, by their solicitors, and present their petition for appeal and approval of their cost bond in the sum of Two Hundred and Fifty Dollars (\$250.00) and move the Court for an allowance of said appeal and the approval of said bond.

It is therefore ordered by the Court that said appeal be and the same is hereby allowed to the United States Circuit Court of Appeals for the Seventh Circuit and that said bond be and is hereby approved, & filed.

Charles E. Woodward,  
*District Judge.*

Dated April 7, 1937.

55 And on, to wit, the 7th day of April, 1937, came the Plaintiff and Intervenor by their attorneys and filed in the Clerk's office of said Court their certain Bond on Appeal, in words and figures following, to wit:

56 IN THE UNITED STATES DISTRICT COURT.  
• • (Caption—14284) • •

**APPEAL BOND.**

Know all men by these Presents, that we, Enameline Products Corporation, formerly Nu-Enamel Corporation, a corporation of Illinois, and Nu-Enamel Corporation, a corporation of Delaware, as principals, and Glens Falls Indemnity Company, a corporation, as sureties, are held and firmly bound unto Armstrong Paint & Varnish Works, defendant, in the full and just sum of Two Hundred and Fifty (\$250.00) Dollars, to be paid to the said defendant, its respective attorneys, executors, administrators, or assigns; to which payment, well

and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally, firmly by these Presents.

Whereas, lately at a session of the District Court of the United States for the Northern District of Illinois, Eastern Division, in a suit pending in said Court, between Nu-Enamel Corporation, plaintiff, and Nu-Enamel Corporation, intervener, and said Armstrong Paint & Varnish Works, defendant, a decree was rendered against the said plaintiff and intervener, dismissing the bill of complaint and the said plaintiff and intervener having obtained from said Court an order allowing an appeal to the United States Circuit Court of Appeals for the Seventh Circuit, and filed a copy thereof in the Clerk's Office of the said Court to reverse the decree of the aforesaid Court, and a citation directed to the said defendant citing and admonishing it to be and appear at the United States Circuit Court of Appeals for the Seventh Circuit within thirty (30) days from the date of the order allowing the aforesaid appeal.

Now, the condition of the above obligation is such, that if the said plaintiff and intervener shall prosecute their said appeal to effect, and shall answer all damages and costs, if any, that may be awarded against it if it fail to make its plea good, then the above obligation to be void; otherwise to remain in full force and effect.

Sealed with our seals and dated this 5th day of April, 1937.

Enameline Products Corporation,

By C. L. Lloyd,

*President.*

(no seal)

Attest:

J. O. Edwards,  
*Secretary.*

Nu-Enamel Corporation,

By C. E. Steffey,

*President.*

(Delaware Corporate Seal)

Attest:

J. O. Edwards,  
*Secretary.*

Glens Falls Indemnity Company,

By Schofield B. Gross

(seal)

(Illinois Corporate Seal)

Approved:

Charles E. Woodward,  
*Judge.*

*Order Extending Time.*

121

186 And afterwards, to wit, on the 3rd day of May, 1937, being one of the days of the regular May term of said Court, in the record of proceedings thereof, in said entitled cause, before the Honorable Charles E. Woodward, District Judge, appears the following entry, to wit:

Entered Mr.  
1937.

187 IN THE UNITED STATES DISTRICT COURT.  
\* \* (Caption—14284) \* \*

*ORDER.*

Now on this day, for good cause shown, It Is Her by Ordered that the time for appellants to file the Transcript in the United States Court of Appeals for the Seventh Circuit, and to docket the case therein be, and is hereby extended to and including the 15th day of May, 1937.

Enter:

Charles E. Woodward,  
*United States District Judge.*

Approved as to Form:

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,

*Solicitors for Plaintiff and Intervener.*

Krinsky, Levitan & Glassner,  
*Solicitors for Defendant.*

Dated this 3 day of May, 1937.

190 And afterwards, to wit, on the 12th day of May, 1937, being one of the days of the regular May term of said Court, in the record of proceedings thereof, in said entitled cause, before the Honorable John P. Barnes, District Judge, appears the following entry, to wit:

191 IN THE UNITED STATES DISTRICT COURT.  
\* \* (Caption—14284) \* \*

*ORDER.*

On motion of attorneys for the appellants, for good cause shown, It Is Hereby Ordered that the time for appellants to file the transcript of record in the United States Circuit

*Stipulation re Exhibits.*

Court of Appeals for the Seventh Circuit, and to docket the case therein be, and is hereby extended to and including the 29th day of May, 1937.

Enter:

Barnes,

*District Judge.*

Dated this 12th day of May, 1937.

Apr. 7.

62 And on, to wit, the 7th day of April, 1937, came the parties by their attorneys and filed in the Clerk's office of said Court their certain Stipulation, in words and figures following, to wit:

63

IN THE UNITED STATES DISTRICT COURT.

(Caption—14284)

STIPULATION.

It is hereby stipulated by and between counsel for the parties to this cause, that in the preparation of the record for appeal, which is being taken by the plaintiffs to the United States Circuit Court of Appeals for the Seventh Circuit, that all exhibits offered at the trial of this cause by the parties, be considered exhibits of material and shall be transmitted to said Court of Appeals as physical exhibits.

Edward S. Rogers,

William T. Woodson,

James H. Rogers,

*Attorneys for Plaintiff and Intervener.*

Krinsky Levitan & Glassner,

*Attorneys for Defendant.*

Dated this 12th day of March, 1937.

Approved:

Charles E. Woodward,

*District Judge.*

April 7, 1937.

188 And afterwards, to wit, on the 3rd day of May, 1937, being one of the days of the regular May term of said Court, in the record of proceedings thereof, in said entitled cause, before the Honorable Charles E. Woodward, District Judge, appears the following entry, to wit: Entered &  
1937.

189 IN THE UNITED STATES DISTRICT COURT.  
• • (Caption—14284) • •

## ORDER.

On motion of plaintiff and intervener to strike from the file items 1, 2, 3, 4, and 5 of defendant's praecipe,

It Is Hereby Ordered that the motion of plaintiff and intervener is granted as to items 2, 3 and 4, and denied as to items 1 and 5.

Enter:  
Charles E. Woodward,  
*United States District Judge.*

Approved as to Form:

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,

*Solicitors for Plaintiff and Intervener.*

Krinsky, Levitan & Glassner,  
*Solicitors for Defendant.*

Dated this 3 day of May, 1937.

192 And on, to wit, the 13th day of May, 1937, came the Parties by their attorneys and filed in the Clerk's office of said Court their certain Stipulation, in words and figures following, to wit:

193 IN THE UNITED STATES DISTRICT COURT.  
• • (Caption—14284) • •

## STIPULATION.

It is hereby stipulated by and between counsel for the parties herein that the order entered herein on the 6th day of



May, 1937, with respect to defendant's praecipe, be and the same is modified to read as follows:

It Is Hereby Ordered that the motion of plaintiff and intervenor is granted as to items 2, 3, 4 and 5, and denied as to items 1 and 6.

Edward S. Rogers,

William T. Woodson,

James H. Rogers,

*Attorneys for Plaintiff and Intervener.*

Krinsky, Livitan & Glassner,

*Attorney for Defendant.*

Approved:

Barnes,

*District Judge. May 13, 1937.*

Dated this 12th day of May, 1937.

APR. 7. 58 And on, to wit, the 7th day of April, 1937, came the Plaintiff and Intervenor by their attorneys and filed in the Clerk's office of said Court their certain Praecept, in words and figures following, to wit:

59 IN THE UNITED STATES DISTRICT COURT.  
• • (Caption—14284) • •

### PRAECIPE.

To the Clerk of said Court:

You are hereby requested to prepare a transcript of record in the above entitled cause, to be filed in the United States Circuit Court of Appeals for the Seventh Circuit, as the record for appeal of said cause, and to include in said transcript of record the following items:

1. Bill of complaint and Exhibits A, B and C, attached thereto.
2. Defendant's amended answer, with Exhibit "A" attached.
3. Petition by Nu-Enamel Corporation of Delaware for leave to intervene as a party plaintiff.
4. Order granting leave to Nu-Enamel Corporation of Delaware to intervene.
5. A narrative statement of evidence.

6. The findings of fact and conclusions of law entered by the Court.
- 60 7. Findings of fact and conclusions of law tendered on behalf of plaintiff and intervenor.
8. Final order dismissing the bill of complaint.
9. Notice for appeal.
10. Petition for appeal.
11. Order allowing appeal and approval of bond.
12. Assignment of errors.
13. Citation.
14. Appeal bond.
15. Order approving statement of evidence.
16. This praecipe.
17. Stipulation between counsel that all exhibits offered in evidence at the trial be considered exhibits of material and shall be transmitted to the Court of Appeals for the Seventh Circuit as physical exhibits.
18. All exhibits offered in evidence at the hearing, as shown on the attached list, these to be set up as physical exhibits.
19. Clerk's certificate.

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,

*Solicitors for plaintiff and intervenor.*

Dated April 1st, 1937.

61 PLAINTIFF'S AND INTERVENER'S EXHIBITS.

D, E, F, G, G-1, G-2, G-3, G-4, G-5, G-6, G-7, G-8, G-9, G-10, G-11, G-12, G-13, G-14, G-15, G-16, G-17, G-18, G-19, G-20, G-21, G-22, G-23, H, I, J, K, M, N-1, N-2, N-3, N-4, N-5, N-6, N-45, N-46, N-8, N-9, N-10, N-11, N-12, N-13, N-14, N-15, N-16, N-17, N-17-A, N-18, N-19, N-20, N-20-A, N-21, N-21-A, N-22, N-23, N-24, 25, 26, 26-A, 27, 28, 28-A, 29, 29-A, 30, 30-A, 31, 31-A, 32, 33, 34, 34-A, 35, 36, 37, 38, 39, 40, 40-A, 41, 42, 43, 44, O, P, Q, Q-1, Q-2, R, T, T-1, T-2, U, U-1, U-2, U-3, U-4, U-5, U-6, U-7, U-8, U-9, U-10.

## DEFENDANT'S EXHIBITS:

A, B, C, D, E, F, G, H, 38, 39, 40, 41, 42 to 53, inc., 54 to 59, inc., 60, 75, 76, 77, 78, 79, 80 to 85, inc., 1 to 10, inc., 91, 92, 93, 94, 95, 96, 97, 98, 99, 100, 61-A, 61-B, 61-C, 62-A, 62-B, 63-A, 63-B, 64-A, 64-B, 65-A, 65-B, 65-C, 66-A, 67-A, 67-B, 67-C, 67-D, 68-A, 68-B, 69-A, 70-A, 70-B, 70-C, 71-A, 71-B, 72-A, 72-B, 72-C, 73-A, 73-B, 74-A, 74-B, 86-A, 86-B, 86-C, 86-D, 86-E, 87-A, 88-A, 88-B, 88-C, 88-D, 88-E, 89-A, 89-B, 90-A, 90-B, 90-C, 90-D, 101 to 129, inc.

Apr. 16,  
7.

64 And on, to wit, the 16th day of April, 1937, came the Defendant by its attorneys and filed in the Clerk's office of said Court its certain Praecept, in words and figures following, to wit:

65 IN THE DISTRICT COURT OF THE UNITED STATES.  
\* \* (Caption—14284) \* \*

## PRAECEPT.

To the Clerk of said Court:

You Are Requested to include in the transcript of record in the above entitled cause to be filed in the Circuit Court of Appeals for the Seventh Circuit, the following items in addition to the items requested by solicitors for the plaintiff:-

1. Exhibit "A" attached to the amendment to the answer filed April 30, 1936, being bill of particulars referred to in Paragraph 9 of defendant's amended answer.

2. Interrogatories filed by defendant May 21, 1936.

3. Answers to defendant's interrogatories and documents filed in connection with answers to interrogatories numbered 7 and 9, filed June 4, 1936.

4. Amended interrogatories numbered 5 and 10, filed June 30, 1936.

5. Answers to defendant's amended interrogatories numbered 5 and 10, filed July 13, 1936.

6. Defendant's Exhibit No. 38, to be set up as a physical exhibit.

Krinsky, Levitan & Glassner,  
*Solicitors for Defendant.*

Dated April 16, 1937.

194 Northern District of Illinois, { ss.  
Eastern Division.

I, Henry W. Freeman, Clerk of the District Court of the United States for the Northern District of Illinois, do hereby certify the above and foregoing to be a true and complete transcript of the proceedings had of record made in accordance with Praeceptum filed in this Court in the cause entitled Nu-Enamel Corporation, *vs.* Armstrong Paint & Varnish Works, as the same appear from the original records and files thereof now remaining in my custody and control.

In Testimony Whereof, I have hereunto set my hand and affixed the seal of said Court at my office, in the City of Chicago, in said District, this 13th day of May, A. D. 1937.

Henry W. Freeman,  
*Clerk.*

(Seal)

195 IN THE UNITED STATES DISTRICT COURT.  
\* \* \* (Caption—14284) \* \*

**CITATION.**

To Armstrong Paint & Varnish Works, defendant,—Greeting:

You are hereby cited and admonished to be and appear in the United States Circuit Court of Appeals for the Seventh Circuit in the City of Chicago, State of Illinois, within thirty (30) days from the date hereof, pursuant to an order allowing an appeal from the District Court of the United States for the Northern District of Illinois, Eastern Division, in a case wherein Nu-Enamel Corporation, plaintiff and Nu-Enamel Corporation, intervener, are appellants and you are appellee, to show cause, if there be, why the decree rendered against the said parties should not be set aside.

This 7th day of April, 1937.

Charles E. Woodward,  
*District Judge.*

Service of the above citation accepted this 7th day of April, 1937.

Krinsky, Levitan & Glassner,  
Solicitors for defendant.

196 (Endorsed) In the United States District Court \* \*  
(Caption—14284) \* \* Citation Filed Apr 7 1937 Henry  
W. Freeman Clerk Rogers, Woodson and Rogers 801—122  
S. Michigan Ave. Chicago, Illinois.





UNITED STATES CIRCUIT COURT OF APPEALS

For the Seventh Circuit.

I, Frederick G. Campbell, Clerk of the United States Circuit Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing printed pages, numbered 1 to 127, inclusive, contain a true copy of the printed record, printed under my supervision and filed on the sixteenth day of July, 1937, upon which the following entitled cause was heard and determined:

Nu-Enamel Corporation, Plaintiff, and  
Nu-Enamel Corporation, Intervenor,

*Appellants,*

*vs.*

Armstrong Paint and Varnish Works,

*Appellee,*

No. 6268, October Term, 1937, as the same remains upon the files and records of the United States Circuit Court of Appeals for the Seventh Circuit.

In Testimony Whereof I hereunto subscribe my name and affix the seal of said United States Circuit Court of Appeals for the Seventh Circuit, at the City of Chicago, this 12th day of May, A. D. 1938.

(Seal)

Frederick G. Campbell,  
*Clerk of the United States Circuit Court  
of Appeals for the Seventh Circuit.*



At a regular term of the United States Circuit Court of Appeals for the Seventh Circuit begun and held in the United States Court Room in the City of Chicago, in said Seventh Circuit, on the sixth day of October, 1936, of the October Term, in the year of our Lord one thousand nine hundred and thirty-six, and of our Independence the one hundred and sixty-first.

Nu-Enamel Corporation, Plaintiff,  
and Nu-Enamel Corporation, In-  
tervenor,

*Appellants,*

6268

*vs.*

Armstrong Paint and Varnish  
Works,

*Defendant-Appellee.*

Appeal from the District Court  
of the United States for the  
Northern District of Illi-  
nois, Eastern Division.

And, to-wit: On the thirteenth day of May, 1937, there was filed in the office of the Clerk of this Court, an appearance of counsel for Appellants, which said appearance is in the words and figures following, to-wit:

UNITED STATES CIRCUIT COURT OF APPEALS

For the Seventh Circuit.

No. 6268.

October Term, 1936.

Nu-Enamel Corporation, Plaintiff,  
Nu-Enamel Corporation, Intervenor,

*vs.*

Armstrong Paint and Varnish Works.

The Clerk will enter our appearance as counsel for Appel-  
lants.

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,  
122 So. Michigan Ave.,  
Chicago, Illinois.

Endorsed: Filed May 13, 1937. Frederick G. Campbell,  
Clerk.

And afterwards, to-wit: On the seventeenth day of May, 1937, there was filed in the office of the Clerk of this Court, an appearance of counsel for Appellee, which said appearance is in the words and figures following, to-wit:

UNITED STATES CIRCUIT COURT OF APPEALS

For the Seventh Circuit.

No. 6268.

October Term, 1936.

Nu-Enamel Corporation, Plaintiff,  
Nu-Enamel Corporation, Intervenor,

*vs.*

Armstrong Paint and Varnish Works.

The Clerk will enter my appearance as counsel for appellee.

Moses Levitan,  
120 So. La Salle St.,  
Chicago, Illinois.

Endorsed: Filed May 17, 1937. Frederick G. Campbell,  
Clerk.

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At a regular term of the United States Circuit Court of Appeals for the Seventh Circuit begun and held in the United States Court Room in the City of Chicago, in said Seventh Circuit, on the fifth day of October, 1937, of the October Term, in the year of our Lord one thousand nine hundred and thirty-seven, and of our Independence the one hundred and sixty-second.

---

And, to-wit: On the eighth day of February, 1938, the following further proceedings were had and entered of record, to-wit:

Tuesday, February 8, 1938.

Court met pursuant to adjournment.

Before:

Hon. Evan A. Evans, Circuit Judge.  
Hon. Walter E. Treanor, Circuit Judge.  
Hon. Walter C. Lindley, District Judge.

Nu-Enamel Corporation, Plaintiff,  
Nu-Enamel Corporation, Inter-  
venor,  
6268 vs.  
Armstrong Paint and Varnish  
Works.

} Appeal from the District Court  
of the United States for the  
Northern District of Illi-  
nois, Eastern Division.

Now this day come the parties by their counsel, and this cause comes on to be heard on the transcript of the record and briefs of counsel, and on oral argument by Mr. Edward S. Rogers, counsel for appellants, and by Mr. Moses Levitan, counsel for appellee, and the Court having heard the same takes this matter under advisement.

---

And afterwards, to-wit: On the twenty-fourth day of February, 1938, there was filed in the office of the Clerk of this Court, the Opinion of this Court, which said Opinion is in the words and figures following, to-wit:



## IN THE UNITED STATES CIRCUIT COURT OF APPEALS

For the Seventh Circuit

No. 6268.

OCTOBER TERM, 1937, JANUARY SESSION, 1938.

NU-ENAMEL CORPORATION, Plaintiff, and  
 NU-ENAMEL CORPORATION, Intervener,  
*Appellants,*

vs.

ARMSTRONG PAINT AND VARNISH  
 WORKS,  
*Defendant-Appellee.*

Appeal from the District Court  
 of the United States for the  
 Northern District of Illi-  
 nois, Eastern Division.

February 24, 1938

Before EVANS and TREANOR, *Circuit Judges*, and LINDLEY,  
*District Judge.*

LINDLEY, *District Judge.* Plaintiff appeals from a decree of the District Court dismissing for want of equity its bill for infringement of a trade-mark and to recover damages for unfair competition. The latter ground for relief was not considered by the court on its merits but was disposed of by a finding that the court, having found the trade-mark invalid, had no jurisdiction to grant relief for unfair competition.

The sufficiency of the bill of complaint was before this court in *Nu-Enamel v. Armstrong*, 81 F. (2) 1, and it was there held that the bill was sufficient and that three questions were presented, namely, (1), has plaintiff a valid trade-mark in "Nu-Enamel"; (2), is it infringed by defendant; (3), was a cause of action based on unfair trade and practice stated in the complaint. The court reversed a decree of the District Court dismissing the bill upon defendant's motion, pointing out that the first two queries were questions of fact and that the averments being sufficient as to each of them and also upon the third question, the court should hear the evidence and enter a decree in conformity therewith.

After reversal the defendant filed an answer in which it said: "Defendant admits that the name 'Nu-Enamel' has

come to mean and is understood to mean, throughout the United States, including the State of Illinois and the City of Chicago, the plaintiff and plaintiff's products only and the word 'Nu-Enamel' is a mark by which the goods of the plaintiff are distinguished from other goods of the same class."

The mark "Nu-Enamel" has been used since 1922 and was registered in 1933. It has been applied to paints, varnishes, enamels, top dressings, paint brushes, wood powder, patching plaster, wax, varnish remover, glue, mineral oil colors, solder and tack rags, all products of plaintiff. These articles are sold under the mark in 300 stores, operating under the name Nu-Enamel and handling plaintiff's products exclusively, twenty-five of which stores are located in and about Chicago. The name Nu-Enamel appears on the windows of these stores or on the window valances and is displayed by Neon signs. In addition plaintiff's products are sold under the trade-mark in every state of the union, through approximately 3,000 dealers, as well as abroad. Plaintiff has spent several hundreds of thousands of dollars each year in advertising its products under this mark. In connection with the distinctive name, plaintiff uses the slogans "One Coat Covers," "Leaves no Brush Marks" and "A Coat of Enduring Beauty." From these facts, in connection with defendant's admission, it is apparent that the word "Nu-Enamel" is the mark by which products of plaintiff covering the various articles above mentioned are distinguished from the goods of all other persons. Thus the word has developed a secondary meaning.

It is contended by defendant that the mark "Nu-Enamel" cannot be the subject matter of a valid trade-mark for the reason that it is descriptive in character, and the District Court so found. We cannot agree. The word "Nu-Enamel" as applied to paints, paint brushes, solder, wax and similar products is in no wise descriptive of the subject matter or of the possibility of results of use of the products. Rather they constitute a fanciful phrase, largely advertised and generally known to the public, signifying the products of plaintiff, irrespective of their composition, character or purpose. The name is similar to the words "Coca Cola" considered by the Supreme Court in *Coca Cola v. Koke Co.*, 254 U. S. 143 where Mr. Justice Holmes said: "The name now characterizes a beverage to be had at almost any soda fountain. It means a single thing coming from a single source, and well known to the community. It hardly would be too much to say that the drink characterizes the name as much as the name of

the drink. In other words Coca Cola probably means to most persons the plaintiff's familiar product to be had everywhere rather than a compound of particular substances. Although the fact did not appear in *United States v. Coca Cola Co.*, 241 U. S. 265, 289, we see no reason to doubt that, as we have said, it has acquired a secondary meaning in which perhaps the product is more emphasized than the producer but to which the producer is entitled." It also comes within the definition of a trade-mark contained in *Elgin Nat'l. Watch Co. v. Illinois Watch Co.*, 179 U. S. 665 at 673. There the court said that a trade-mark is "a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others. It may consist in any symbol or in any form of words." In view of the fact that the word cannot possibly be descriptive, when applied to plaintiff's products as a whole, but is a manufactured phrase which has come to mean only plaintiff's products, irrespective of their character or purpose, we find it valid.

Furthermore we think the evidence clearly shows infringement. Defendant's mark consists of the word "Nu-Enamel" with the word "Beauty" inserted between the words "Nu" and "Enamel" or between the words "New" and "Enamel." The addition of this word becomes significant in view of the slogan placed by plaintiff on its cans over the trade-mark, "The Coat of Enduring Beauty," where the word "Beauty" appears immediately above the word "Nu-Enamel."

In order to infringe a trade-mark, it is not necessary to use the identical words or that those employed be so similar that a person looking at one would always be deceived into believing that it is the other. It is sufficient to constitute infringement that one adopt a trade-name so like another in form, appearance, spelling or sound that the purchasing public is likely to become confused or misled. *Barton v. Rex-Oil Co.*, 2 F. (2) 402 (CCA3); *Northam Warren Corporation v. Universal Cosmetic Co.*, 18 F. (2) 774; *Meyer v. Dr. B. L. Bull Vegetable Medicine Co.*, 58 Fed. 384. Thus this specific trade-mark was held to be infringed in *Nu-Enamel Corporation v. Nate Enamel Co., Inc.*, 243 N. Y. App. Div. 292, affirmed in 268 N. Y. R. 574.

That there was confusion between the products of plaintiff and defendant clearly appears. Witnesses testified that they called on dealers handling defendant's product and asked

specifically for Nu-Enamel. In forty-six instances New Beauty Enamel was delivered to them, without explanation. This included products marked New Beauty Enamel and Nu Beauty Enamel, the former being the mark adopted by defendant some two months after this suit was brought. Other instances of confusion appear in the record. There was evidence of similarity in advertising, adoption of the slogans of the plaintiff and other acts, all bearing also heavily upon the issue of unfair competition.

As we have had occasion previously to announce, a manufacturer of goods is entitled to the reputation he has established and the public has the right to rely upon his distinctive means of distinguishing between his and other goods. Courts will not unduly extend monopolies under trade-marks, but where a clear property right is shown and it is apparent that that right is being invaded and trespassed upon as in the present case, we shall not hesitate to grant relief. He who establishes a favorable reputation of merchandise under a known mark, brought about by extensive advertising and backed up by continuous manufacture of reputable products branded with a definite mark, which indicates not their character or purpose but their origin, shall be protected; and he who attempts to acquire the business which "another has developed through many years of fair dealing and through the expenditures of vast sums in advertising and in establishing a good will," must face the fact that his actions will meet with disapproval and condemnation. The facts presented to us in the instant case persuade us that the defendant attempted to convert to its own use the property right which plaintiff had built up represented by the trade-mark.

In view of this determination in this respect, the conclusion of the District Court that it had no jurisdiction of the issue as to unfair competition also was erroneous.

The decree is reversed with directions to proceed in accord with the views herein expressed.

Endorsed: Filed February 24, 1938. Frederick G. Campbell, Clerk.

---



And on the same day, to-wit: On the twenty-fourth day of February, 1938, the following further proceedings were had and entered of record, to-wit:

Thursday, February 24, 1938.

Court met pursuant to adjournment.

Before:

Hon. Evan A. Evans, Circuit Judge.

Hon. Walter E. Treanor, Circuit Judge.

Hon. Walter C. Lindley, District Judge.

Nu-Enamel Corporation, Plaintiff,

Nu-Enamel Corporation, Inter-  
venor,

6268

vs.

Armstrong Paint and Varnish  
Works.

} Appeal from the District Court  
of the United States for the  
Northern District of Illi-  
nois, Eastern Division.

This cause came on to be heard on the transcript of the record from the District Court of the United States for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On Consideration Whereof: It is now here ordered, adjudged and decreed by this Court that the Decree of the said District Court in this cause be and the same is hereby reversed with costs; and that this cause be, and the same is hereby remanded to the said District Court with directions to proceed in accord with the views expressed in the Opinion of this Court.

---

And afterwards, to-wit: On the sixteenth day of March, 1938, there was filed in the office of the Clerk of this Court, a Petition for a Rehearing, which said Petition for a Rehearing is not copied here.

---

And afterwards, to-wit: On the twenty-sixth day of March, 1938, there was filed in the office of the Clerk of this Court, an Answer to Petition for Rehearing, which said Answer is not copied here.

---



And afterwards, to-wit: On the twenty-eighth day of March, 1938, the following further proceedings were had and entered of record, to-wit:

Tuesday, March 28, 1938.

Court met pursuant to adjournment.

Before:

Hon. Evan A. Evans, Circuit Judge.  
Hon. Walter E. Treanor, Circuit Judge.  
Hon. Walter C. Lindley, District Judge.

Nu-Enamel Corporation, Plaintiff,  
Nu-Enamel Corporation, Inter-  
venor,  
6268 vs.  
Armstrong Paint and Varnish  
Works,

} Appeal from the District Court  
of the United States for the  
Northern District of Illi-  
nois, Eastern Division.

It is ordered by the Court that the Petition for a Rehearing in this cause be and the same is hereby denied.

---

And afterwards, to-wit: On the twenty-ninth day of March, 1938, the Mandate of this Court issued to the District Court of the United States for the Northern District of Illinois, Eastern Division.

---

And afterwards, to-wit: On the fourth day of May, 1938, there was filed in the office of the Clerk of this Court, a Motion to recall and stay the Mandate, which said Motion is in the words and figures following, to-wit:

IN THE UNITED STATES CIRCUIT COURT OF APPEALS,

For the Seventh Circuit.

Nu-Enamel Corporation, Plaintiff,  
and Nu-Enamel Corporation,  
Intervener,

*Appellants,*

No. 6268.

*vs.*

Armstrong Paint and Varnish  
Works,

*Appellee.*

MOTION.

Now Comes Armstrong Paint and Varnish Works, Appellee herein, and moves this Honorable Court to recall and stay the mandate heretofore issued herein pending the determination by the Supreme Court of the United States of the petition for a Writ of Certiorari, to be filed by the appellee.

George A. Carpenter and  
Moses Levitan,

*Attorneys for Appellee.*

Endorsed: Filed May 4, 1938. Frederick C. Campbell,  
Clerk.

---

And afterwards, to-wit: On the sixth day of May, 1938, there was filed in the office of the Clerk of this Court, a Memorandum for Plaintiff-Appellants, which said Memorandum is in the words and figures following, to-wit :

IN THE UNITED STATES CIRCUIT COURT OF APPEALS,

For the Seventh Circuit.

Nu-Enamel Corporation, Plaintiff, and Nu-Enamel Corporation, Intervenor,	} No. 6268
<i>Appellants,</i>	
<i>vs.</i>	
Armstrong Paint and Varnish Works, <i>Defendant-Appellee.</i>	

MEMORANDUM FOR PLAINTIFFS-APPELLANTS.

Defendant has moved to recall and stay the mandate of this court pending the determination by the Supreme Court of the petition for a writ of certiorari which defendant states it is its purpose to file.

This cause has twice been before this court on appeal from decrees entered by Judge Woodward. In both instances this court reversed. The second appeal and the one to which this motion relates, was decided February 24, 1938. A petition for rehearing was filed on March 16, 1938 and denied on March 28, 1938. Thereafter, on March 29, 1938 the mandate issued and was filed in the District Court. On April 11, 1938 a motion by the plaintiffs was made for a decree in conformity with the mandate. Notice was given to defendant and the decree was presented to Judge Woodward. Counsel for defendant suggested to Judge Woodward that a petition for certiorari was to be filed, whereupon, on defendant's motion, consideration of the decree was postponed until May 16, 1938.

Rule XI of this court provides:

"Petition to the Supreme Court of the United States for writ of certiorari to review a judgment of the appellate court shall be made within thirty (30) days after the entry of the judgment of that court. Such petition shall be made as prescribed in Rules 38 and 39 of the Rules of the Supreme Court of the United States."

The judgment of this court was entered on February 24, 1938 and the mandate went down on March 29, 1938. The thirty days prescribed by the Rule expired on May 3, 1938.

The Supreme Court in *Magnum Import Company, Inc. v.*

*Coty*, 262 U. S. 159 holds that the issuance of a writ of certiorari is exceptional. Chief Justice Taft said (163):

"Our experience shows that eighty per cent of those who petition for certiorari do not appreciate these necessary limitations upon our issue of the writ. When, therefore, after the petition is filed and before its submission, an application is made for a suspension of the judgment or decree of the Circuit Court of Appeals, a heavy burden rests on the applicant.

"The petition should, in the first instance, be made to the Circuit Court of Appeals which with its complete knowledge of the cases may with full consideration promptly pass on it. That court is in a position to judge first whether the case is one likely under our practice to be taken up by us on certiorari, and second, whether the balance of convenience requires a suspension of its decree and a withholding of its mandate. It involves no disrespect to this Court for the Circuit Court of Appeals to refuse to withhold its mandate or to suspend the operation of its judgment or decree pending application for certiorari to us. If it thinks a question involved should be ruled upon by this Court, it may certify it. If it does not certify, it may still consider that the case is one in which a certiorari may properly issue, and may in its discretion facilitate the application by withholding the mandate or suspending its decree. This is a matter however wholly within its discretion. If it refuses, this Court requires an extraordinary showing, before it will grant a stay of the decree below pending the application for a certiorari, and even after it has granted a certiorari, it requires a clear case and a decided balance of convenience before it will grant such stay."

It would perhaps be unseemly to prophesy whether the Supreme Court would grant a certiorari in this case or not, but we submit that it is extremely doubtful. There seems to be no question of general or public interest. It is a question between private traders of trade-mark infringement and unfair competition. This is a question of fact, and this court held on the evidence that defendant had infringed and had competed unfairly. There is no question of jurisdiction (*Hurn v. Oursler*, 289 U. S. 238) and if there was such a question originally it was removed pending the proceeding by the transfer of the trade-mark and all business and property of the original plaintiff to the intervener, which is a Delaware

corporation, and thus diversity of citizenship exists. There is no diversity of decisions between different courts. On the contrary, the decisions have been unanimous in sustaining plaintiffs' trade-mark. (*Nu-Enamel Corporation v. Nate Enamel Co., Inc.*, 243 N. Y. App. Div. 292 (affirmed in 268 N. Y. R. 574.) *Nu-Enamel Corporation v. True Enamel, Inc.* Chancery Court of New Jersey, Docket 103/320, decided Mar. 6, 1935 (unreported). *Long Island Nu-Enamel Co. Inc. v. Neustein*, U. S. D. C., E. D., New York, No. E 7377-1934 (unreported). *Nu-Enamel Corporation v. U-Enamel-It, Inc.*, U. S. D. C., S. D., New York, No. E 78-193-1934 (unreported).)

The Supreme Court has held (*Hamilton-Brown Shoe Co. v. Wolf Brothers & Co.*, 240 U. S. 251, 258; *John Simmons Company v. Grier Brothers Company*, 258 U. S. 32, 91) that except in unusual and exceptional instances a writ of certiorari will be granted only where there is a final decree. There is no decree in this case, final or otherwise. The proceeding is pending on an application to the District Court to enter an interlocutory decree. There has been no final decree and will be none until the accounting is completed.

We suggest that it is unlikely that the Supreme Court would grant the writ in the present state of this case.

Respectfully submitted,

Edward S. Rogers,  
William T. Woodson,  
James H. Rogers,

Attorneys for Plaintiffs.

Endorsed: Filed May 6, 1938. Frederick G. Campbell,  
Clerk.



And afterwards, to-wit: On the ninth day of May, 1938, the following further proceedings were had and entered of record, to-wit:

Monday, May 9, 1938.

Court met pursuant to adjournment.

Before:

Hon. Walter C. Lindley, District Judge.

Nu-Enamel Corporation, Plaintiff,

Nu-Enamel Corporation, Inter-  
venor,

6268

vs.

Armstrong Paint and Varnish  
Works.

} Appeal from the District Court  
of the United States for the  
Northern District of Illi-  
nois, Eastern Division.

On motion of counsel for appellee, It is ordered that the Mandate in this cause be and the same is hereby recalled and stayed until the further order of this Court, and that counsel for appellee promptly file a petition for a Writ of Certiorari in the Supreme Court of the United States and forthwith file proof of the filing of said Petition in this Court.

---

UNITED STATES CIRCUIT COURT OF APPEALS,

For the Seventh Circuit.

I, Frederick G. Campbell, Clerk of the United States Circuit Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing printed pages, numbered from 131 to 144, inclusive, contain a true copy of the proceedings had and papers filed, (excepting Briefs of Counsel, Petition for Rehearing and Answer thereto, Stipulations and an Order extending time for filing briefs), in the case of:

Nu-Enamel Corporation, Plaintiff,  
Nu-Enamel Corporation, Intervenor,

*Appellants,*

*vs.*

Armstrong Paint and Varnish Works,

*Appellee,*

No. 6268, October Term, 1937, as the same remains upon the files and records of the United States Circuit Court of Appeals for the Seventh Circuit.

In Testimony Whereof I hereunto subscribe my name and affix the seal of said United States Circuit Court of Appeals for the Seventh Circuit, at the City of Chicago, this 12th day of May, A. D. 1938.

(Seal)

FREDERICK G. CAMPBELL,  
*Clerk of the United States Circuit Court  
of Appeals for the Seventh Circuit.*

SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—Filed October 10, 1938

The petition herein for a writ of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit is granted. And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

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**CHARLES ELMORE CROPLEY**  
CLERK

IN THE

**Supreme Court of the United States**

OCTOBER TERM, A. D. 1937.

No.  **51**

**ARMSTRONG PAINT AND VARNISH WORKS,**  
*Petitioner,*

*vs.*

**NU-ENAMEL CORPORATION,** an Illinois corporation,  
and

**NU-ENAMEL CORPORATION,** a Delaware corporation,  
*Intervener,*

*Respondents.*

**PETITION OF ARMSTRONG PAINT & VARNISH  
WORKS FOR THE WRIT OF CERTIORARI TO THE  
CIRCUIT COURT OF APPEALS FOR THE  
SEVENTH CIRCUIT AND BRIEF IN SUPPORT  
THEREOF.**

**GEORGE A. CARPENTER,  
GEORGE I. HAIGHT,  
MOSES LEVITAN,**

*Counsel for Petitioner.*

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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1937.

\_\_\_\_\_  
**No.** \_\_\_\_\_  
\_\_\_\_\_

**ARMSTRONG PAINT AND VARNISH WORKS,**  
*Petitioner,*

*vs.*

**NU-ENAMEL CORPORATION,** an Illinois corporation,  
and

**NU-ENAMEL CORPORATION,** a Delaware corporation,  
*Intervener,*

*Respondents.*

\_\_\_\_\_  
**PETITION OF ARMSTRONG PAINT & VARNISH  
WORKS FOR THE WRIT OF CERTIORARI TO THE  
CIRCUIT COURT OF APPEALS FOR THE  
SEVENTH CIRCUIT AND BRIEF IN SUPPORT  
THEREOF.**

\_\_\_\_\_  
*To the Honorable, the Chief Justice, and Associate Jus-  
tices of the Supreme Court of the United States:*

Your petitioner,\* Armstrong Paint & Varnish Works,  
respectfully prays for the writ of certiorari to the Cir-

\*Petitioner is sometimes referred to herein as defendant, and respondent, "Nu-Enamel Corporation," the Illinois corporation, as plaintiff.



cuit Court of Appeals for the Seventh Circuit to review a judgment of that court entered on the twenty-fourth day of February, 1938, in the case numbered and entitled on its docket No. 6268, *Nu-Enamel Corporation, plaintiff, and Nu-Enamel Corporation, intervenor, appellants, v. Armstrong Paint & Varnish Works, defendant, appellee*, reversing the decision of the United States District Court in and for the Northern District of Illinois, Eastern Division. A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith. The decision of the Circuit Court of Appeals is reported in 95 Fed. (2d) 448 and is attached as an appendix hereto.

## SUMMARY AND SHORT STATEMENT OF THE MATTER INVOLVED.

The present suit was brought in the District Court of the United States for the Northern District of Illinois, Eastern Division, by Nu-Enamel Corporation, an Illinois corporation, against Armstrong Paint & Varnish Works, an Illinois corporation. The Bill of Complaint stated at the outset (R. 2), "This is a suit arising under the trade-mark laws of the United States," and charged infringement by defendant\* of the plaintiff's alleged trade-mark "Nu-Enamel," registered under the 1920 Trade-Mark Act.

The District Court held that "Nu-Enamel" is not a valid trade-mark either at common law or under the Trade-Mark Laws of the United States, based upon the following findings of fact by the court (R. 108):

### 2. "Nu" in "Nu-Enamel", appearing on plain-

\*The Bill of Complaint charged infringement by defendant's use on paints and varnishes of the mark "Nu-Beauty Enamel," although as hereinafter set forth, defendant's mark was "Nu-Beauty," the word "Enamel" having never appeared on any product save the product commonly known as enamel.

tiff's label is a phonetic spelling or misspelling of the English word "new" and means "new".

3. "Enamel" is a common English word describing a paint which flows out to a smooth coat when applied and which usually dries with a glossy appearance, and has long been known as such in the paint industry and to the public in general.

4. "Nu-Enamel" used in connection with paint or enamel sold by plaintiff means "new enamel" and is a common and generic term descriptive of the product to which it is applied and of its new or recent origin.

5. "Nu" was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of "new" to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name "Nu-Enamel".

Respondents appealed to the Circuit Court of Appeals for the Seventh Circuit which reversed the District Court and held "Nu-Enamel" to be a valid trade-mark.

The District Court had previously (before answer was filed) dismissed the Bill of Complaint because of facts appearing on the face of the bill and the exhibits attached thereto (R. 2-11). On appeal, the Circuit Court of Appeals for the Seventh Circuit (81 Fed. (2d) 1) reversed on the following grounds (which it later overruled and disregarded):

"Determination of the question (i.e. the validity of 'Nu-Enamel' as a trade-mark) turns largely upon the use of the word 'Nu' . . . . The Court is not justified in assuming, without evidence, that 'Nu' is phonetic spelling of new." (81 Fed. (2d) 1, at page 2.) (Part in parenthesis ours.)

Defendant then filed its answer (R. 13) and after the hearing which was directed by the Circuit Court of Appeals, the District Court made the findings of fact hereinabove set forth, and again dismissed the bill. Said

findings of fact are based on evidence which not only was uncontradicted, but was largely corroborated and furnished by the testimony of plaintiff's witnesses and records of the plaintiff.

On appeal from the decree of the District Court, dismissing the bill after hearing, the Circuit Court of Appeals, apparently disregarding its first opinion and the directions given therein to the District Court, and absolutely disregarding the uncontradicted findings of fact of the District Court, reversed the District Court and held that "Nu-Enamel" was a valid trade-mark.

Thus, this case has been before four courts, twice before the District Court and twice before the Court of Appeals. Twice the District Court decided against the plaintiff. On the first appeal, the Circuit Court of Appeals, in effect, decided that if "Nu" in "Nu-Enamel" meant "new" (as the District Court later found), "Nu-Enamel" was not a valid trade-mark. On the second appeal, the Circuit Court of Appeals found "Nu-Enamel" to be a valid trade-mark in spite of the findings by the District Court that "Nu-Enamel" was descriptive of the product.

#### SUBJECT MATTER.

Plaintiff's trade-mark (R. 9) covers mixed paints, varnishes, paint enamels, and other kindred products. Plaintiff's application for this trade-mark under the 1905 Trade-Mark Act was refused because the words "Nu-Enamel" were descriptive of the product. Such refusal was acquiesced in by the plaintiff, which then registered its mark under the 1920 Trade-Mark Act (R. 32, Plf.'s Ex. M), adopted only to permit registration in foreign countries and registration under which act is not even *prima facie* evidence of ownership. (*Kellogg*

*Co. v. National Biscuit Co.* (C. C. A. 2), 71 Fed. (2d) 662, 666.)

We are concerned here only with the product known as *enamel*.

The record discloses, without contradiction, that defendant's mark was "Nu-Beauty" or "Armstrong New Beauty"; that its products were designated with the species underneath the mark, as follows:

NU-BEAUTY PAINT	or	ARMSTRONG NEW BEAUTY PAINT
NU-BEAUTY VARNISH	or	ARMSTRONG NEW BEAUTY VARNISH
NU-BEAUTY FURNITURE CREAM	or	ARMSTRONG NEW BEAUTY FURNITURE CREAM
NU-BEAUTY ENAMEL	or	ARMSTRONG NEW BEAUTY ENAMEL

The record further discloses, without contradiction, that the defendant never used the word "*enamel*" with its mark "Nu-Beauty" or "Armstrong New Beauty" on any product save the product commonly and generally known as "*enamel*." (R. 41, 72. Def.'s Exs. 80-85 inc.) Plaintiff sells its *enamel* under its mark "Nu-Enamel" without further or other designation of the product as *enamel* (R. 7).

The Circuit Court of Appeals in considering, in its opinion, whether "Nu-Enamel" is a descriptive term, discusses products other than *enamel* and in no way involved herein, and fails to discuss and consider the product known as "*enamel*," the *only* product here in issue. The

Circuit Court of Appeals, therefore, evades the obvious question based on the record facts in this case and raised in its first opinion, namely, whether "Nu-Enamel" is descriptive of the product known as *enamel*, and the question whether defendant in the sale of *enamel* has the right to use the word *enamel* in connection with its marks "Nu-Beauty" and "Armstrong New Beauty" to designate that product.

A startling feature of the decision is that no conflict of testimony in the District Court occurred upon which any reversal of fact could possibly be predicated, and that the Court of Appeals, in its opinion, has failed entirely to give cognizance to the findings of fact by the District Court (R. 109) that "Nu" was commonly used in the paint industry prior to the adoption by plaintiff of its trade-mark "Nu-Enamel" and that the word "enamel" describes a paint, and has failed as well to give cognizance to the other findings of fact by the District Court, above set forth (pp. 2-3).

*There was no issue of unfair competition. The Bill of Complaint did not allege unfair competition, nor did it pray for relief against unfair competition.*

The Circuit Court of Appeals was of the opinion that long user of a trade name, as a result of which it acquired a secondary meaning, could make valid as a trade-mark what was invalid, both at common law and under the Trade-Mark Laws of the United States.

If the decision of the Circuit Court of Appeals is permitted to stand, one who discovers and produces a new kind of enamel could not so advertise it to the trade or to the consumer.\*

\*Mr. Edward S. Rogers (senior counsel for respondents), in his book entitled "Good Will, Trade Marks and Unfair Trading," (1914 Ed. reprinted 1919) says (P. 79): "descriptive words are not protected as trade marks for the excellent reason that to give to one producer the exclusive right to such a word would prevent others from accurately describing their own goods."



## QUESTIONS PRESENTED.

1. Whether "Nu-Enamel," consisting of the word "Nu" which means "new," and "Enamel" which describes a common species of paint called "enamel," is a valid trade-mark under the Trade-Mark Laws of the United States for paints, and particularly the species of paint commonly known as "enamel."

2. Whether the fact that "Nu-Enamel" had acquired a secondary meaning can make it valid as a trade-mark, if it otherwise is invalid under the Trade-Mark Laws of the United States.

3. Whether the petitioner has the right in the sale of the product commonly known as enamel to use the word "enamel" in connection with its mark "Nu-Beauty" or "New Beauty".

## REASONS RELIED ON FOR THE GRANTING OF THE WRIT OF CERTIORARI.

1. The decision of the court below that a descriptive term like "Nu-Enamel," descriptive of a product known as "enamel," is a valid trade-mark, is in conflict not only with applicable decisions of this court (*Elgin Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665), but also with decisions of other Circuit Courts of Appeals, which hold that descriptive words cannot be the subject of a valid trade-mark under the Trade-Mark Laws of the United States, even where they have acquired a secondary meaning.

2. Because the Circuit Court of Appeals has decided an important question of Trade-Mark Law in a way probably untenable and in conflict with the applicable decisions of this court and of Circuit Courts of Appeals, and in conflict with the overwhelming weight of authority.

3. Because the decision of the Circuit Court of Appeals has reversed and completely disregarded important findings of fact of the trial court based on uncontradicted evidence, which action of the Circuit Court of Appeals was, therefore, in direct conflict with the rule of law stated by this court in *Adamson v. Gilliland*, 242 U. S. 350.

4. Regardless of the propriety of the holding of the Circuit Court of Appeals that "Nu-Enamel" is a valid trade-mark and not descriptive as to paint brushes, wood powder, etc., it was in error in holding it a good trade-mark to designate enamel, the only product here involved, whether such enamel be new or old, or whether "new" be spelled "nu," or "old" be spelled "auld".

5. The court below erred in holding that the fact that a descriptive term has acquired a secondary meaning gives it validity as a trade-mark under the Trade-Mark Laws of the United States, and that such mark is protected even where unfair competition is not an issue, contrary to the applicable decision of this court in *Elgin Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665.

6. Because of the sharp conflict in the two opinions of the Circuit Court of Appeals rendered herein and the sharp conflict of opinion between the Court of Appeals and the District Court in a proceeding, the subject-matter and final judgment of which is of public, economic and industrial importance in the paint and other industries and because they involve monopolistic control of words of common usage.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued under the seal of this Court directed to the United States Circuit Court of Appeals for the Seventh Judicial Circuit, sitting at Chicago, Illinois, commanding said court to certify and send to this

court on a day to be designated, a full and complete transcript of the record and all proceedings of the Circuit Court of Appeals had in this cause, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Circuit Court of Appeals be reversed, and that petitioner be granted such other and further relief as may seem proper.

GEORGE A. CARPENTER,

GEORGE I. HAIGHT,

MOSES LEVITAN,

*Counsel for Petitioner.*

## BRIEF IN SUPPORT OF THE PETITION.

### OPINIONS BELOW.

The District Court did not render a written opinion, but its findings of fact and conclusions of law appear at pages 108 and 109 of the record, and the decree of the District Court appears on page 115 of the record. The opinion of the Circuit Court of Appeals for the Seventh Circuit is reported in 95 Fed. (2d) 448, and is attached as an appendix hereto. The first opinion of the Circuit Court of Appeals for the Seventh Circuit is reported in 81 Fed. (2d) 1.

### JURISDICTION.

1. The decision below was entered on February 24, 1938 (R. 134). Petition for rehearing was filed on March 16, 1938 (R. 138), and denied on March 8, 1938 (R. 139).

2. The judgment was rendered in a suit in equity brought under the Trade-Mark Statutes of the United States to determine the issues of the validity and infringement of a Trade-Mark issued under Section 15 U. S. C. A. 121.

3. The Statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, as amended by the act of February 13, 1925; U. S. C. Title 28, Section 347 (a).

### STATEMENT OF THE CASE.

The facts are sufficiently stated in the petition, to which reference is made.

## SPECIFICATIONS OF ERRORS.

The Circuit Court of Appeals for the Seventh Circuit erred,

1. In disregarding the uncontradicted fact that *enamel* is the only product on which defendant used the word "enamel" and that enamel is the only product in issue herein.

2. In reversing the decree of the District Court and in holding that "Nu-Enamel" is a valid trade-mark for paints, enamels, etc.

3. In failing to hold that "Nu-Enamel" is invalid as a trade-mark for paints and allied products because it is descriptive of the product.

4. In failing to hold that "Nu-Enamel" is invalid as a trade-mark for the product known as *enamel*, because it is descriptive of enamel.

5. In reversing the positive finding of fact of the District Court based on uncontradicted evidence that "Nu-Enamel", used in connection with paint or enamel, means "new enamel", and is a common and generic term descriptive of the product to which it is applied.

6. In disregarding entirely the finding of fact of the District Court based on uncontradicted evidence that "nu" was commonly used in the paint and other industries as a phonetic spelling of "new" to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name "Nu-Enamel".

7. In considering the issue of unfair competition and other matters not raised by the pleadings, and over which the court had no jurisdiction.



## SUMMARY OF ARGUMENT.

The points of argument follow in the main the reasons relied upon for the allowance of the writ of certiorari, and are stated in the index hereto *supra*, page 1..

## ARGUMENT

### I.

The decision of the Circuit Court of Appeals that "Nu-Enamel" is a valid trade-mark is contrary to the trade-mark Laws of the United States, under which this suit was brought, and in conflict with applicable decisions of this court and of other Circuit Courts of Appeals.

**A. Descriptive words are not valid as trade-marks under the trade-mark laws of the United States.**

We are not concerned in this case with any product either of plaintiff or defendant other than the product commonly known as enamel. *Enamel is the only product in issue.* (R. 41, 72.)

The question in this case is whether "Nu-Enamel", which the District Court found from uncontradicted evidence to mean "new enamel" and, therefore, descriptive of the product known as enamel, can be the subject of a valid trade-mark under the Trade-Mark Laws of the United States.

The first section of the Trade-Mark Act of March 19, 1920 (Section 121, Chapter 3, Title 15, Code of Laws of

the United States of America) (15 U. S. C. A. 121), under which "Nu-Enamel" was registered, provides:

"The Commissioner of Patents shall keep a register of . . . (b) all other marks not registerable under the preceding subdivision of this chapter, except those specified in Paragraphs (a) and (b) of Section 85 of this chapter."

Paragraph (b) of Section 85, (15 U. S. C. A. Sec. 85), provides that:

"No mark which consists . . . merely in words or devices which are descriptive of the goods with which they are used . . . shall be registered."

The Circuit Court of Appeals in its opinion, however, overlooked and disregarded the fact that the only product involved in this case is enamel. In discussing the question as to whether or not "Nu-Enamel" is descriptive, the court refers to products other than enamel, entirely ignoring enamel, the only product in issue.

In respect to the question of descriptiveness of the plaintiff's mark "Nu-Enamel," it may be a good trade-mark for brushes, wood powder, wax, varnish remover, solder and tack rags, but "Nu-Enamel" is descriptive of *new enamel*, whether "new" be spelled "nu" or "new". "*New Tack Rags*" might be non-descriptive and a good trade-mark for new enamel, but it would be descriptive of *new tack rags* and invalid as a trade-mark for such *rags*. The conclusion of the Circuit Court of Appeals that the words "Nu-Enamel" are not descriptive of many articles (listed above) other than enamel, upon which Respondent uses them is not a sound basis for the further conclusion that therefore Nu-Enamel does not describe *new enamel*.

The District Court, however, basing its conclusion on

the findings of fact, hereinabove set out (pages 2-3), that "Nu-Enamel" was descriptive of the product, properly concluded that it was invalid as a trade-mark, both under the Trade-Mark Laws of the United States, and under the common law.

That words descriptive of the product with which they are used, even when misspelled, are not the subject of a valid trade-mark, either at common law or under the Trade-Mark Laws of the United States, is so fundamental that it scarcely requires the citation of authorities. We refer to the oft cited and quoted cases, *Standard Paint Co. v. Trinidad Asphalt Co.*, 220 U. S. 446, involving the misspelled word "Rubberoid"; *Canal Co. v. Clark*, 13 Wall., 311; *Elgin Watch Co. v. Illinois Watch Co.*, 179 U. S. 665. In the latter case, this court said (page 673):

" . . . it follows that no sign or form of words can be appropriated as a valid trade-mark which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose."

**B. That a descriptive word or term has acquired a secondary meaning does not render it capable of being appropriated as a valid trade-mark under the trade-mark laws of the United States.**

This question was decided by this court in *Elgin Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, where this court in language unusually applicable and pertinent hereto, said (p. 677):

"It is to be observed, however, that the question we are considering is not whether this record makes out a case of false representation, or perfidious dealing, or unfair competition, but whether appellant had the exclusive right to use the word 'Elgin' as against all the world. Was it a lawfully registered trade mark? If the absolute right to the word as a trade mark belonged to appellant, then the Cir-

cuit Court had jurisdiction under the statute to award relief for infringement; but if it were not a lawfully registered trade mark, then the Circuit Court of Appeals correctly held that jurisdiction could not be maintained.\*

"And since while the secondary signification attributed to its use of the word might entitle appellant to relief, the fact that primarily it simply described the place of manufacture, and that appellees had the right to use it in that sense, though not the right to use it, without explanation or qualification, if such use would be an instrument of fraud, we are of opinion that the general rule applied, and that *this geographical name could not be employed as a trade mark and its exclusive use vested in appellant, and that it was not properly entitled to be registered as such.* (Italics ours.)

The Elgin Watch case has been uniformly followed by the various Circuit Courts of Appeals.\*\*

The Circuit Court of Appeals, however, in this case, contrary to the above decisions of this Court and of other Circuit Courts of Appeals (including the Circuit Court of Appeals for the Seventh Circuit in the case of *Speaker Thaler*, 86 Fed. (2d) 985, 987), has held that because "Nu-Enamel" had acquired a secondary meaning, it thereby attained validity as a trade-mark, even though it is descriptive of the products to which it is applied. The admission by defendant in Paragraph 2 of its answer (R. 13) and quoted in the opinion of the court below (R. 134), is an admission only that "Nu-Enamel" had acquired a secondary meaning as a trade name. Such

\*As the District Court herein held in its Conclusions of Law. (R. 109.)

\*\*In *re Candia Dry Gingerale, Inc.* (C. C. P. A.) 86 Fed. (2d) 830, in which the *Elgin* case and other cases covering this question are reviewed at length; *Kay & Ess-Co. v. Coe* (C. A. D. C.) 92 Fed. (2d) 552; *Speaker v. Thaler*, (C. C. A. 7) 86 Fed. (2d) 985; *Barber v. Overhead Door Corporation* (C. C. P. A.) 65 Fed. (2d) 147; *Richmond Remedies v. Dr. Miles Medical Co.* (C. C. A. 8) 16 Fed. (2d) 598; *Barton v. Rex Oil Co.* (C. C. A. 3) 2 Fed. (2d) 402; *Hercules Powder v. Newton* (C. C. A. 2) 266 Fed. 169; *Vacuum Oil v. Chmaz Refining* (C. C. A. 6) 120 Fed. 254.

an admission did not give it validity as a *statutory trade-mark*. Under the prohibitions of the Trade-Mark Laws of the United States, and under the applicable decisions of this and other Federal Courts, it is incapable of being a valid trade-mark.

## II.

The Circuit Court of Appeals in its opinion has overlooked and disregarded entirely the finding of facts by the District Court that "Nu" was commonly used in the paint industry as a misspelling of "new" before plaintiff and its predecessors adopted the name "Nu-Enamel" and that enamel was an old and well known paint product.

The above finding of facts by the District Court is based on overwhelming evidence, uncontradicted (R. 96-99, 76, 77) (Def's. Ex. 39). The record discloses the common use of "Nu" in the paint industry long before plaintiff adopted the mark "Nu-Enamel". The word "enamel" is notoriously as old as the paint industry itself.\* These findings of fact by the District Court are under the principles laid down by this court in *Adamson v. Gilliland*, 242 U. S. 350, 353,\* and *McGaughn v. Real Estate Land, Title and Trust Co.*, 297 U. S. 606, 608, unassailable, and conclusive on the Circuit Court of Appeals.

"Nu" and "enamel," therefore, having been used for many years in the paint industry in connection with paint and enamels, are incapable of being appropriated and monopolized as a trade-mark.\* This court so held in *Columbia Mill v. Alcorn*, 150 U. S. 460, and *Hanover*

\*Where this court said, page 13: "the case is preeminently one for the application of the practical rule that so far as the finding of the Master or Judge who saw the witnesses depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable." *Davis v. Schwartz*, 155 U. S. 631, 636; 39 L. Ed. 289, 291; 15 Sup. Ct. Rep. 237."



*Milling Co. v. Metcalf*, 240 U. S. 403, at page 415, where the Court said:

"Of course, if the symbol or device is already in general use, employed in such a manner that its adoption as an index of source or origin would only produce confusion and mislead the public, it is not susceptible of adoption as a trade-mark. Such a case was *Columbia Mill Co. v. Alcorn*, 150 U. S. 460, 464, affirming 40 Fed. Rep 676, where it appeared that before complainant's adoption of the disputed word as a brand for its flour the same word was used for the like purpose by numerous mills in different parts of the country."

It is a rule recognized by Rogers, in his book "*Good Will, Trade-Marks and Unfair Competition*," (1914, reprinted 1919), at page 83.\*

### III

That "Nu-Enamel" may have acquired a secondary meaning does not prevent others from using such words in their primary descriptive sense as "Nu-Beauty" was used by the defendant in connection with the product known as enamel.

As heretofore pointed out in the petition, page 5, the only product on which defendant ever used the word "enamel" in connection with its mark "Nu-Beauty" was the product known as enamel. On no other product did defendant use the word "enamel" in connection with its mark "Nu-Beauty" (or "Armstrong New Beauty"). The language of this court in the analogous and applicable case of *Warner & Co. v. Lilly & Co.*, 265 U. S. 526, 28, is pertinent:

\*The courts do not protect a trader in the use of things which are common to the trade, because being common to the trade, they cannot indicate commercial origin with any one producer."

"We agree with the courts below that the charge of infringement was not sustained. The name Cocco-Quinine is descriptive of the ingredients which enter into the preparation. The same is equally true of the name Quin-Coco. A name which is merely descriptive of the ingredients, qualities or characteristics of an article of trade cannot be appropriated as a trade mark and the exclusive use of it afforded legal protection. The use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product."

The principle emphasized in the Warner case has been reiterated in numerous cases by various Circuit Courts of Appeal.\*

The Circuit Court of Appeals for the Seventh Circuit in *O'Cedar Corporation v. F. W. Woolworth, etc.*, 66 F. (2d) 363 (C. C. A. 7), said even of a validly registered trade-mark "O'Cedar" (366):

"A recognition of the validity of the trade-marks does not give appellant a monopoly of the word 'Cedar'."

(P. 367):

"That appellant acquired no exclusive right to use the words 'cedar' or 'cedar oil' as applied to polish must be readily conceded."

It is submitted that to deny to a company in existence since 1854 (R. 71) the right to sell its enamel as enamel, stretches trade-mark law beyond its elastic limits. Yet this is the result of the Court's opinion, for the defendant is permitted to sell Nu- (or Armstrong New) Beauty varnish, paint, and furniture polish, but not enamel.

\**Hygrade, etc. v. W. H. D. Lee, etc.*, (C. C. A. 10) 46 F. (2d) 771, 772; *Barton v. Rez-Oil Co.*, (C. C. A. 3) 2 F. (2d) 402; *Richmond Remedies v. Dr. Miles Medical Co.*, (C. C. A. 3) 16 F. (2d) 598; *Fawcett Publications v. Popular Mechanics*, (C. C. A. 3) 30 F. (2d) 194.

The Court in effect has held that on every species of the class, except enamel, there is no infringement. In other words, the use of the name of the species, *enamel*, in its primary and descriptive sense on cans of *enamel* only,—the only name by which the species is known in the industry,—spells infringement.

### CONCLUSION.

From the foregoing it appears that the Circuit Court of Appeals for the Seventh Circuit has now rendered a decision in conflict with its own previous decision, in conflict with the findings of facts and decision of the trial court, in conflict with the controlling and applicable decisions of this court, in conflict with applicable decisions of various Circuit Courts of Appeals (including decisions of the Circuit Court of Appeals for the Seventh Circuit) in a case of great public, economic and industrial importance, and which decision has seriously prejudiced not only the rights of petitioner, but of other paint manufacturers and dealers. We respectfully submit that if "Nu-Enamel" (or "New Enamel") is non-descriptive, and therefore, is a valid trade-mark for the product known as *enamel*, then "Auld Enamel" (or "Old Enamel") is equally non-descriptive and a valid trade-mark for the product known as *enamel*.

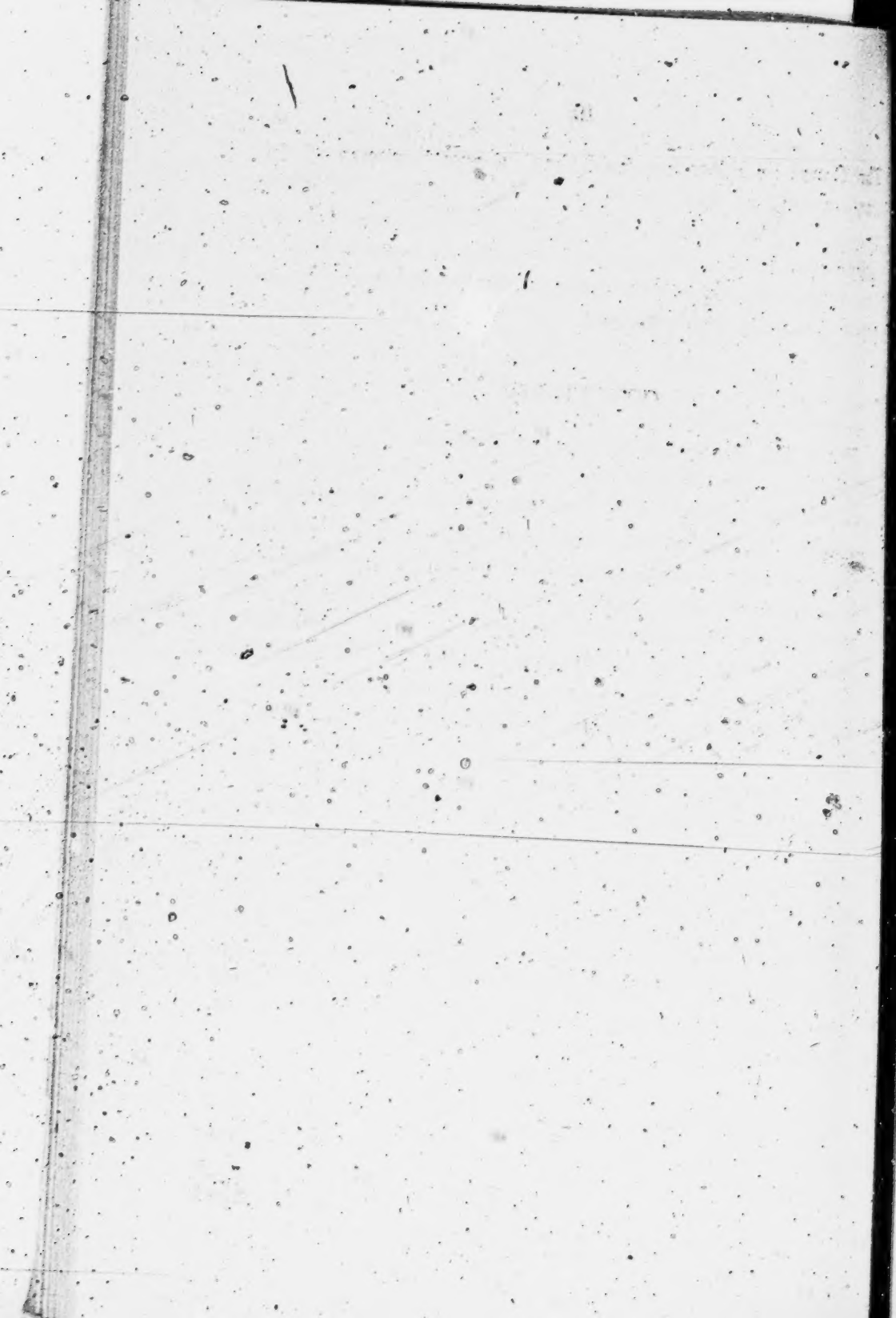
Respectfully submitted,

GEORGE A. CARPENTER,

GEORGE I. HAIGHT,

MOSES LEVITAN,

*Counsel for Petitioner.*



## APPENDIX.

Decision of the Court Below.  
(Reported in 95 F. (2d) 448.)

In the

UNITED STATES CIRCUIT COURT OF APPEALS

For the Seventh Circuit.

No. 6268. October Term, 1937, January Session, 1938.

Nu-Enamel Corporation, Plaintiff, and  
Nu-Enamel Corporation, Intervener,  
*Appellants,*

*vs.*

Armstrong Paint and Varnish Works,  
*Defendant-Appellee.*

Appeal from the  
District Court of  
the United States  
for the Northern  
District of Illi-  
nois, Eastern Di-  
vision.

February 24, 1938.

Before EVANS and TREANOR, *Circuit Judges*, and LIND-  
LEY, *District Judge*.

LINDLEY, *District Judge*. Plaintiff appeals from a de-  
cree of the District Court dismissing for want of equity  
its bill for infringement of a trade-mark and to recover  
damages for unfair competition. The latter ground for  
relief was not considered by the court on its merits but  
was disposed of by a finding that the court, having found  
the trade-mark invalid, had no jurisdiction to grant re-  
lief for unfair competition.

The sufficiency of the bill of complaint was before this  
court in *Nu-Enamel v. Armstrong*, 81 F. (2) 1, and it  
was there held that the bill was sufficient and that three  
questions were presented, namely, (1), has plaintiff a  
valid trade-mark in "Nu-Enamel"; (2), is it infringed



by defendant; (3), was a cause of action based on an unfair trade and practice stated in the complaint. The court reversed a decree of the District Court dismissing the bill upon defendant's motion, pointing out that the first two queries were questions of fact and that the averments being sufficient as to each of them and also upon the third question, the court should hear the evidence and enter a decree in conformity therewith.

After reversal the defendant filed an answer in which it said: "Defendant admits that the name 'Nu-Enamel' has come to mean and is understood to mean, throughout the United States, including the State of Illinois and the City of Chicago, the plaintiff and plaintiff's products only and the word 'Nu-Enamel' is a mark of which the goods of the plaintiff are distinguished from other goods of the same class."

The mark "Nu-Enamel" has been used since 1922 and was registered in 1933. It has been applied to paints, varnishes, enamels, top dressings, paint brushes, wood powder, patching plaster, wax, varnish remover, glue, mineral oil colors, solder and tack rags, all products of plaintiff. These articles are sold under the mark in 300 stores, operating under the name Nu-Enamel and handling plaintiff's products exclusively, twenty-five of which stores are located in and about Chicago. The name Nu-Enamel appears on the windows of these stores or on the window valances and is displayed by Neon signs. In addition plaintiff's products are sold under the trade-mark in every state of the union, through approximately 3,000 dealers, as well as abroad. Plaintiff has spent several hundreds of thousands of dollars each year in advertising its products under this mark. In connection with the distinctive name, plaintiff uses the slogans "One Coat Covers," "Leaves no Brush Marks"

and "A Coat of Enduring Beauty." From these facts, in connection with defendant's admission, it is apparent that the word "Nu-Enamel" is the mark by which products of plaintiff covering the various articles above mentioned are distinguished from the goods of all other persons. Thus the word has developed a secondary meaning.

It is contended by defendant that the mark "Nu-Enamel" cannot be the subject matter of a valid trademark for the reason that it is descriptive in character, and the District Court so found. We cannot agree. The word "Nu-Enamel" as applied to paints, paint brushes, solder, wax and similar products is in no wise descriptive of the subject matter or of the possibility of results of use of the products. Rather they constitute a fanciful phrase, largely advertised and generally known to the public, signifying the products of plaintiff, irrespective of their composition, character or purpose. The name is similar to the words "Coca Cola" considered by the Supreme Court in *Coca Cola v. Koke Co.*, 254 U. S. 143 where Mr. Justice Holmes said: "The name now characterizes the beverage to be had at almost any soda fountain. It means a single thing coming from a single source, and well known to the community. It hardly ~~would be too much to say that the drink characterizes~~ the name as much as the name of the drink. In other words Coca Cola probably means to most persons the plaintiff's familiar product to be had everywhere rather than a compound of particular substances. Although the fact did not appear in *United States v. Coca Cola Co.*, 241 U. S. 265, 289, we see no reason to doubt that, as we have said, it has acquired a secondary meaning in which perhaps the product is more emphasized than the producer but to which the producer is entitled." It also

comes within the definition of a trade-mark contained in *Elgin Nat'l. Watch Co. v. Illinois Watch Co.*, 179 U. S. 665 at 673. There the court said that a trade-mark is "a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others. It may consist in any symbol or in any form of words." In view of the fact that the word cannot possibly be descriptive, when applied to plaintiff's products as a whole, but is a manufactured phrase which has come to mean only plaintiff's products, irrespective of their character or purpose, we find it valid.

Furthermore we think the evidence clearly shows infringement. Defendant's mark consists of the word "Nu-Enamel" with the word "Beauty" inserted between the words "Nu" and "Enamel" or between the words "New" and "Enamel." The addition of this word becomes significant in view of the slogan placed by plaintiff on its cans over the trade-mark, "The Coat of Enduring Beauty," where the word "Beauty" appears immediately above the word "Nu-Enamel."

In order to infringe a trade-mark, it is not necessary to use the identical words or that those employed be so similar that a person looking at one would always be deceived into believing that it is the other. It is sufficient to constitute infringement that one adopt a trade-name so like another in form, appearance, spelling or sound that the purchasing public is likely to become confused or misled. *Barton v. Rex-Oil Co.*, 2 F. (2) 402 (CCA3); *Northam Warren Corporation v. Universal Cosmetic Co.*, 18 F. (2) 774; *Meyer v. Dr. B. L. Bull Vegetable Medicine Co.*, 58 Fed. 884. Thus this specific trade-mark was held to be infringed in *Nu-Enamel Cor-*

*Enamel Co., Inc.*, 243 N. Y. App. Div. 32, affirmed in 268 N. Y. R. 574.

That there was confusion between the products of plaintiff and defendant clearly appears. Witnesses testified that they called on dealers handling defendant's product and asked specifically for Nu-Enamel. In forty-six instances New Beauty Enamel was delivered to them, without explanation. This included products marked New Beauty Enamel and Nu Beauty Enamel, the former being the mark adopted by defendant some two months after this suit was brought. Other instances of confusion appear in the record. There was evidence of similarity in advertising, adoption of the slogans of the plaintiff and other acts, all bearing also heavily upon the issue of unfair competition.

As we have had occasion previously to announce, a manufacturer of goods is entitled to the reputation he has established and the public has the right to rely upon its distinctive means of distinguishing between his and other goods. Courts will not unduly extend monopolies under trade-marks, but where a clear property right is shown and it is apparent that that right is being invaded and trespassed upon as in the present case, we shall not hesitate to grant relief. He who establishes a favorable reputation of merchandise under a known mark, brought about by extensive advertising and backed up by continuous manufacture of reputable products branded with definite mark, which indicates not their character or purpose but their origin, shall be protected; and he who attempts to acquire the business which "another has developed through many years of fair dealing and through the expenditures of vast sums in advertising and in establishing a good will," must face the fact that his actions will meet with disapproval and condemnation.

25  
The facts presented to us in the instant case persuade us that the defendant attempted to convert to its own use the property right which plaintiff had built up represented by the trade-mark.

In view of this determination in this respect, the conclusion of the District Court that it had no jurisdiction of the issue as to unfair competition also were erroneous.

The decree is reversed with directions to proceed in accord with the views herein expressed.

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**CHARLES ELMORE CROPLEY**  
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IN THE

**Supreme Court of the United States**

**OCTOBER TERM, A. D. 1938.**

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**No. 51**

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**ARMSTRONG PAINT AND VARNISH WORKS,**  
*Petitioner,*  
**vs.**

**NU-ENAMEL CORPORATION, an Illinois corporation,**  
**and**  
**NU-ENAMEL CORPORATION, a Delaware corporation,**  
**Intervener,**  
*Respondents.*

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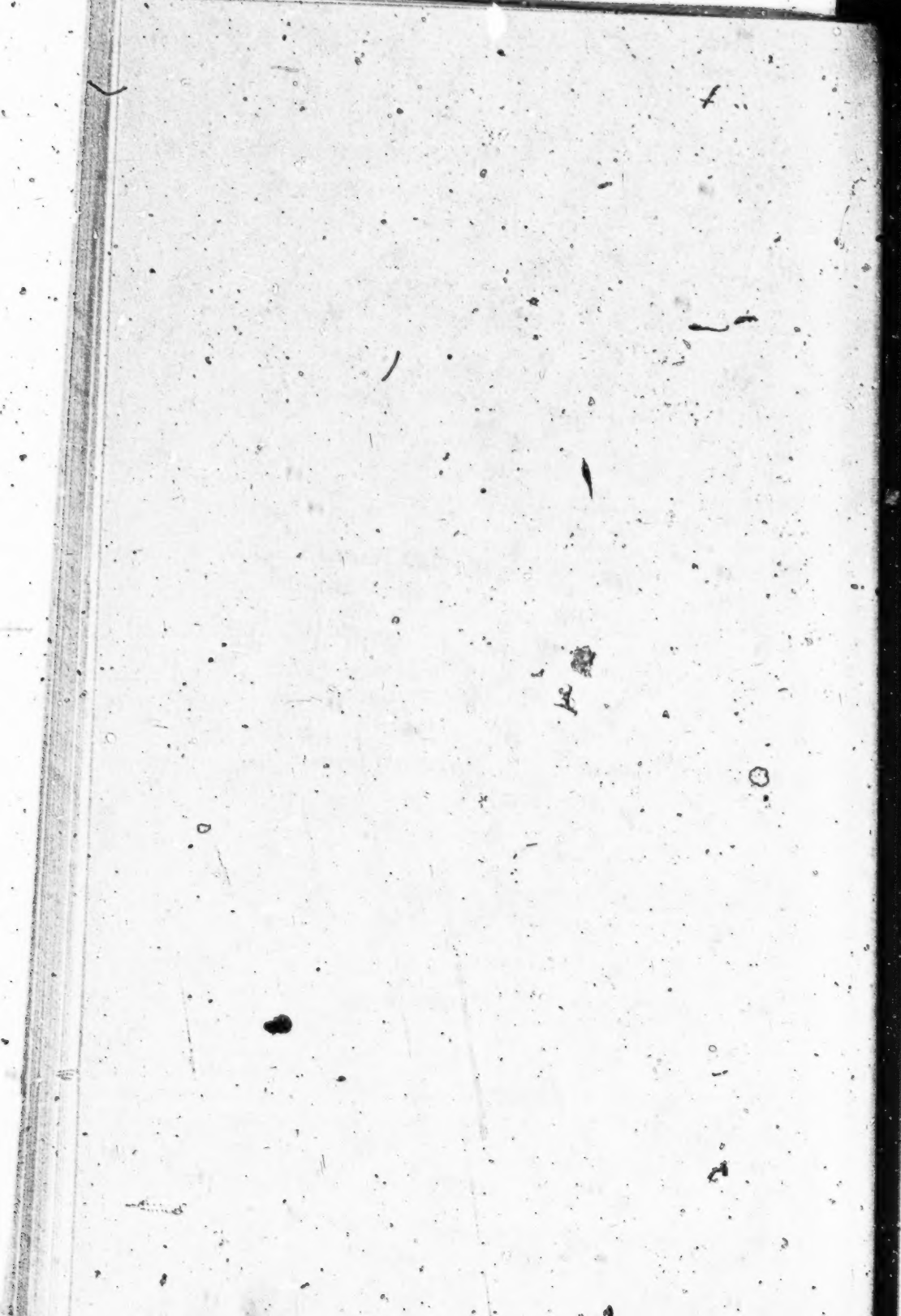
**WRIT OF HABEAS CORPUS TO THE CIRCUIT COURT OF APPEALS  
FOR THE SEVENTH CIRCUIT.**

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**BRIEF OF PETITIONER**

---

**GEORGE A. CARPENTER,**  
**GEORGE I. HAIGHT,**  
**MOSES LEVITAN,**  
*Counsel for Petitioner.*



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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1938.

**No. 51**

**ARMSTRONG PAINT AND VARNISH WORKS,**  
*Petitioner,*

*vs.*

**NU-ENAMEL CORPORATION, an Illinois corporation,**  
**and**

**NU-ENAMEL CORPORATION, a Delaware corporation,**  
**Intervener,**

*Respondents.*

WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS  
FOR THE SEVENTH CIRCUIT.

**BRIEF OF PETITIONER\***

**OPINIONS BELOW.**

The District Court did not render a written opinion, but its findings of fact and conclusions of law appear at pages 108 and 109 of the record, and the decree of the District Court appears on page 115 of the record. The opinion of

\* Petitioner is sometimes referred to herein as defendant, and Respondent, "Nu-Enamel Corporation," the Illinois corporation, as plaintiff.

the Circuit Court of Appeals for the Seventh Circuit (R. 134) is reported in 95 Fed. (2d) 448. The first opinion of the Circuit Court of Appeals for the Seventh Circuit is reported in 81 Fed. (2d) 1.

### JURISDICTION.

1. The judgment was rendered in a suit in equity brought under the Trade-Mark Statutes of the United States to determine the issues of the validity and infringement of a Trade-Mark issued under Section 15 U. S. C. A. 121.

2. The Statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, as amended by the act of February 13, 1925; U. S. C. Title 28, Section 347 (a). Petition for certiorari was granted by this Court on October 10, 1938.

### STATEMENT OF THE CASE.

The present suit was brought in the District Court of the United States for the Northern District of Illinois, Eastern Division, by Nu-Enamel Corporation, an Illinois corporation, against Armstrong Paint & Varnish Works, an Illinois corporation. The bill of complaint was filed on January 9, 1935. On January 11, 1937, the intervener, Nu-Enamel Corporation, a Delaware corporation, was granted leave to intervene (R. 25). The Bill of Complaint stated at the outset (R. 2), "This is a suit arising under the trade-mark laws of the United States," and charged infringement by defendant\* of the plaintiff's alleged trade-mark "Nu-Enamel," registered under the 1920 Trade-Mark Act.

\* The Bill of Complaint charged infringement by defendant's use on paints and varnishes of the mark "Nu-Beauty Enamel," although as hereinafter set forth, defendant's mark was "Nu-Beauty," the word "Enamel" having never appeared on any product save the product commonly known as enamel.

The Bill of Complaint did not allege unfair competition, or did it pray for relief against unfair competition.

The District Court held that "Nu-Enamel" is not a valid trade-mark either at common law or under the Trade-Mark Laws of the United States, based upon the following findings of fact by the court (R. 108):

1. Plaintiff and defendant at the time of the filing of the bill of complaint herein were and are now both citizens of the State of Illinois. The intervener, Nu-Enamel Corporation, is a corporation of the State of Delaware.

2. "Nu" in "Nu-Enamel", appearing on plaintiff's label is a phonetic spelling or misspelling of the English word "new" and means "new".

3. "Enamel" is a common English word describing a paint which flows out to a smooth coat when applied and which usually dries with a glossy appearance, and has long been known as such in the paint industry and to the public in general.

4. "Nu-Enamel" used in connection with paint or enamel sold by plaintiff means "new enamel" and is a common and generic term descriptive of the product to which it is applied and of its new or recent origin.

5. "Nu" was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of "new" to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name "Nu-Enamel".

The District Court stated the following conclusions of law:

1. "Nu-Enamel" is not a valid trade-mark, either at common law or under the Trade-Mark Laws of the United States, namely, Trade-Mark Act of March 19, 1920, and Trade-Mark Act of February 20, 1905.

4

2. This Court has jurisdiction to determine the validity of "Nu-Enamel" as a trade-mark under the Trade-Mark Laws of the United States, and having found that "Nu-Enamel" is invalid as a trade-mark, this court has no jurisdiction of the issue of unfair competition or other issues in this case.

Respondents appealed to the Circuit Court of Appeals for the Seventh Circuit which reversed the District Court and held "Nu-Enamel" to be a valid trade-mark.

For further clarification, we call the court's attention to the following proceedings in this matter, which were had before the hearing of this cause on evidence.

The District Court had previously (before answer was filed) dismissed the Bill of Complaint on motion of defendant because of facts appearing on the face of the bill and the exhibits attached thereto (R. 2-11). On appeal, the Circuit Court of Appeals for the Seventh Circuit (81 Fed. (2d) 1) reversed on the following grounds:

"Determination of the question (i. e. the validity of 'Nu-Enamel' as a trade-mark) turns largely upon the use of the word 'Nu' . . . . The Court is not justified in assuming, without evidence, that 'Nu' is phonetic spelling of new." (81 Fed. (2d) 1, at page 2.)—(Part in parenthesis ours.)

Defendant then filed its answer (R. 13) and after the hearing which was directed by the Circuit Court of Appeals, the District Court made the findings of fact hereinabove set forth, and again dismissed the bill. Said findings of fact are based on evidence which not only was uncontradicted, but was largely corroborated and furnished by the testimony of plaintiff's witnesses and records of the plaintiff (R. 36; Defendant's Exhibits 60 to 74-B, 86-A to 90-D; R. 101-102, 33, 32, 87).

On appeal from the decree of the District Court, dismissing the bill after hearing, the Circuit Court of Ap-



als, disregarding its first opinion and the directions given therein to the District Court, and absolutely disregarding the uncontradicted findings of fact of the District Court, reversed the District Court and held that "Nu-Enamel" was a valid trade-mark, and that "the conclusion of the District Court that it had no jurisdiction of the issue as to fair competition also was erroneous." (R. 137.)

Thus, this case has been before four courts, twice before the District Court and twice before the Court of Appeals. Twice the District Court decided against the plaintiff. On the first appeal, the Circuit Court of Appeals, in effect, decided that if "Nu" in "Nu-Enamel" meant "new" (as the District Court later found), "Nu-Enamel" was not a valid trade-mark. On the second appeal, the Circuit Court of Appeals found "Nu-Enamel" to be a valid trade-mark in spite of the findings by the District Court that "Nu-Enamel" was descriptive of the product.

Plaintiff's alleged trade-mark (R. 9) covers mixed paints, varnishes, paint enamels, and other kindred products. Plaintiff's application for this trade-mark under the 1905 Trade-Mark Act was refused because the words "Nu-Enamel" were descriptive of the product. Such refusal was acquiesced in by the plaintiff, which then registered the mark under the 1920 Trade-Mark Act (R. 32, Plf.'s Ex. 1).

Petitioner's mark was "Nu-Beauty" or "Armstrong New Beauty" and its products were designated with the words underneath the mark, as follows (R. 41, 72; Defendant's Exhibits 80-85, inc.):

NU-BEAUTY  
PAINT

or

ARMSTRONG  
NEW BEAUTY  
PAINT

NU-BEAUTY  
VARNISH

or

ARMSTRONG  
NEW BEAUTY  
VARNISH

NU-BEAUTY  
FURNITURE CREAM

OR

ARMSTRONG  
NEW BEAUTY  
FURNITURE CREAM

NU-BEAUTY  
ENAMEL

OR

ARMSTRONG  
NEW BEAUTY  
ENAMEL

The record further discloses, without contradiction, that the defendant never used the word "enamel" with its mark "Nu-Beauty" or "Armstrong New Beauty" on any product save the product commonly and generally known as enamel. (R. 41, 72. Def.'s Exs. 80-85 inc.) Plaintiff sells its enamel under its mark "Nu-Enamel" without further or other designation of the product as enamel (R. 7).

Petitioner's business was established in 1854 and has been continuously carried on since that time (R. 71). Its annual sales amount to about four million dollars.

The Nu-Enamel Corporation of Delaware, the intervenor in this cause, was organized in March, 1935 (R. 26) and was not in existence on January 9, 1935, at the time of the filing of the bill of complaint by the Illinois corporation.

### SPECIFICATIONS OF ERRORS.

The Circuit Court of Appeals for the Seventh Circuit erred,

1. In disregarding the uncontradicted fact that enamel is the only product on which defendant used the word "enamel" and that enamel is the only product in issue herein.
2. In reversing the decree of the District Court and in holding that "Nu-Enamel" is a valid trade-mark for paints, enamels, etc.

3. In failing to hold that "Nu-Enamel" is invalid as a trade-mark for paints and allied products because it is descriptive of the product.

4. In failing to hold that "Nu-Enamel" is invalid as a trade-mark for the product known as *enamel*, because it is descriptive of enamel.

5. In reversing the positive the finding of fact of the District Court based on uncontradicted evidence that "Nu-Enamel", used in connection with paint or enamel, means "new enamel", and is a common and generic term descriptive of the product to which it is applied.

6. In disregarding entirely the findings of fact of the District Court based on uncontradicted evidence that "nu" was commonly used in the paint and other industries as a phonetic spelling of "new" to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name "Nu-Enamel".

7. In considering the issue of unfair competition and other matters not raised by the pleadings, and over which the court had no jurisdiction.

### SUMMARY OF ARGUMENT.

1. The Circuit Court of Appeals, in its opinion, has overlooked and disregarded entirely the findings of fact by the District Court, upon which it based its conclusions of law. Such findings of fact were binding on the Circuit Court of Appeals and unassailable, and the Circuit Court of Appeals was without authority to make its own findings.

*Adamson v. Gilliland*, 242 U. S. 350, 353.

*McGaughan v. Real Estate Land, etc.*, 297 U. S. 606, 608.

*In re: Country Club Bldg. Corp.*, 91 F. (2d) 712, 715.

2. The decision of the Circuit Court of Appeals that "Enamel" is a valid trade-mark is contrary to the trade-mark laws of the United States, under which this was brought, and in conflict with applicable decisions of this court and of other Circuit Courts of Appeals.

A. Descriptive words are not valid as trade-marks under the trade-mark laws of the United States.

Trade-Mark Act, (Section 85, Par. (b), 15 U. S. C. A.).

Trade-Mark Act, (Section 121, 15 U. S. C. A.).

*In re: Chas R. Long, Jr., Co.* (C. A. D. C.), 280 F. 975, 976.

*Standard Paint v. Trinidad*, 220 U. S. 446.

*Canal v. Clark*, 13 Wall. 311.

*Elgin Watch v. Illinois Watch*, 179 U. S. 665, 673.

*Richmond Remedies v. Dr. Miles Medical Co.*, 16 F. (2) 598, 601.

*Kellogg Co. v. National Biscuit*, 71 F. (2d) 662, 666.

Rogers on "Good Will, Trade-Marks and Unfair Tradings," (1914 Ed. reprinted 1919) 76.

*Charles Broadway Rouss, Inc. v. Winchester Co.* 300 F. 706, 712.

- B. That a descriptive word or term has acquired a secondary meaning does not render it capable of being appropriated as a valid trade-mark under the trade-mark laws of the United States.

*Elgin Watch v. Illinois Watch*, 179 U. S. 665, 677.

*Kay & Ess Co. v. Commissioner of Patents*, (C. A. D. C.) 92 F. (2d) 552, 554.

*In re: Canada Dry Gingerale, Inc.* (C. C. P. A.),  
86 Fed. (2d) 830, 832, 833.

*Speaker v. Shaler*, (C. C. A. 7) 86 F. 985, 987.

*Barber v. Overhead Door Corporation*, (C. C. P.  
A.) 65 F. (2d) 147.

*Richmond Remedies v. Dr. Miles Medical*, (C. C.  
A. 8) 16 F. (2d) 598.

*Barton v. Rex-Oil Co.*, (C. C. A. 3) 2 F. (2d) 402,  
404.

*Hercules Powder v. Newton* (C. C. A. 2) 266 F.  
169.

*Vacuum Oil v. Climax Refining* (C. C. A. 6) 120  
F. 254.

That "Nu-Enamel" may have acquired a secondary meaning does not prevent others from using such words in their primary descriptive sense as "Nu-Beauty" was used by the defendant in connection with the product known as enamel.

*Warner & Co. v. Lilly & Co.*, 265 U. S. 526, 528.

*Pepsi-Cola v. Krause Bottling Co.* (C. C. A. 4) 92  
F. (2d) 272, 274.

*Hygrade, etc. v. W. H. D. Lee, etc.* (C. C. A. 10)  
46 F. (2d) 771, 772.

*Barton v. Rex-Oil Co.*, (C. C. A. 3) 2 F. (2d) 402.

*Richmond Remedies v. Dr. Miles Medical Co.* (C.  
C. A. 8) 16 F. (2d) 598.

*Fawcett Publications v. Popular Mechanics* (C.  
C. A. 3) 80 F. (2d) 194, 197.

*Standard Paint v. Trinidad*, 220 U. S. 446, 462.

*O'Cedar Corporation v. F. W. Woolworth, etc.*,  
66 F. (2d) 363, 366.



4. The Circuit Court of Appeals in its opinion has overlooked and disregarded entirely the finding of fact by the District Court that "Nu" was commonly used in the paint industry as a misspelling of "New" before plaintiff and its predecessors adopted the name "Nu-Enamel," and that enamel was an old and well known product. "Nu" and "Enamel" are, therefore, incapable of being appropriated as a trade-mark.

*Columbia Milling v. Alcorn*, 150 U. S. 460.

*Hanover Milling v. Metcalf*, 240 U. S. 403, 415.

Rogers on "Good-Will, Trade-Marks and Unfair Trading" (1914 Ed., reprinted 1919), page 83.

5. There was no issue of unfair competition and the District Court had no jurisdiction over the issue of unfair competition.

- A. The Bill of Complaint contains no allegations of facts constituting unfair competition, nor does it pray for relief against unfair competition.

*Garrett v. Louisville & Nashville R. R. Co.*, 235 U. S. 308, 313.

*Crocket v. Lee*, 7 Wheat. 522, 527.

- B. There was no diversity of citizenship, and, therefore, no Federal question.

*Nu-Enamel v. Armstrong*, 81 Fed. (2d) 1, 3, 2.

*Atkins v. Gordan*, 86 F. (2d) 595.

*Leschen Rope Co. v. Broderick Co.*, 201 U. S. 166, 172.

*Hurn v. Oursler*, 289 U. S. 238, 248.

*Standard Paint v. Trinidad*, 220 U. S. 446.

*Elgin Watch v. Illinois Watch*, 179 U. S. 665, 677.

*Van Camp Sea Food Co., Inc. v. Cohn-Hopkins, etc.*, 56 F. (2d) 797, 799.

*Sanders v. Paul*, 74 F. (2d) 399, 405.

6. "Nu-Enamel" is not infringed by "Nu-Beauty," or "New Beauty" as used by Petitioner in connection with and on the product known as enamel.

*Elliott Varnish Co., v. Sears, Roebuck Co.* (C. C.

A. 7) 232 F. 588, 591.

*Richmond Remedies v. Dr. Miles Medical Co.*, 16

F. (2d) 598, 603.

## ARGUMENT.

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1. The Circuit Court of Appeals, in its opinion, has overlooked and disregarded entirely the findings of fact by the District Court, upon which it based its conclusions of law. Such findings of fact were binding on the Circuit Court of Appeals and unassailable, and the Circuit Court of Appeals was without authority to make its own findings.

A startling feature of the decision of the Circuit Court of Appeals is that no conflict of testimony in the District Court occurred upon which any reversal of fact could possibly be predicated, and that the Court of Appeals, in its opinion, has failed entirely to give cognizance to the findings of fact by the District Court (R. 109) that "Nu" was commonly used in the paint industry prior to the adoption by plaintiff of its trade-mark "Nu-Enamel" and that the word "enamel" describes a paint, and has failed as well to give cognizance to the other findings of fact by the District Court, above set forth (p. 3).

The above findings of fact by the District Court are based on overwhelming evidence, uncontradicted (R. 96-99, 76, 77) (Def's. Ex. 39). The record discloses the common use of "Nu" in the paint industry long before plaintiff adopted the mark "Nu-Enamel". The word "enamel" is notoriously as old as the paint industry itself. These findings of fact by the District Court are under the principles laid down by this court in *Adamson v. Gilliland*, 242 U. S. 350, 353, and *McGaughn v. Real Estate Land, Title and Trust Co.*, 297 U. S. 606, 608, unassailable, and conclusive on the Circuit Court of Appeals.

In the *Adamson* case this court said, page 13:

"The case is preeminently one for the application of the practical rule that so far as the finding of the Master or Judge who saw the witnesses 'depends upon conflicting testimony or upon the credibility of witnesses, or so far as there is any testimony consistent with the finding, it must be treated as unassailable.' *Davis v. Schwartz*, 155 U. S. 631, 636."

This principle was recognized by the Circuit Court of Appeals for the Seventh Circuit in the case of *In re Country Club Building Corporation*, 91 F. (2d) 713, where the court said (p. 715):

"It is not the province of this court to weigh the evidence or analyze the same except to the extent of ascertaining if the ultimate fact found by the trial court is supported by any evidence. The rule is succinctly stated in *McGaughn v. Real Estate Land Title & Trust Co.*, 297 U. S. 606, on page 608:

"The ultimate question for the decision of the trial court was one of fact and its general verdict was conclusive. The Circuit Court of Appeals was without authority to weigh the evidence and to make its own findings."

2. The decision of the Circuit Court of Appeals that "Nu-Enamel" is a valid trade-mark is contrary to the trade-mark laws of the United States, under which this suit was brought, and in conflict with applicable decisions of this court and of other Circuit Courts of Appeals.

**A. Descriptive words are not valid as trade-marks under the trade-mark laws of the United States.**

We are not concerned in this case with any product either of plaintiff or defendant other than the product commonly known as enamel. *Enamel is the only product in issue.* (R. 41, 72.)

The question in this case is whether "Nu-Enamel", which the District Court found from uncontradicted evidence to mean "new enamel" and, therefore, descriptive of the product known as enamel, can be the subject of a valid trade-mark under the Trade-Mark Laws of the United States.

The first section of the Trade-Mark Act of March 19, 1920 (Section 121, Chapter 3, Title 15, Code of Laws of the United States of America) (15 U. S. C. A. 121), under which "Nu-Enamel" was registered, provides:

"The Commissioner of Patents shall keep a register of . . . (b) all other marks not registerable under the preceding subdivision of this chapter, except those specified in Paragraphs (a) and (b) of Section 85 of this chapter."

Paragraph (b) of Section 85, (15 U. S. C. A. Sec. 85), provides that:

"No mark which consists . . . merely in words or devices which are descriptive of the goods with which they are used . . . shall be registered."

The Circuit Court of Appeals in its opinion, however, overlooked and disregarded the fact that the only product involved in this case is enamel. In discussing the ques-

\* In *re Ohas. R. Long, Jr., Co.*, 280 Fed. 975 (C. A. D. C.) involving the word "Stabrite" as applied to a polish for locomotives, the court said in passing upon the interpretation of said Act (976):

"In his reply brief and in his argument at bar, however, appellant has contended that his rights are enlarged by the Act of March 19, 1920 (41 Stat. 533), 'to give effect to certain provisions of the convention for the protection of trade-marks and commercial names, made or signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910.' But paragraph 'b' of section 1 of that act, particularly relied upon by appellant, excepts from its operation marks specified in Paragraphs 'a' and 'b' of section 5 of the Trade-Mark Act of February 20, 1905 (33 Stat. 724 (Comp. St. No. 9490)). Under paragraph (b) of the Trade-Mark Act, a mark consisting 'merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods,' may not be registered. The act of 1920, therefore does not change the status of appellant here."



tion as to whether or not "Nu-Enamel" is descriptive, the court refers to products other than enamel, entirely ignoring enamel, the only product in issue.

Said the Circuit Court of Appeals in its opinion (R. 135):

"It is contended by defendant that the mark 'Nu-Enamel' cannot be the subject matter of a valid trade-mark for the reason that it is descriptive in character, and the District Court so found. We cannot agree. The word 'Nu-Enamel' as applied to paints, paint brushes, solder, wax and similar products is in no wise descriptive of the subject matter or of the possibility of results of use of the products."

In respect to the question of descriptiveness of the plaintiff's mark "Nu-Enamel," it may be a good trade-mark for brushes, wood powder, wax, varnish remover, solder and tack rags, but "Nu-Enamel" is descriptive of *new enamel*, whether "new" be spelled "nu" or "new". "*New Tack Rags*" might be non-descriptive and a good trade-mark for new enamel, but it would be descriptive of *new tack rags* and invalid as a trade-mark for such *rags*. The conclusion of the Circuit Court of Appeals that the words "Nu-Enamel" are not descriptive of many articles (listed above) other than enamel, upon which Respondent uses them is not a sound basis for the further conclusion that therefore Nu-Enamel does not describe *new enamel*.

The District Court, however, basing its conclusion on the findings of fact, hereinabove set out (page 3), that "Nu-Enamel" was descriptive of the product, properly concluded that it was invalid as a trade-mark, both under the Trade Mark Laws of the United States and under the common law.

That words like Nu-Enamel, descriptive of the product with which they are used, even when misspelled, are not the subject of a valid trade-mark, either at common law or under the Trade-Mark Laws of the United States, is so fundamental that it scarcely requires the citation of authorities.\* We refer to the oft cited and quoted cases, *Standard Paint Co. v. Trinidad Asphalt Co.*, 220 U. S. 446, involving the misspelled word "Rubberoid"; *Canal Co. v. Clark*, 13 Wall., 311; *Elgin Watch Co. v. Illinois Watch Co.*, 179 U. S. 665. In the latter case, this court said (673):

"... \* \* it follows that no sign or form of words can be appropriated as a valid trade-mark which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose."

In *Richmond Remedies Co. v. Dr. Miles Medical Co.*, 16 Fed. (2d) 598 (C. C. A. 8), the court said (601):

"The word 'Nervine' is a descriptive word, meaning a nerve tonic, or a remedy for disorders of the nerves. The court will take judicial notice that it has been in use for more than a century and a half. It is a part of the public heritage. Being a descriptive word, it cannot be appropriated as a trade-mark at common law, either alone or in combination with the word 'Samaritan'."

"Nor can it be registered under the federal statute relating to trade-marks, unless it meets the requirement of the fourth proviso of section 5(b) of

\* In his book "Good Will, Trade Marks and Unfair Trading" (1914—reprinted 1919), Mr. Edward S. Rogers says (p. 76):

"DON'T SELECT A DESCRIPTIVE NAME"

"A descriptive name is less distinctive even than a geographical or personal name. \* \* \* This would seem to be so evident that discussion of it is not necessary, but when one sees the advertising pages of magazines and the bill boards plastered with names which are descriptive or only thinly disguised descriptions with idiot attempts made to cover their descriptiveness by misspelling, it makes one feel that almost anything in foolishness is possible. Misspelling does not help at all." (The italics are ours.)

the Act of February 20, 1905 (33 Stat. 724 (Comp. St. No. 9490).)''

Descriptive words like "Nu-Enamel" are not registrable under the Trade-Mark Act of February 20, 1905, and the same prohibition against the registration of descriptive words or devices was adopted specifically by reference in the Trade-Mark Act of March 19, 1920. Therefore, the attempted registration of the trade-mark "Nu-Enamel" by the plaintiff is of no validity, and plaintiff acquired no right to said trade-mark under said act. Registration under the Trade-Mark Act of 1920 is not even *prima facie* evidence of the ownership of "Nu-Enamel" as a trade-mark. As the court said in *Kellogg Co. v. National Biscuit Co.*, 71 Fed. (2d) 662 (C. C. A. 2), (666):

"While it is true that a registered trade-mark cannot be cancelled except by direct attack in the way prescribed by the statute, trade-marks registered under the Law of 1920 (Act Congress March 19, 1920, 41 Stat. 532) (15 U. S. C. A. Par. 121 *et seq.*) as those in question were, are not thereby rendered valid. Their validity may still be questioned in any suit in which they are relied upon. That act was for the purpose of enabling persons in this country to register trade-marks so that they might obtain registration under the laws of foreign countries. As we said in *Charles Broadway Rouss v. Winchester Co.*, 300 Fed. 706, it has no effect on the domestic rights of the person whose trade-mark is registered. In short, the registration cannot in itself determine any of the issues involved in the present case."

As the court said in *Charles Broadway Rouss, Inc. v. Winchester Co.*, 300 Fed. 706 (C. C. A. 2), at page 712:

"Whatever may be the rights of the plaintiff acquired by its registration of the words 'The Winchester,' and the act of 1920, we are satisfied that it did not obtain thereby even a *prima facie* title to the words as a trade-mark or trade-name."

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- B. That a descriptive word or term has acquired a secondary meaning does not render it capable of being appropriated as a valid trade-mark under the trade-mark laws of the United States.

This question was decided in *Elgin Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, where this court in language unusually applicable and pertinent hereto, said (p. 677):

"It is to be observed, however, that the question we are considering is not whether this record makes out a case of false representation, or perfidious dealing, or unfair competition, but whether appellant had the exclusive right to use the word 'Elgin' as against all the world. Was it a lawfully registered trade mark? If the absolute right to the word as a trade mark belonged to appellant, then the Circuit Court had jurisdiction under the statute to award relief for infringement; but if it were not a lawfully registered trade mark, then the Circuit Court of Appeals correctly held that jurisdiction could not be maintained.\*

"And since while the secondary signification attributed to its use of the word might entitle appellant to relief, the fact that primarily it simply described the place of manufacture, and that appellees had the right to use it in that sense, though not the right to use it, without explanation or qualification, if such use would be an instrument of fraud, we are of opinion that the general rule applied, and that *this geographical name could not be employed as a trade mark and its exclusive use vested in appellant, and that it was not properly entitled to be registered as such.*" (Italics ours.)

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\*As the District Court herein held in its Conclusions of Law. (R. 109.)



The *Elgin Watch* case has been uniformly followed by the various Circuit Courts of Appeals.\*\*

In the recent case of *Kay & Ess Co. v. Commissioner of Patents*, 92 Fed. (2d) 552 (C. A. D. C.), it appeared that the word "Morocco" described certain type of paints, enamels, varnishes, lacquers and japans. It also appeared from the evidence that the term "Morocco" as used in the trade, identified the product made by appellant. The court said (p. 554):

"In respect of the appellants point that a descriptive word is registerable if it has acquired a secondary meaning: the law is settled that while a secondary meaning may be protected in equity against fraudulent or descriptive use, the existence of a secondary meaning is not a foundation for the registration of a descriptive word."

In *Barton v. Rex-Oil Co.*, (C. C. A. 3), 2 F. (2d) 402, the Court said (404):

"A merely descriptive name can never become such property, *Warner & Co. v. Lilly & Co.*, 265 U. S. 526, and the utmost the first user of such a name after it has acquired a secondary meaning can insist upon is that no one shall use it against him in an unfair way."

It was contended in the above case that "Dyanshine" was the subject of a valid trade-mark, but the Court held otherwise, and said (404):

"The word 'Dyanshine' is merely descriptive of the characteristics of the product, and therefore this

\*\*In *re Canada Dry Gingerale, Inc.* (C. C. P. A.) 86 Fed. (2d) 830, in which the *Elgin* case and other cases covering this question are reviewed at length; *Kay & Ess Co. v. Com* (C. A. D. C.) 92 Fed. (2d) 552; *Speaker v. Shaler*, (C. C. A. 7) 86 Fed. (2d) 985; *Barber v. Overhead Door Corporation* (C. C. P. A.) 65 Fed. (2d) 147; *Richmond Remedies v. Dr. Miles Medical* (C. C. A. 8) 16 Fed. (2d) 598; *Barton v. Rex Oil Co.* (C. C. A. 3) 2 Fed. (2d) 402; *Hercules Powder v. Newton* (C. C. A. 2) 266 Fed. 169; *Vacuum Oil v. Cumar Refining* (C. C. A. 6) 120 Fed. 254.

word, a collection of several words misspelled, is not a subject-matter of a valid trade-mark. We are in accord with the finding of the learned trial court that the registration is invalid."

In *In re Canada Dry Gingerale, Inc.* (C. C. P. A.) 86 F. (2) 830, it was contended that "Canada Dry," even though it was a geographic and descriptive term, having acquired a secondary meaning, was the subject of a valid trade-mark. The Court, however, held otherwise, and (quoting from its opinion in *Barber v. Overhead Door Corporation*, 65 F. (2d) 147) said (832):

"The decision of the Supreme Court of the United States in the case of *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, is unusually pertinent to the facts at bar and the contentions of appellee. The court there held that words which were merely descriptive of the place where the articles were manufactured could not be monopolized as a trade-mark, and that the word 'Elgin' was such a term, and that, if it had acquired a secondary meaning in connection with its use, protection from imposition and fraud would be afforded by the courts, but that, *notwithstanding this fact, its descriptive or geographic character rendered it unregistrable as a trade-mark.*" (Italics ours.)

And also (quoting from *Hercules Powder Co. v. Newton*, (C. C. A.) 266 F. 169), said (833):

"It is not possible under the present act for a citizen to choose as his trade-mark something invalid by general law, use it without opposition long enough to make a showing of trade repute and commercial success, derive from that success 'secondary meaning' for his mark, and then apply for registration."

With reference to the "Canada Dry" label in question, the Court said (833):

"Inasmuch as the Supreme Court of the United States has directly held that a geographical term which

was descriptive of the place where the articles were manufactured was not registerable even though it had acquired a secondary meaning, we must follow our decision in the *Overhead Door Case*, *supra*, which is in harmony with the views of the Supreme Court."

In *Speaker v. Shaler*, (C. C. A. 7) 86 F. (2d) 985, Judge Lindley said with reference to the doctrine of secondary meaning as applied to the mark "Hot Patches," (987):

"The relief, however, is not granted under the rules applicable to infringement of a trade-mark."

The Circuit Court of Appeals, however, in this case, contrary to the above decisions of this Court and of other Circuit Courts of Appeals (including the Circuit Court of Appeals for the Seventh Circuit in the case of *Speaker v. Shaler*, 86 Fed. (2d) 985, 987), has held that because "Nu-Enamel" had acquired a secondary meaning it thereby attained validity as a trade-mark, even though descriptive of the products to which it is applied. The admission by defendant in Paragraph 2 of its answer (R. 13) and referred to in the opinion of the court below (R. 134), is an admission only that "Nu-Enamel" had acquired a secondary meaning as a trade name. Such an admission did not and can not give it validity as a *statutory trade-mark*. Under the prohibitions of the Trade-Mark Laws of the United States, and under the applicable decisions of this and other Federal Courts, it is incapable of being a valid trade-mark.

3. That "Nu-Enamel" may have acquired a secondary meaning does not prevent others from using such words in their primary descriptive sense as "Nu-Beauty" was used by the defendant in connection with the product known as enamel.

As heretofore pointed out the only product on which defendant ever used the word "enamel" in connection

with its mark "Nu-Beauty" or "Armstrong New Beauty" was the product known as *enamel*. On no other product did defendant use the word "enamel" in connection with its mark "Nu-Beauty" (or "Armstrong New Beauty"). The language of this court in *Warner & Co. v. Lilly & Co.*, 265 U. S. 526, 528, is pertinent:

"We agree with the courts below that the charge of infringement was not sustained. The name *Coco-Quinine* is descriptive of the ingredients which enter into the preparation. The same is equally true of the name *Quin-Coco*. A name which is merely descriptive of the ingredients, qualities or characteristics of an article of trade cannot be appropriated as a trade mark and the exclusive use of it afforded legal protection. The use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product."

The principle emphasized in the *Warner* case has been reiterated in numerous cases by various Circuit Courts of Appeal.\*

In *Pepsi-Cola Co. v. Krause Bottling Co.*, (C. C. A. 4) 92 Fed. 2nd, 272, at page 274, the Court quoting from *Bliss v. Arleen*, (C. C. A. 4) 25 Fed. 2nd, 370, at 372 said:

"It is settled beyond all controversy that a manufacturer has no right to the exclusive use of a descriptive word in connection with his goods, and if nevertheless he adopts such a trade-mark, he himself is largely to blame for the confusion which ensues when other manufacturers, with equal right, adopt similar terms to describe their products."

\**Hygrade, etc. v. H. D. Lee, etc.*, (C. C. A. 10) 46 F. (2d) 771, 772; *Barton v. Rex-Oil Co.*, (C. C. A. 3) 2 F. (2d) 402; *Richmond Remedies v. Dr. Miles Medical Co.*, (C. C. A. 8) 16 F. (2d) 598; *Fawcett Publications v. Popular Mechanics*, (C. C. A. 3) 80 F. (2d) 194; *Pepsi-Cola Co. v. Krause Bottling Co.*, (C. C. A. 4) 92 F. (2d) 272, 274.

In *Fawcett Publications v. Popular Mechanics*, (C. C. 3) 80 F. (2d) 194, the Court said (197):

"It is easy to forget that it is not competition but unfair competition which entitles the user of a descriptive word with an acquired secondary meaning, to relief. Such a word belongs to the public in its primary sense."

The Circuit Court of Appeals for the Seventh Circuit *O'Cedar Corporation v. F. W. Woolworth, etc.*, 66 F. (2d) 363 (C. C. A. 7), said even of a validly registered trade-mark "O'Cedar" (366):

"A recognition of the validity of the trade-marks does not give appellant a monopoly of the word 'Cedar'." . . .

(P. 367):

"That appellant acquired no exclusive right to use the words 'cedar' or 'cedar oil' as applied to polish must be readily conceded."

It is submitted that to deny to this Petitioner, a company in existence since 1854, (B. 71) the right to sell its enamel *enamel*, stretches trade-mark law beyond its elastic limits. Yet this is the result of the Court's opinion, for the defendant is permitted to sell Nu- (or Armstrong New) beauty varnish, paint, and furniture polish, but not enamel. The Circuit Court of Appeals in effect has held that on every species of the class, except enamel, there is no infringement. In other words, the use of the name of the species, *enamel*, in its primary and descriptive sense on *enamel* only,—the only name by which the species known in the industry,—spells infringement.

This Court in affirming the opinion of the Circuit Court of Appeals said in *Standard Paint Co. v. Trinidad Asphalt*, 220 U. S. 446, 462:



"The only imitation by the Asphalt Company of the roofing of the Paint Company is that which exists in the use of the word 'rubbero', and this only by its asserted resemblance to the word 'ruberoid'. To preclude its use because of such resemblance would be to give to the word 'ruberoid' the full effect of a trade-mark, while denying its validity as such."

4. The Circuit Court of Appeals in its opinion has overlooked and disregarded entirely the finding of fact by the District Court that "Nu" was commonly used in the paint industry as a misspelling of "New" before plaintiff and its predecessors adopted the name "Nu-Enamel," and that enamel was an old and well known product. "Nu" and "Enamel" are, therefore, incapable of being appropriated as a trade-mark.

The District Court made the following finding of facts (R. 109):

"5. 'Nu' was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of 'new' to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name 'Nu-Enamel'."

As heretofore pointed out, the above finding of facts by the District Court is based on overwhelming evidence, uncontradicted (R. 96-99, 76, 77) (Def.'s. Ex. 39). The record discloses the common use of "Nu" in the paint industry long before plaintiff adopted the mark "Nu-Enamel" (R. 96-98, Def.'s. Ex. 101-128, R. 76-77, R. 17, Def.'s. Ex. 39). The word "enamel" is notoriously as old as the paint industry itself.

"Nu" and "enamel," therefore, having been used for many years in the paint industry in connection with

paint and enamels, are incapable of being appropriated and monopolized as a trade-mark. This court so held in *Columbia Mill v. Alcorn*, 150 U. S. 460, and *Hanover Milling Co. v. Metcalf*, 240 U. S. 403, at page 415, where the Court said:

"Of course, if the symbol or device is already in general use, employed in such a manner that its adoption as an index of source or origin would only produce confusion and mislead the public, it is not susceptible of adoption as a trade-mark. Such a case was *Columbia Mill Co. v. Alcorn*, 150 U. S. 460, 464, affirming 40 Fed. Rep. 676, where it appeared that before complainant's adoption of the disputed word as a brand for its flour the same word was used for the like purpose by numerous mills in different parts of the country."

It is a rule recognized by Rogers, in his book "Good Will, Trade-Marks and Unfair Trading," (1914, reprinted 1919), at page 83.\*

How extensive was the use of "Nu" in the paint industry as a misspelling of "New" may be conveniently noted from examples taken from the record and set forth in Appendix A to this brief.

**There was no issue of unfair competition and the District Court had no jurisdiction over the issue of unfair competition.**

**A. The Bill of Complaint contains no allegations of facts constituting unfair competition, nor does it pray for relief against unfair competition.**

The issue of unfair competition is not involved herein, and the District Court properly refused to assume juris-

\*"The courts do not protect a trader in the use of things which are common to the trade, because being common to the trade, they cannot indicate commercial origin with any one producer."

diction of the issue of unfair competition for the reason that the Bill of Complaint herein does not raise the issue of unfair competition nor does it allege facts from which unfair competition can reasonably be inferred.

The bill of complaint states as a preface (R. 2): "This is a suit arising under the trade-mark laws of the United States." The only charge in the Bill of Complaint (R. 2 to 5) is that the use by defendant of "Nu-Beauty Enamel" constitutes an infringement of plaintiff's registered trade-mark "Nu-Enamel." *No other act or acts whatsoever are charged or alleged.* Proof of any other acts was clearly incompetent, *and proof, if any, of any other facts or acts could not be the basis for a finding or decree.* Nowhere in the Bill of Complaint is there any allegation or charge of unfair competition or any words which might be construed as allegations of unfair competition by the defendant.

The prayer in the Bill of Complaint merely asks that defendant be enjoined from "*infringing plaintiff's registered trade-mark.*"

The District Court, having found that "Nu-Enamel" is not a valid trade-mark either at common law or under the trade-mark laws of the United States, rightfully concluded as a matter of law that it had no jurisdiction of the issue of unfair competition or other issues in this case, not alleged or set out in the Bill of Complaint.

Plaintiff's case must stand or fall on the issues made by the pleading, and not having charged in its Bill of Complaint any acts of unfair competition, but having limited its Complaint solely to the allegation of an infringement by defendant's label of an alleged trade-mark which the Court found to be invalid, there was nothing left before the Court on any issues outside of the allegations in the Bill of Complaint.

In *Garrett, Administrator of Lewis v. Louisville & Nashville Railroad Company*, 235 U. S. 308, this Court said (313):

"Although the same precision of statement is not required as in pleadings at law, nevertheless it is held to be absolutely necessary that in bills of equity such a convenient degree of certainty should be adopted as may serve to give the defendant full information of the case which he is called upon to answer. Every bill must contain in itself sufficient matters of fact, *per se*, to maintain the plaintiff's case; and if the proofs go to matters not set up therein, the court cannot judicially act upon them as a ground for decision, for the pleadings do not put them in contestation. *Harrison v. Nixon*, 9 Pet. 483, 503; *Daniell's Ch. Pl. & Pr.* 368." (Italics ours.)

In *Crocket v. Lee*, 7 Wheaton, 522, Chief Justice Marshall said (527):

"If the pleadings in the cause were to give no notice to the parties or to the Court of the material facts on which the right asserted was to depend, no notice of the points to which the testimony was to be directed, and to which it was to be limited; if a new case might be made out in proof, differing from that stated in the pleadings, all will perceive the confusion and uncertainty which would attend legal proceedings, and the injustice which must frequently take place. The Rule that the decree must conform to the allegations, as well as to the proofs of the parties, is not only one which justice requires, but one which necessity imposes on courts. We cannot dispense with it in this case."

The Circuit Court of Appeals, in its opinion herein, has disregarded the above principles and rules in relation to the issue of unfair competition, *allegations as to which nowhere appear in the bill of complaint herein.*

**B. There was no diversity of citizenship, and, therefore, no Federal question.**

As we have heretofore pointed out under 5-a, the issue of unfair competition is not involved in this case. However, even if it had been raised by the Bill of Complaint, "Nu-Enamel" not being a valid trade-mark under the laws of the United States, and there being no diversity of citizenship at the time of the filing of the bill herein, the District Court had no jurisdiction over the issue of unfair competition.

When this case was before the Circuit Court of Appeals on appeal from the order dismissing the Bill of Complaint, the court (*Nu-Enamel v. Armstrong*, 81 F. (2d) 1), said (3):

"We have no doubt but that the so-called unfair competition phase of the case may be heard with the trade-mark infringement charge, *provided the trade-mark be held valid.*" (*Italics ours.*)

and (2):

"The court is not justified in assuming without evidence that 'Nu' is phonetic spelling of 'New'."

In effect, the Circuit Court of Appeals held that if "Nu" meant "New," the bill was properly dismissed in the first proceedings. This case was sent back for the purpose of taking evidence on the meaning of the word "Nu" and the evidence having clearly established that "Nu" means "New," the District Court properly held that "Nu-Enamel", is not a valid trade-mark. *Therefore, the trade-mark being invalid, and there being no diversity of citizenship at the time of the filing of the bill of complaint and no Federal question involved, the court had no jurisdiction over the non-Federal question of unfair competition, even if that issue had been raised by the pleadings.*



The question of jurisdiction in a situation such as this was again before the Circuit Court of Appeals for the Seventh Circuit in *Atkins v. Gordon*, 86 F.2d 595 (decided November 30, 1936), involving the alleged infringement of plaintiff's patent, and the court having held that the patent of plaintiff was invalid, said (Mr. Justice Evans) (597):

"We are of the opinion that the single claim of the patent is invalid for want of patentable novelty.

It is unnecessary to discuss the unfair trade method charges, for in view of the residence of the parties in the same state, the Federal court's jurisdiction is dependent upon appellee's sustaining the patent infringement charge of the complaint."

In *Leschen Rope Co. v. Broderick*, 201 U. S. 166, involving, as does this case, an invalid trade-mark, this court said (172):

"Nor can we assume jurisdiction of this case as one wherein the defendant had made use of plaintiff's device for the purpose of defrauding the plaintiff and palming off its goods upon the public as of the plaintiff's manufacture. Our jurisdiction depends solely upon the question whether plaintiff has a registered trade-mark valid under the act of Congress, and, for the reasons above given, we think it has not."

The *Leschen Rope* case was approved and followed in *Standard Paint v. Trinidad*, 220 U. S. 446. The same rule was laid down in *Elgin Watch v. Illinois Watch*, 199 U. S. 665, where this Court said (p. 677):

"but if it were not a lawfully registered trade mark, then the Circuit Court of Appeals correctly held that jurisdiction could not be maintained."

We quote in full that part of the opinion of this Court in *Hurn v. Oursler*, pertaining to the *uncopyrighted*

portion of the play in question in that case, which we submit is pertinent to the case at bar, involving as it does an invalid trade-mark (*Hura v. Oursler*, 289 U. S. 238, 248):

"Two. During the pendency of the suit petitioners amended their bill so as to make its allegations apply to the uncopyrighted version of their play, namely, that the wrongful acts of respondents were in violation of the rights of petitioners and constituted unfair business practices and unfair competition with respect to that version as well as to the original. *Since that claim did not rest upon any Federal ground and was wholly independent of the claim of copyright infringement, the district court was clearly right in dismissing it for want of jurisdiction.* The bill as amended, although badly drawn, sets forth facts alleged to be in violation of two distinct rights, namely, the right to the protection of the copyrighted play, and the right to the protection of the uncopyrighted play. From these averments two separate and distinct causes of action resulted, one arising under a law of the United States, and the other arising under general law. For reasons that have already been made manifest, the latter is entirely outside the Federal jurisdiction and subject to dismissal at any stage of the case. *It is hardly necessary to say that a Federal court is without the judicial power to entertain a cause of action not within its jurisdiction, merely because that cause of action has mistakenly been joined in the complaint with another which is within its jurisdiction.*" (Italics ours.)

In *Van Camp Sea Food Co. Inc. v. Cohn-Hopkins, etc.*, 56 F. (2d) 797 (C. C. A. 9) (petition for writ of certiorari denied, 286 U. S. 561), the Court said (799):

"In each of the cases now under consideration, the appellant not only alleges infringement of trade-mark, but also alleges unfair competition. Jurisdiction in every case but one is predicated upon in-

fringement of trade-mark, there being no diversity of citizenship, and our decision that the trade-mark is invalid precludes further consideration of the question of unfair competition for lack of jurisdiction."

The belated intervention in this case of the Nuamel Company, the Delaware corporation, organized after the filing of the bill of complaint herein, cannot in any way affect the jurisdiction of this court which is dependent upon the state of facts as they existed at the time the suit was commenced.

Equity Rule 37 of the Supreme Court of the United States, provides:

"Anyone claiming an interest in the litigation may at any time be permitted to assert his right by intervention, but the intervention shall be in subordination to, and in recognition of, the propriety of the main proceedings."

The plaintiff and defendant in the main proceedings are Illinois corporations. Clearly, if the main proceedings could not properly have been brought in the Federal court, the subsequent intervention by a citizen of another state can in no way affect the jurisdiction. As the Court held in the case of *Sanders v. Paul* (C. C. A. 10), 74 F. 399, 405:

"The test of the jurisdiction is the citizenship of the indispensable parties at the time when the suit was commenced and jurisdiction is not affected by the subsequent change of the parties."

It is clearly the law and within the intent and purview of Rule 37 which recognizes, and is merely a re-statement of the law in the effect of intervention.

6. "Nu-Enamel" is not infringed by "Nu-Beauty", or "New Beauty" as used by Petitioner in connection with and on the product known as enamel.

An examination of Exhibit C attached to the bill of complaint (R. 11) and the cans of enamel and labels of Petitioner in evidence, discloses that Petitioner's mark on cans of enamel was not "Nu-Enamel" with the word "Beauty" inserted between the words "Nu" and "Enamel" but that "*Nu-Beauty*" is a separate word in a different script and on a different line from the word "*Enamel*," and with the words "Superfine" on another line below "Nu-Beauty" and above "Enamel."

The label on Petitioner's cans of enamel is not at all confusingly similar to or an imitation of the label on Respondent's cans of enamel.

Neither "Nu-Beauty" nor "New Beauty" is similar in appearance to "Nu-Enamel."

Phonetically the two words, even in connection with the word "Enamel," are different.

The words have different meanings. "Nu-Enamel" conveys to the mind of the purchaser the idea that the product is an improved or new enamel. "Nu-Beauty" (New Beauty) conveys to the mind of the purchaser the idea that, when the enamel is applied to an article, that article will acquire a new beauty.

The words "Nu-Enamel" on Respondents' label, and the words "Nu-Beauty" or "New Beauty" on Petitioner's label are printed differently. "Nu-Enamel" on Respondents' label is in blocked letters, arched at the bottom, with a red rectangle containing three legends appearing prominently under the word "Nu-Enamel." "Nu-Beauty" on Petitioner's label is in script, is at an angle, is enclosed in an elliptical design, and the word "Enamel" appears

below the words "Nu-Beauty" with the word "Super-  
me" between the two on another line.

The name "Armstrong" and "Armstrong Paint &  
Varnish Works, Chicago" appear prominently on Peti-  
tioner's labels.

The set-up, design and color of Petitioner's label are  
entirely different from that of the label of Respondents.

The predominant colors of Respondent's label and can  
are red and yellow. The predominant color on Peti-  
tioner's label are black, white and silver.

In *Elliott Varnish Co. v. Sears Roebuck Co.*, 232 F..  
88 (C. C. A. 7), involving the words "Never Leak"  
and "Roof Leak" on roofing cement, the Court said  
(191):

"The labels are not so similar as to deceive the  
ordinary purchaser."

In *Richmond Remedies Co. v. Dr. Miles Medical Co.*,  
F. (2d) 598, the Court after analyzing the differences  
between plaintiff's and defendant's labels, said (603):

"The words of Mr. Justice Brewer in the case of  
*P. Lorillard Co. v. Peper*, *supra*, are quite apposite  
here:

"The difference is such that the eye will take it in  
at a moment's glance. Summing it all up, while  
there are certain minor points of resemblance which  
have been forcibly urged upon our attention by  
the counsel for plaintiff, yet, looking at the two  
packages with their labels, taking the tout ensemble,  
it appears to us clear that they are so essentially  
different that no one of ordinary intelligence, de-  
siring to buy the one kind of tobacco, would be  
misled into buying a package of the other. \* \* \* We  
cannot surrender our own judgment in this matter  
because others may be of a different opinion, or be-  
cause it happens in isolated instances, that some pur-



*chaser was so careless as not to detect the difference. It may well be that, where many sales were made, some individuals, not particularly attentive, may have purchased the defendant's supposing they were purchasing the plaintiff's package. Such things will happen in the ordinary course of business, no matter how great the differences; and the fact that they do happen, while it is not to be ignored, is not to outweigh the evidence which comes from a personal inspection of the packages and labels'." (Italics ours.)*

An inspection of Petitioner's and Respondents' cans and labels clearly discloses that he would have to be an extremely careless person and color-blind, who would mistake and confuse the two. We submit that Petitioner's cans of enamel bear no greater resemblance to Respondents' cans, than do other cylindrical cans of enamel of the same size which may bear on their labels the word "enamel." If there are any isolated instances of confusion, as the Court said in *Richmond Remedies Co. v. Dr. Miles Medical Co.* "such things will happen in the ordinary course of business, no matter how great the difference is."

This obvious lack of confusing similarity between the two labels manifest from an inspection of Exhibits "A" and "C" attached to the bill of complaint (R. 7 and 11) of itself furnishes justification for the District Court's original dismissal of the bill of complaint before an answer was filed herein.

## CONCLUSION.

From the foregoing it appears that the Circuit Court of Appeals for the Seventh Circuit has now rendered a decision in conflict with its own previous decision, in conflict with the findings of facts and decision of the trial court, in conflict with the controlling and applicable decisions of this court, in conflict with applicable decisions of various Circuit Courts of Appeals (including decisions of the Circuit Court of Appeals for the Seventh Circuit) in a case of great public, economic and industrial importance, and which decision has seriously prejudiced not only the rights of petitioner, but of other paint manufacturers and dealers. We respectfully submit that if "Nu-Enamel" (or, "New Enamel") is non-descriptive, and therefore, is a valid trade-mark for the product known as *enamel*, then "Auld Enamel" (or "Old Enamel") is equally non-descriptive and a valid trade-mark for the product known as *enamel*.

We therefore urge that for the reasons hereinabove set forth, the Circuit Court of Appeals for the Seventh Circuit committed error, and that, therefore, the decision of the Circuit Court of Appeals should be reversed and the decree of the District Court should be affirmed.

Respectfully submitted,

GEORGE A. CARPENTER,

GEORGE I. HAIGHT,

MOSES LEVITAN,

*Counsel for Petitioner.*

## APPENDIX A.

List of marks with "NU" used in the paint industry registered with Trade Mark Bureau of The National Paint, Varnish & Lacquer Association in its office at Washington, D. C., as testified to by Robert K. Shannon, manager of the Trade Mark Bureau (R. 96-98). (Defendant's Exhibits 101 to 128 inclusive.)

### Exhibit No.

- 101 NU-BLAC registered March 10, 1919, Atlantic Varnish Works.
- 102 NU-CARTO, registered November 10, 1919, Wheeler Varnish Co.
- 103 NUECO, registered November 1, 1930, The Foy Paint Co.
- 104 NU-Eco, registered July 10, 1922, The Foy Paint Co.
- 105 NU-FINISH, registered November 9, 1923, Utley Paint Company.
- 106 NU-FLOB, registered October 28, 1908, Hockaday Paint Company.
- 107 NU-FLOB, registered April 22, 1921, Tanner Paint & Oil Co.
- 108 NU-FLOREN, registered June 29, 1922, Tanner Paint & Oil Co.
- 109 NU-O-LAC, registered December 20, 1921, Glidden Company.
- 110 NU-KAR, registered October 18, 1931, Dean & Barry Company.
- 111 NU-KOLOR-DI, registered March 13, 1918, Peaslee-Gaulbert Co.
- 112 NU-LAC, registered September 1, 1915, Sillers Varnish Co.

- 113 NU-LAC, registered May 16, 1912, Sta-Bright Mfg. Co.
- 114 LIKE NU, registered May 16, 1912, Sta-Bright Mfg. Co.
- 114 NULIFE, registered July 11, 1922, Mutual Paint Mfg. Co.
- 115 NU-LIKE, registered March 6, 1920, Asper-Martin Company.
- 116 NU LUSTRE, registered January 18, 1913, Boston Varnish Company.
- 117 NU-LYK, registered July 23, 1918, Inland White Lead Co.
- 118 NU-NAMEL, registered November 25, 1924, Utley Paint Company.
- 119 NU RINKLE, registered August 25, 1910, R. F. Johnston & Co.
- 120 NU ROOF, registered November 19, 1919, Star Paint & Varnish Company.
- 121 NU SHINE, registered September 12, 1910, Dozier & Gay Paint Company.
- 122 NU SPIRITS, registered April 2, 1919, John Briggs & Company.
- 123 NU TURPS, registered September 26, 1907, Charles H. Moore Oil Company.
- 124 NUVAR, registered January 31, 1921, Gilbert-Spruance Co.
- 125 NUWAL, registered November 12, 1914, R. F. Johnston Paint Company.
- 126 NUBELAC, registered March 1, 1923, Nubian Paint & Varnish Company.
- 127 RE-NU, registered December 16, 1908, W. W. Lawrence & Co.
- NU-TONA, registered December 16, 1908, W. W. Lawrence & Co.

128 NUWITE, registered September 6, 1910, Benj. Moore & Co.

Mr. Milton C. Fisher, advertising manager of appellee, testified concerning the common use of "Nu" for "New" in the paint industry (R. 76-77) and that marks with "Nu" appeared on color cards and circulars advertising paints and enamels under the following names:

*Defendant's Exhibits 1 to 10 inclusive.*

**Exhibit No.**

- 1 NUWAE on paint, R. F. Johnston Paint Co.
- 2 NUSEAL, McCloskey Varnish Co.
- 3 NU-CRAFT, on Enamel, J. E. Harris Co.
- 4 NU-DA, on Flat Finish, Indianapolis Paint & Color Co.
- 5 NU KITCHEN, on Enamel.  
NU-SINK, NU-STOVE, NU-LINOLEUM, Burnett Chemical Co.
- 6 NU-DA, on Wall Finish, Indianapolis Paint & Color Co.
- 7 NU-DA, on Enamel.
- 8 RENUIT, The Modern Finish, Wadsworth-Howland Co.
- 9 NU-FUN, on Enamel, Progress Varnish Co.
- 10 NU CAR TO, on One Coat Automobile Finishes, Wheeler Varnish Works.

Mr. Sappington testified that between 1915 and 1918 he saw displayed and advertised paints, varnishes and kindred articles using the word "Nu" (R. 17), among them "Nu-Back" and "Nu-Shine."

The Trade-Mark book of the National Paint, Varnish and Lacquer Association (Def's. Ex. 39) lists, on pages 90 and 91 a large number of the trade-marks and trade-names with the word "Nu," as set forth in the bill of particulars (R. 17-22) attached to defendant's amended answer.



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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1938.

**No. 51**

ARMSTRONG PAINT AND VARNISH WORKS,  
*Petitioner,*

*vs.*

NU-ENAMEL CORPORATION, an Illinois Corporation,  
*and*

NU-ENAMEL CORPORATION, a Delaware Corporation,  
*Intervener,*  
*Respondents.*

WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS  
FOR THE SEVENTH CIRCUIT.

**REPLY BRIEF FOR PETITIONER**

GEORGE A. CARPENTER,  
GEORGE I. HAIGHT,  
MOSES LEVITAN,

*Counsel for Petitioner.*

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WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS  
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---

**REPLY BRIEF FOR PETITIONER**

---

**Errors in the Respondents' Brief.**

It is our purpose to answer in order the arguments advanced in the brief of the Respondents. It is necessary first, however, to point out errors and omissions in that brief.

It is said on pages 2 and 3, and constantly repeated



thereafter, that the mark complained of is NU-BEAUTY ENAMEL. The Petitioner's mark is NU-BEAUTY or ARMSTRONG NEW BEAUTY. The word "enamel" appears only when the product is enamel. Respondents do not deny this.

To emphasize that the Respondents' brief begins on a false premise or misleading statement, we insert herein portions of exhibits of record. The reproduction immediately below is from a can of the Petitioner's varnish. (Defendant's Exhibit H, R. 72.)



The reproduction below is from an advertisement for Petitioner's furniture cream, upon which product the mark NU-BEAUTY was first used. (Defendant's Exhibit E, R. 72.)



A can of enamel was labeled "enamel." No one can successfully complain of that.

So at the outset the question of infringement is wrongfully put by the Respondents, contrary to the testimony of Respondents' president.\*

The Trade Mark Act of March 19, 1920, involved in this case, is said by Respondents to incorporate by reference certain sections of the Trade Mark Act of February 20, 1905. These sections the Respondents purport to set forth in the appendix to their brief. The most pertinent section is omitted. It reads as follows:

"\* \* \* Provided, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this subdivision of this chapter: \* \* \*"

(Sec. 85, Par. b, 15 U. S. C. A.).

Respondents' brief (p. 2) states, "The Delaware Corporation intervened and the action proceeded with that corporation as plaintiff." That is not the fact. The

\*Mr. Lloyd, president of Respondent, who signed and swore to the bill of complaint herein which stated that (R. 3) "Defendant, Armstrong Paint & Varnish Works, within the last few months has put upon the market paints and varnishes which it sells under the designation 'Nu-Beauty Enamel'", testified (R. 41) that *he had never seen a can of paint or can of varnish manufactured and sold by the Armstrong Paint & Varnish Works or any other Company with the label 'Nu-Beauty Enamel' on it.* The only product of Petitioner in the record and in evidence herein on which the word "enamel" appeared, was the product known as enamel.

action proceeded with the Illinois corporation continuing as plaintiff and with the Delaware corporation as intervenor. (Order of January 11, 1937. (R. 25).) The Illinois corporation was still in existence when this case was tried.

Counsel for Respondents, in commenting on the testimony of their witness, W. J. Nelson\*, make the following statement (p. 26):

"It may be said in passing that none of these statements was denied. Mr. Goldsmith, Petitioner's president, Mr. Van Antwerp, its vice-president and sales manager, and Mr. Sappington, assistant sales manager, testified, and did not deny any of them."

While the testimony referred to is all incompetent, we call the Court's attention to the fact that the above statement is contradicted by the record. The statements of Nelson referred to were specifically denied by Mr. Goldsmith (R. 88 and 89), by Mr. Van Antwerp (R. 91), and by Mr. Milton C. Fisher (R. 78).

The Respondents' argument that there is no difference between trade mark infringement and unfair competition leaves the Circuit Court of Appeals without support and ignores the bill of complaint.

Nowhere in Respondents' brief is any attempt made to support the decision of the Circuit Court of Appeals herein (R. 135) (95 Fed. 2d, 448). In fact, it appears

\* In discussing all of this incompetent testimony, counsel for Respondents have *neglected* to apprise this court that the record discloses that Nelson, at his own solicitation, entered the employ of Petitioner in May, 1935, five months after the suit herein was filed, that he had just previously thereto been employed by Respondents, and that at the time he testified was employed by Respondents as sales promotion manager (R. 62, 63, 67).

from the brief that the grounds on which the Circuit Court of Appeals in its opinion based its reversal of the decree of the District Court are entirely abandoned. No contention is now made that "Nu-Enamel" is not descriptive. Instead, Respondents have embarked upon the new and novel theory that the mere registration under the Trade-Mark Act of 1920 gives validity to a mark otherwise invalid both at common law and under the Trade-Mark Law of 1905.

Respondents' argument (brief page 9) that there is no legal difference between infringement of a trade-mark and the common case of unfair competition has no application to the issues in the present case. The pleadings raise no issue of unfair competition. The bill of complaint states (R. 2), "This is a suit arising under the Trade-Mark laws of the United States". Trade-mark infringement by the asserted resemblance of Petitioner's mark to "Nu-Enamel" is the *only charge made*. It is, therefore, incumbent upon Respondents to prove both the existence of a trade-mark *valid under the Trade-Mark Laws of the United States* and that said trade-mark has been infringed by Petitioner. There is neither a valid trade-mark nor infringement of a valid trade-mark. The situation herein is the same as in *Trinidad Asphalt Co. v. Standard Paint Co.* (C. C. A. 8), 163 F. 977, where the court said (981):

"We discover nothing in defendant's conduct justifying the charge of unfair competition. In the last analysis the charge rests solely on the use of the word 'Rubbero' and similarity thereof to 'Rubroid' or its equivalent 'Rubberoid'."

So in the case at bar, to paraphrase the above language, in the last analysis, the charge rests solely on the use of

the words "Nu-Beauty" and "Enamel" and the asserted similarity thereof to "Nu-Enamel".

We quote again from the language of this court in affirming the decision of the Circuit Court of Appeals (*Standard Paint Co. v. Trinidad Asphalt Co.*, 220 U. S. 446, 461):

"The only imitation by the Asphalt Company of the roofing of the Paint Company is that which exists in the use of the word 'rubbero'; and this only by its asserted resemblance to the word 'ruberoid'. To preclude its use because of such resemblance would be to give to the word 'ruberoid' the full effect of a trade-mark, while denying its validity as such."

#### **Nu-Enamel is Not a Trade Mark**

The Respondents' brief (p. 12) teaches that the "Federal trade-mark statutes do not involve the substantive law." Yet, beginning on page 11, the argument is advanced that since NU-ENAMEL is registered under the 1920 Act, it is a good mark. Support is not found for the mark as a good trade-mark apart from the Federal statutes. Counsel confuse a trade-mark with a trade name. In our original brief (pp. 13 and 18) it was argued that NU-ENAMEL is descriptive and incapable of monopolistic appropriation. Respondents no longer contend otherwise. The cases cited on pages 11 and 12 of Respondents' brief define a valid trade-mark. Not every mark or name which indicates origin is a trade-mark. Every proprietor's name is a mark of origin, but not a trade-mark, particularly when comprised of a trite adjective and a common noun.



## **Registration Under the Act of 1920 Imparts No Validity or Presumption of Validity.**

Respondents' brief states (p. 13) that one of the purposes of the Act of 1920 was to permit registration of descriptive terms functioning as trade-marks which have been in use for one year. Further (p. 16) it is said that the "B" register provided by the Act of 1920 is analagous to the ten-year proviso of the Act of 1905.

The legislative history of the Act of 1920 is then discussed in support of these statements. The decisions of the courts as to the purposes of the Act of 1920 are ignored.

As we point out in our original brief (p. 14), the language of Section 1 of the Trade-Mark Act of 1920, and of paragraph b of Section 5 of the Trade-Mark Act of 1905, which it specifically incorporates by reference, is clear, concise, and unequivocal. Paragraph b specifically provides that

"No mark which consists \* \* \* merely in words or devices which are descriptive of the goods with which they are used, shall be registered \* \* \*"

Counsel for Respondents ignore completely the above provision, or any reference thereto. They ignore also the fact that the above provision has by judicial construction been held to apply to the Act of 1920 in *In re Chas. R. Long, Jr. Co.*, (C. A. D. C.), 280 F. 975 (cited and noted from in Petitioner's brief (p. 14), and in *Charles Broadway Rouss, Inc. v. Winchester Co.*, 300 F. 706 (C. C. A. 2) (Certiorari denied, 266 U. S. 607), cited and quoted from in Petitioner's brief (p. 17). In the latter case the court also said (713):

"The purpose of Congress in its enactment is evident, when one considers it in the light of the report

of the Senate committee on patents to which the bill was referred. That committee, in recommending the passage of it, stated in its report:

"This legislation has no effect on the domestic rights of any one. It is simply for the purpose of enabling manufacturers to register their trade-marks in this country for the purpose of complying with legislation in foreign countries, which necessitates registration in the United States as a necessary preliminary for such foreign registration. \* \* \*"

In view of the lack of ambiguity in the statute, and the judicial pronouncement of its purpose, the legislative history set forth in detail in Respondents' brief is not pertinent. Such history cannot be considered for the purpose of changing and doing violence to the clear and unequivocal language of the Statute, and particularly to eliminate therefrom entire sections which by reference are specifically included therein.

Respondents contend for a construction of the Trade-Mark Law of 1920 which would in effect constitute a repeal of the Trade-Mark Act of 1905 and which would, in effect, permit one who does not have a valid trade-mark either under the common law or under the Trade-Mark Law of 1905, to register said mark under the 1920 Act, and by virtue of the mere act of registering, claim a good and valid trade-mark. Such a construction constitutes a *reducto ad absurdum*.

Respondents' application for its trade-mark under the 1905 Act was refused because the words "Nu-Enamel" were descriptive of the product. It then registered its mark under the 1920 Act (Petitioner's Brief p. 5) (R. 32, Plff's. Ex. M). An identical and parallel situation was present in *Sleight Metallic Ink Co. v. Marks*, 52 Fed. (2d) 664, (D. Ct. E. D. Pa.), in which the Court said (665):

"The first question is as to the plaintiff's rights in

the word 'Metallic' as a technical trade-mark. It has been noted that the plaintiff was refused registration under the act of 1905. The effect of registration under the act of 1920 is fully considered in *Charles Broadway Rouss, Inc. v. Winchester Co.* (C. C. A.), 300 F. 706, and the conclusion reached that registration under the act of 1920 does not give the registrant even a *prima facie* title to the word as a trade-mark or trade-name. The statement of the committee, in recommending passage of the bill, was that the act would have no effect upon the domestic rights of any one. I accept the view of the scope of the act of 1920 taken by the court in the *Rouss* case. The plaintiff's case, therefore, stands entirely upon the plaintiff's common-law rights, as though there had been no registration at all."

In this connection, counsel for Respondents state (p. 18) that "Nu-Enamel is regarded even by Petitioner as a trade-mark", referring to R. 76. We fail to find in Record page 76, or anywhere, any basis for this statement. Even if true, the fact that Petitioner or any other than a court of competent jurisdiction regards "Nu-Enamel" as a trade-mark cannot give it validity.

#### **The Court's Only Jurisdiction Is to Determine Trade-Mark Validity and Infringement.**

In Respondents' brief (p. 20) it is said: "Jurisdiction once attaching, the court has power to decide all questions involved." This is followed by the statement: "When by virtue of the registration the Federal Courts have authority to act, they have authority to deal fully with all aspects of the case."

We submit that the above is not a correct statement of the law here applicable. Nor is it supported by the partial quotation in their brief (p. 20) from *Vogue Co. v. Vogue Hat Co.*, 12 Fed. (2d) 991. On the contrary, the

court in the *Vogue* case, which involved a valid trade-mark, sustains the proposition contended for by Petitioner that the trade-mark must first be held valid before a Federal Court can retain jurisdiction over the non-Federal question. We quote the following statement from the *Vogue* decision, p. 995, omitted by counsel for Respondents:

"In the patent—unfair competition cases the plaintiff must first show the existence of the valid patent; but, while the court has jurisdiction to hear this question, it has none to go further until the first point is established; only then may it consider whether the right has been infringed. In constitutional cases, there is no preliminary question; the general federal jurisdiction exists, and we come at once to the question of injury to the right. There is at least some analogy in cases depending on diverse citizenship. The plaintiff or the removing defendant must show that fact, and the court has a preliminary jurisdiction to determine whether that fact exists; but if it is found not to exist, that is the end of the case, while if it does exist, the court goes forward and considers all questions involved."

The jurisdiction of a Federal Court which attaches on the mere registration of a trade-mark, is the preliminary jurisdiction only to determine the validity of the trade-mark, which jurisdiction the District Court did exercise herein (Conclusion of Law No. 2, R. 109). Where the trade-mark is found to be invalid, there does not exist that substantial Federal question which this Court said in *Hurn v. Oursler*, 289 U. S. 238, will carry with it jurisdiction to determine a non-Federal question. As we have pointed out in our original brief (p. 30), the present case is analogous to that part of *Hurn v. Oursler* which involved the *uncopyrighted* portion of the play.

The *Oursler* decision makes very clear the distinction

ended for by Petitioner. In that case the original charged "violation of the copyright laws" and "unbusiness practices and unfair competition". (p. 239) amended bill added the charge that as to an uncopyrighted version of the play there was "unfair competition" (p. 248). *Infringement of a valid copyright* was found; but the Federal right and a substantial Federal question were recognized. This gave jurisdiction, in the absence of diversity of citizenship, over the unfair competition charged in respect to the valid copyright.

At where there was no copyright, the Court held that Federal courts were without jurisdiction over the Federal issue of unfair competition (p. 248). A trademark that is invalid is as impotent to support jurisdiction of a Federal court (in the absence of diversity of citizenship) over unfair competition as is the lack of a copyright.

The jurisdiction given by registration can apply only where there was something to register. Registering nothing creates nothing, either substantively or adjectively. It is as wholly nugatory as the failure to deposit or mark a copyright.

Further, in the *Oursler* case unfair competition was denied. The only charge in the instant case is that "Beauty" simulated "Nu-Enamel".

*Waterman v. Gordon*, 72 F. (2d) 272, cited and quoted in Respondents' brief (p. 20), involved a trademark which the Court held *valid under the Trade-Mark Laws of the United States* and is, therefore, not in point.

Furthermore, the distinction contended for by Petitioner is recognized in the *Waterman* Case in the following comment by the Court on the *Hurn* Case (p. 274):



"The result would have been otherwise had the suit on the statutory copyright been too unsubstantial to invoke any initial federal jurisdiction."

**The Evidence Referred to, if True, Does Not Establish Infringement.**

In their brief (p. 22) Respondents state that infringement is established by the evidence. Under this heading are set forth alleged acts not put in issue by the bill of complaint, which, as we pointed out in our original brief (p. 25), contains only an allegation that Respondents' alleged registered trade-mark "Nu-Enamel" has been infringed by Petitioner's use of "Nu-Beauty Enamel". No ~~other act or acts whatsoever were charged or alleged~~. Nowhere in their brief have counsel for Respondents met or answered this vital and important question. Nowhere in their brief is it pointed out where in the bill of complaint there is any allegation of unfair competition or of an act or acts from which unfair competition might be inferred. The District Court, therefore, properly disregarded all of the testimony referred to in respondents' brief under this section (pages 22 and following):

We again quote from *Richmond Remedies v. Dr. Miles Medical Co.*, 16 F. (2d) 598 (Petitioner's brief p. 33):

"We cannot surrender our own judgment in this matter because others may be of a different opinion or because it happens in isolated instances that some purchaser was so careless as not to detect the difference."

The above statement is unusually applicable herein in view of the fact that the *isolated instance* in the record of confusion of a *bona fide* customer is that of Dr. Teschan referred to in Respondents' brief (p. 28), and there was no passing off as far as the doctor was concerned.

He testified that he "asked for a half pint can of ivory enamel" (R. 44).<sup>\*</sup> What he bought was a can of enamel with the "Armstrong New Beauty" label on it. As Respondents state in their brief (p. 29), "The friend spotted the can and said: 'Why this is not Nu-Enamel it is New Beauty Enamel'."<sup>\*\*</sup>

The other alleged instances of passing off referred to on page 30 of Respondents' brief applied to witnesses, not one of whom was confused (R. 47-62). They were all paid shoppers, paid by Respondents, who were told to accept anything that was given to them, and in each and every instance the witness knew that he or she was not getting a can of "Nu-Enamel".

Respectfully submitted,

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<sup>\*</sup> Counsel for Respondents in their brief (p. 28) following their studied plan of avoiding the use of the word "enamel" when referring to petitioner's product, state that this witness "bought a can of paint".

<sup>\*\*</sup> The testimony of Dr. Teschan on this point is as follows (R. 44): "He (Seifert) spotted immediately that this was New-Beauty enamel."



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CHARLES ELMORE CROPLEY  
CLERK

IN THE  
Supreme Court of the United States  
OCTOBER TERM, A. D. 1937.

No. [REDACTED]

51

ARMSTRONG PAINT AND VARNISH WORKS,  
*Petitioner,*

*vs.*

NU-ENAMEL CORPORATION, an Illinois corporation,

*and*

NU-ENAMEL CORPORATION, a Delaware corporation,

*Intervener,*

*Respondents.*

BRIEF FOR RESPONDENTS  
OPPOSING APPLICATION FOR WRIT OF CERTIORARI.

EDWARD S. ROGERS,  
*Attorney for Respondents.*

WILLIAM T. WOODSON,  
JAMES H. ROGERS,  
*of Counsel.*





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IN THE  
**Supreme Court of the United States,**

October Term, A. D. 1937.

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**No. 1046**

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**ARMSTRONG PAINT AND VARNISH WORKS,**

*Petitioner,*

*vs.*

**NU-ENAMEL CORPORATION,** an Illinois corporation,

*and*

**NU-ENAMEL CORPORATION,** a Delaware corporation,  
*Intervener,*

*Respondents.*

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**BRIEF FOR RESPONDENTS  
OPPOSING APPLICATION FOR WRIT OF CERTIORARI.**

There are various reasons why, as it seems to us, there is no need for the Court to review this case. It has been twice decided adversely to Petitioner by the Circuit Court of Appeals for the Seventh Circuit. The first decision (81 Fed. (2d) 1) was by Judges Evans, Sparks and Alschuler. The opinion was written by Judge Evans. The second decision (95 Fed. (2d) 448) was by Judges Evans, Treanor and Lindley, the opinion being written by Judge Lindley.

In *Magnum Import Co. v. Coty*, 262 U. S. 159, Mr. Chief Justice Taft said (163) in speaking of the exercise of the jurisdiction to bring up cases by certiorari:

“ . . . the jurisdiction was not conferred upon this court merely to give the defeated party in the circuit court of appeals another hearing.”

### 1. There is no final decree to be reviewed.

The opinion of the Circuit Court of Appeals was filed on February 24, 1938 (R. 134), a petition for rehearing was filed on March 16, 1938, and denied on March 28, 1938 (R. 139), the mandate thereupon issued and was filed in the District Court on March 29, 1938 (R. 141). On April 11, 1938 (R. 141), an interlocutory decree for an injunction and accounting was presented to the District Court. Counsel for Petitioner suggested their purpose to file this petition, whereupon the motion for the entry of the decree was continued. On May 4th, Petitioner asked the Circuit Court of Appeals to recall and stay its mandate (R. 140). This motion was granted (R. 144). There is, therefore, no final decree. The only decree pending is the suggested interlocutory decree which Respondents moved the District Court to enter.

### 2. There is no question of general interest.

This is a suit between private traders involving trade mark infringement.

The question is primarily one of fact. All trade mark cases are cases of unfair competition. To attempt to place them in a different category is merely to play with words. The essence of the wrong is the false representation, however it may be made, that the goods of one producer or vendor are those of another, and, as Mr. Justice Pitney pointed out in *Hanover Star Milling Co. v. Metcalf*, 240 U. S. 401, 413, this essential element is the same whether the wrong is called trade mark infringement or unfair competition. This element must depend upon the facts; and, "it being a question of fact no previous case can be an authority for any other case, each case must depend upon the facts applicable to that case alone" (Lord Halsbury in *The Cellular Clothing Company v. Mawson and Murray*, 16 R. P. C. 397, 404).

Many years ago, this Court (quoting Lord Justice Turner) said in *Howe Scale Co. v. Wyckoff*, 198 U. S. 118, 37:

“It is a question of evidence in each case whether there is false representation or not.”

A trade mark is a mark used in trade which is capable of identifying or which in fact does identify, goods as coming from a particular trader. In this case, the Circuit Court of Appeals found, and it is admitted, that the word Nu-Enamel means Respondents and their products only, and is so understood; and that this word is a mark by which respondents' goods are distinguished from other goods of the same class. This is not a finding made upon conflicting evidence, but upon Petitioner's admission in a formal pleading intentionally made.\*

There is no need then of discussing whether as a matter of legal presumption, the name Nu-Enamel is or is not theoretically a valid trade mark. It is conceded that in fact it is distinctive of Respondents' goods. It, therefore, is Respondents' trade mark. It is unimportant that the syllable Nu or New may have been used in combination with other words or syllables on other goods. This case is specific and concrete. Moreover, Petitioner used the words Nu-Beauty Enamel not to describe its goods, but as a trade name to designate them. The evidence shows that the result of this is the passing off of Petitioner's goods as and for the respondents'. Therefore, Petitioner has committed a wrong

\* The admission is in the answer. (R. 13).

“Defendant admits that the name ‘Nu-Enamel’ has come to mean and is understood to mean, throughout the United States, including the State of Illinois and the City of Chicago, the plaintiff and plaintiff's products only, and the word ‘Nu-Enamel’ is a mark by which the goods of the plaintiff are distinguished from other goods of the same class.”



against Respondents, because the wrong which equity prevents in trade mark cases is, as this Court has said, the sale of one manufacturer's or vendor's goods as those of another (*Hanover Star Milling Co. v. Metcalf*, 240 U. S. 401, 413).

### 3. The registration of Respondents' trade mark is valid.

The word Nu-Enamel is registered as a trade mark for mixed paints, varnishes, paint enamels, prepared shellacs, stains, lacquers, liquid cream furniture polish, and colors ground in oil (R. 9) under an Act of Congress which provides (15 U. S. C., Sec. 124) for an action at law for damages and a suit in equity against any one who without the consent of the owner colorably imitates "any trade mark on the register provided by this Act" and shall use such colorable imitation in interstate commerce on goods of substantially the same descriptive properties as those set forth in the registration. Petitioner in this case comes within this express language. It is using a colorable imitation\* of Respondents' registered trade mark in interstate commerce upon the goods set forth in the certificate of registration. The District Courts are given original jurisdiction of all suits in equity "respecting trade marks registered in accordance with the provisions of this act" (15 U. S. C., Secs. 97, 126).

### 4. The District Court had jurisdiction.

Petitioner suggests that this suit was really for unfair competition, not for trade mark infringement. It asserts that the trade mark is invalid because descriptive and the

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\* It is clear that Nu-Beauty Enamel is a colorable imitation of Nu-Enamel under the definition of the term "colorable imitation" as used in the Trade Mark Act in *Dauids v. Davids*, 233 U. S. 461, 469, where it was held that "C. I. Davids" and "Davids Mfg. Co." were colorable imitations of the word "Davids'."

registration is void. Therefore, it is said that jurisdiction failed and the Court could not pass on the issue of unfair competition because both parties were Illinois corporations and there was no diversity of citizenship. We understand the law to be that when there is a cause of action grounded in infringement of a registered trade mark, there may be coupled with it a second cause of action for unfair competition, and if the unfair competition arises from the same acts which constitute trade mark infringement, the Court has jurisdiction over the unfair competition question even though there be no diversity of citizenship. Moreover, the Court retains its jurisdiction over the second cause of action even though the first may fail (*Hurn v. Oursler*, 289 U. S. 8; *L. E. Waterman Co. v. Gordon* (C. C. A. 2) 72 Fed. 2d 272; *Warner Publication, Inc. v. Popular Publications, Inc.* (C. C. A. 2) 87 Fed. (2d) 913; *Vogue Co. v. Vogue Hat Co.* (C. C. A. 6) 12 Fed. (2d) 991). However, during the pendency of this case, the original plaintiff, Nu-Enamel Corporation, the Illinois corporation, was succeeded by Nu-Enamel Corporation, a corporation of Delaware which acquired all its property and business, including the trade mark Nu-Enamel and its registration. The Delaware corporation intervened (R. 22-25) under Equity Rule 37. Hereafter, the case proceeded with the Delaware corporation as plaintiff. So, while we are confident that the Court had jurisdiction originally, any defect was cured before trial.

Petitioner further suggests that a mark which has acquired a distinctive or so-called secondary meaning can never be a trade mark. In *Coca-Cola Company v. Koke Company of America*, 254 U. S. 143, this Court held that the word Coca-Cola had "acquired a secondary meaning in which perhaps the product is more emphasized than the producer, but to which the producer is entitled", and granted a decree which held "that the word 'Coca-Cola' is a valid trade mark". Moreover, descriptiveness is no ob-

jection to registration under the Trade Mark Act of 1920. Indeed, the purpose of this Act is to permit the registration of quasi descriptive and suggestive marks in bona fide use for not less than one year (U. S. C. Title 15, Sec. 121). There is no such prohibition in the Act of 1920 against the registration of descriptive marks such as there is in the Act of 1905 (U. S. C. Title 15, Sec. 85). On the contrary, the 1920 Act authorizes the registration of "all other marks not registrable" under the Act of 1905 except those specified in paragraphs (a) and (b) of Section 85. Paragraphs (a) and (b) forbid the registration of marks which are immoral or scandalous or comprise the flag or coat of arms or other insignia of the United States, etc. Therefore, we suggest that the alleged descriptiveness of Respondents' trade mark, even if true, would not affect its registration under the Act in question or render it invalid.

While it has been held that registration under the Act of 1920 (15 U. S. C., Sec. 121 and following) carries no presumption of validity, in this case the lack of any such presumption is supplied by Petitioner's admission that the registered mark *in fact* performs the function of a trade mark because it identifies the registrant's goods. Therefore, as between the parties to this case the trade mark is valid. Moreover, the statute provides a direct proceeding to cancel improperly registered marks (15 U. S. C., Sec. 122), of which Petitioner has not availed itself. In view of Petitioner's admissions that the trade mark is distinctive and its failure to attack the registration directly, it should not be permitted to do so collaterally in an attempt to avoid accountability for its piracy.

**5. There is no diversity of decision between different courts.**

On the contrary, the decisions have been unanimous in sustaining Respondents' trade-mark and enjoining infringements of it. (*Nu-Enamel Corporation v. Nate Enamel Co.*,

*Inc.*, 243 N. Y. App. Div. 292 [affirmed in 268 N. Y. 574.]  
*Nu-Enamel Corporation v. True Enamel, Inc.*, Chancery  
 Court of New Jersey, Docket 103/320, decided Mar. 6, 1935  
 [unreported]. *Long Island Nu-Enamel Co. Inc. v. Neustein*,  
 U. S. D. C., E. D., New York, No. E7377-1934 [unreported].  
*Nu-Enamel Corporation v. U-Enamel-It, Inc.*, U. S. D. C.,  
 S. D., New York, No. E78-193-1934 [unreported].)

#### 6. Petitioner's infringement.

The trade mark Nu-Enamel was first used by C. L. Lloyd, Respondents' predecessor in business, in the latter part of 1922 or the first part of 1923 (R. 28). The products upon which it was originally used were paints, varnishes, enamels, top dressings and brushes (R. 28). Other items were added from time to time. When this suit was begun, the trade mark Nu-Enamel was being used on the following additional items: wood powder, patching plaster, wax, enamelized paint, flat white varnish, varnish stain, utility block thinner floor finish, bronze liquid, linoleum finish, polish, casein paint, metallic finish remover, glue, mineral and oil colors, liquid solder and tack rags (R. 28, 135).

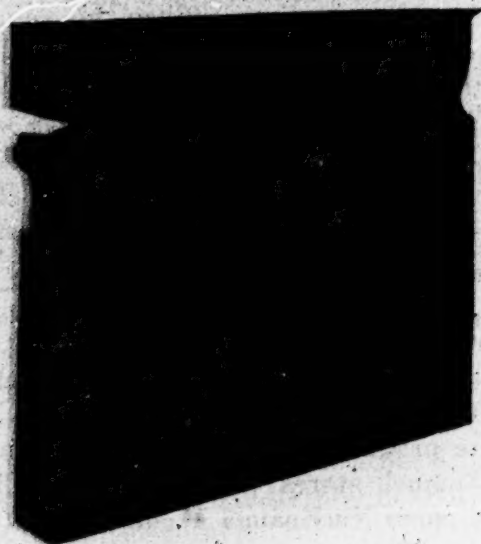
Respondents' goods bearing the Nu-Enamel trade mark are sold in every state of the union and in twenty-one foreign countries. There are approximately 3,000 dealers throughout the United States selling Nu-Enamel goods, and there are 300 stores operating under the name Nu-Enamel, handling these products exclusively. Twenty-five or thirty of the Nu-Enamel stores are located in Chicago and vicinity. The name Nu-Enamel is conspicuously displayed about them (R. 29):

The sales of Nu-Enamel goods in the past four years have been over \$4,250,000.00 (R. 29). Several hundred thousand dollars has been spent each year in advertising them (R. 30).

Respondents' trade mark is illustrated on pages 7 and 9 of the record. The word Nu-Enamel is shown in a curve thus—

**NU-ENAMEL**

The label used by Petitioner when this suit was brought (R. 11) displayed the words Nu-Beauty Enamel on the front. Petitioner's name appeared only on the back. Petitioner's advertising signs like the one here illustrated (from Plaintiff's Exhibit T) were before the Court below.



**7. The purpose of Petitioner's acts and their result.**

The evidence of Petitioner's bad motive in adopting the colorable imitation of Respondents' trade mark is overwhelming, and this in itself is almost conclusive on the issue of infringement. Petitioner knew of Respondents'



trade mark before adopting the designation Nu-Beauty Enamel for its competing goods. It went out to "get their share of that business created by the demand for Nu-Enamel" (R. 66). It hired a man, formerly employed by Respondents, to "put this proposition over" (R. 64). Respondents' advertising was copied, their customers solicited (R. 65), and retail outlets opened as near to Respondents' as possible (R. 65).

The testimony is very clear and Petitioner's scheme was plain. Its advertising manager, Milton C. Fisher, stated (R. 74) that in 1933 Petitioner put out a product called "Nu-Beauty Furniture Cream"; that in August, 1934, it brought out "Nu-Beauty Enamel"; that the other items of the line under the name "Nu-Beauty" were later; and (R. 75): "Prior to 1934, when we adopted the name Nu-Beauty Enamel, our company had been putting out enamels and varnishes under some other trade mark. \* \* \* The product which we put out in 1934, was not a new product; we didn't at that time add enamels and varnishes to our line of products, we had been putting those out previously". Again, "I had heard of Nu-Enamel before I suggested the name Nu-Beauty for this furniture polish and for this line of products." (R. 74). Speaking of Nu-Enamel, the witness said (R. 73): "I am familiar with a product sold under the trade-mark Nu-Enamel. It is a well known product. I have seen it on sale in stores, in and about Chicago, by the name of Nu-Enamel". Again (R. 76): "When we adopted Nu-Beauty for cream, furniture cream, and enamel and varnish, I was familiar or was aware of the trade-mark Nu-Enamel."

So we have the admitted fact that when the name Nu-Beauty Enamel was adopted, Petitioner knew of Respondents' trade mark Nu-Enamel and that Respondents' goods were well known.

Not content merely with adopting a name for a competing line which Petitioner knew was the well known designation of a competitor's goods, it hired W. J. Nelson who

had been an employee of a company affiliated with Respondents.

Nelson testified (R. 64):

"I was hired to devote all of my time and effort to the promotion, development and sale of New-Beauty Enamel. At the time he (Van Antwerp, Petitioner's Vice President and Sales Manager) employed me he told me he was not quite ready to start it at that time, that he had some changes he was making and some things were not in quite the shape to proceed, and we set the date for June 3rd to start my employment. \* \* \*

I was told that they were not capable of instructing me, with the experience I had in developing Nu-Enamel, but told me they were going to look to me for suggestions and instructions. They told me I would have to use my own initiative and they were depending on me to put this proposition over in the same manner Nu-Enamel had been put over. I was told that they had no definite policy outlined, and that Nu-Enamel had done an outstanding job in that specialty field, and that I knew more about that than they did, that I should use my own judgment, develop it and put it over on the same basis if necessary." (Interpolation ours.)

Nelson turned over to Petitioner, Nu-Enamel sales material. He proceeded to develop the department on the same lines used by Respondents. He solicited and engaged new distributors, which were most always in the vicinity of a Nu-Enamel store or Nu-Enamel dealer (R. 65). The Nu-Enamel advertising matter was copied and adapted. Nelson testified (R. 65):

"I mentioned to Mr. Fisher, the advertising manager, the similarity of these two, the design on those two color cards. I said 'That is a copy of the Nu-Enamel girl.' He said 'We just straightened her up a little bit and gave her the sign to hold'."

Indeed, the Petitioner's establishment was so permeated with Nu-Enamel ideas that (R. 66):

"Mr. Sappington (Petitioner's assistant sales manager) said several times that Nu-Enamel had made the public enamel conscious, and that we were going out to get their share of that business created by the demand for Nu-Enamel. It was the custom in and around the offices of the Armstrong Paint & Varnish works in referring to New-Beauty Enamel to call it Nu-Enamel as often as it was called New-Beauty Enamel. It was general unless one was specific in his conversation to distinguish between the two." (Interpolation ours.)

Also, the prices of Nu-Enamel, which were unusual, were adopted by the Petitioner (R. 65). Every step was taken with Nu-Enamel in view, and (R. 69), "They compared to Nu-Enamel, Nu-Enamel was used as the standard of comparison of all enamels in the Armstrong laboratory." When the suit was brought, Mr. Nelson testified (R. 69):

"Mr. Goldsmith (Petitioner's president) told me, as well as Mr. Van Antwerp (vice president and sales manager) and Mr. Sappington (assistant sales manager), that we had to soft pedal these New-Beauty merchandising ideas until this suit was over, and that Mr. Goldsmith hesitated to go ahead with the proposition. They called Mr. Armstrong the skipper. They said the skipper was very much worried about it. They told me to tone down in carrying on the New-Beauty establishment of dealers and distributors and asked me to go into the full line, sell the full line of Armstrong products under other brand names. At one time Mr. Van Antwerp said 'I don't want this copying of Nu-Enamel ideas too evident.'" (Interpolations ours.)

None of these statements was denied. So the Court below had before it this situation. Nu-Enamel goods were well known products under a well known

name and was well known to Petitioner who, as its advertising manager candidly put it, was "going out to get their share of that business created by the demand for Nu-Enamel" (R. 66). There was a conscious effort to appropriate everything in sight so that Petitioner's purpose to get the Nu-Enamel business might be successfully carried out.

Petitioner's intent to appropriate Respondents' business succeeded. People bought its goods in the belief that they were Respondents' (R. 44-45, 65).

Forty-four instances of passing off Petitioner's product for Respondents' at twenty-seven stores on fifty-one calls were proved (R. 47-62).

Petitioner, by furnishing to dealers the instrument of fraud, is responsible for the use that is made of it. *Federal Trade Commission v. Winsted Hosiery Company*, 258 U. S. 433, where Mr. Justice Brandeis said (494):

"That a person is a wrongdoer who so-furnishes another with the means of consummating a fraud has long been a part of the law of unfair competition."

#### 8. The decision of the Circuit Court of Appeals was correct.

This case presented a definite and undisputed fact situation to the Court below. A distinctive name, made valuable by Respondents' efforts and advertising, and one which Petitioner admits is the well-recognized means of distinguishing Respondents' products, registered under the Federal Act and the registration unassailed, was deliberately imitated by Petitioner with the result that Petitioner's goods are passed off as Respondents'.

Like the one referred to by Mr. Justice Holmes, when Chief Justice of Massachusetts, in *American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85, 87: "The question is specific and concrete". The Court below put a stop to a manifest, intentional, and successful fraud, perpetrated by Petitioner upon Respondents.

Stripped of all sophistry, this case comes down to this simple fact. Respondents adopted a name which admittedly and in fact identifies their goods. This name is Respondents' registered trade mark. Petitioner intentionally used a colorable imitation to designate competing goods which in fact caused them to be passed off as the goods of the respondents. The cause of action was complete and on rudimentary principles of fair dealing, Respondents are entitled to the relief which the Court awarded.

Respectfully submitted,

EDWARD S. ROGERS,  
*Attorney for Respondents.*

WILLIAM T. WOODSON,  
JAMES H. ROGERS,  
*of Counsel.*



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IN THE

**Supreme Court of the United States**

OCTOBER TERM, A. D. 1938.

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No. 51.

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**ARMSTRONG PAINT AND VARNISH WORKS,**  
*Petitioner,*

*vs.*

**NU-ENAMEL CORPORATION, AN ILLINOIS CORPORATION,**  
**and**  
**NU-ENAMEL CORPORATION, A DELAWARE CORPORATION,**  
**INTERVENER,**  
*Respondents.*

---

WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE  
SEVENTH CIRCUIT.

---

**BRIEF FOR RESPONDENTS.**

---

**EDWARD S. ROGERS,**  
*For Respondents.*

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**JAMES H. ROGERS,**  
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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, A. D. 1938.

---

ARMSTRONG PAINT AND VARNISH WORKS,  
*Petitioner,*

*vs.*

NU-ENAMEL CORPORATION, AN ILLINOIS CORPORATION,  
and  
NU-ENAMEL CORPORATION, A DELAWARE CORPORATION,  
INTERVENER,

*Respondents.*

---

WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE  
SEVENTH CIRCUIT.

---

**BRIEF FOR RESPONDENTS.**

---

**THE PROCEEDINGS.**

---

This action was brought in January, 1935 by Respondent, the Illinois Corporation, as Plaintiff, and Petitioner as Defendant, in the District Court for the Northern District of Illinois. The complaint charged Petitioner with infringement of a trade-mark consisting of the word Nu-Enamel in a curved line, registered by Respondents' predecessor in 1933 (R. 9) under the Act of Congress of March 19, 1920 (U. S. C. Tit. 15, Par. 121 and following) for mixed paints, varnishes, paint enamels, prepared shellacs, stains, lac-

quers, liquid cream furniture polishes and colors ground in oil. The infringement complained of was the use by Petitioner, beginning in August, 1934, of the name Nu-Beauty Enamel on competing goods. Both marks are used in interstate commerce (R. 4, 15).

When the action was brought both parties were Illinois corporations. Pending the suit the original plaintiff sold its property, assets, good will and trade-marks including the one involved, to a Delaware corporation of the same name. The Delaware corporation intervened and the action proceeded with that corporation as plaintiff.

The District Court dismissed the complaint on motion. The Circuit Court of Appeals reversed. *Nu-Enamel Corporation v. Armstrong Paint and Varnish Works*, 81 Fed. (2) 1.

On remand, after a trial the District Court dismissed the complaint for want of equity (R. 115). The Circuit Court of Appeals reversed a second time. *Nu-Enamel Corporation v. Armstrong Paint and Varnish Works*, 95 Fed. (2) 448 (R. 134). This court granted certiorari on October 10, 1938.

#### THE FACTS.

The word Nu-Enamel was first used as a trade-mark by C. L. Lloyd, Respondents' predecessor in business, in the latter part of 1922 or the first part of 1923 (R. 28). The products upon which it was originally used were paints, varnishes, enamels, top dressings and brushes (R. 28). Other items were added from time to time. When this suit was begun, Nu-Enamel was being used on the following additional goods: wood powder, patching plaster, wax, enamelled paint, flat white varnish, varnish stain, utility black, thinner, floor finish, bronze liquid, linoleum finish, polish, casein paint, metallic finish, remover, glue, mineral and oil colors, liquid solder and tack rags (R. 28, 135).



Respondents' goods marked with the name Nu-Enamel are sold in every state of the union and in twenty-one foreign countries. There are approximately 3,000 dealers throughout the United States selling Nu-Enamel goods, and there are 300 stores operating under the name Nu-Enamel, handling these products exclusively. Twenty-five or thirty of the Nu-Enamel stores are located in Chicago and vicinity where Petitioner's business is conducted. The name Nu-Enamel is conspicuously displayed about them (R. 29).

The sales of Nu-Enamel goods in the past four years have been over \$4,250,000.00 (R. 29). Several hundred thousand dollars has been spent each year in advertising them (R. 30).

The result is that Nu-Enamel has come to mean Respondents' goods and indicates that products so marked come from Respondents and no one else. Petitioner expressly admits this significance. The answer says:

"Defendant admits that the name 'Nu-Enamel' has come to mean and is understood to mean, throughout the United States, including the State of Illinois and the City of Chicago, the plaintiff and plaintiff's products only and the word 'Nu-Enamel' is a mark by which the goods of the plaintiff are distinguished from other goods of the same class." (Paragraph 2 of defendant's Amended Answer, R. 13.)

The foregoing facts were found by the court below (R. 134-136).

Petitioner's product was labelled Nu-Beauty Enamel when the action was begun. A month or so afterward the name was changed to New Beauty Enamel (R. 74). The use of the word "beauty" was commented on by the court below (R. 136):

"Furthermore we think the evidence clearly shows infringement. Defendant's mark consists of the word 'Nu-Enamel' with the word 'Beauty' inserted between the words 'Nu' and 'Enamel' or between the words 'New' and 'Enamel.' The addition of this word be-

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comes significant in view of the slogan placed by plaintiff on its cans over the trade-mark, 'The Coat of En-during Beauty,' where the word 'Beauty' appears immediately above the word 'Nu-Enamel'."

Petitioner's product sold under the name Nu-Beauty Enamel was not a new article. Petitioner had previously used other names for the same goods when it began to use "Nu-Beauty Enamel" in August, 1934. Nu-Beauty Enamel was merely a new mark applied to an old product (R. 75). Petitioner knew of Respondents' use and advertisement of Nu-Enamel, when it adopted the name Nu-Beauty Enamel for its competing goods. One of Petitioner's officers testified that "It (Nu-Enamel) is a well known product" (R. 73) and "I was familiar or was aware of the trade-mark Nu-Enamel" (R. 76). Another said that Petitioner was "going out to get their share of that business created by the demand for Nu-Enamel" (R. 66). Petitioner copied Respondents' advertising slogans, sales literature and displays (R. 65, 67). Petitioner's use of the name Nu-Beauty Enamel caused purchasers to buy Petitioner's goods believing them to be Respondents' (R. 44, 45, 65). A large number of instances of passing off Petitioner's goods when Respondents' were called for were proved (R. 47-62).

The court below found (R. 136):

"That there was confusion between the products of plaintiff and defendant clearly appears. Witnesses testified that they called on dealers handling defendant's product and asked specifically for Nu-Enamel. In forty-six instances New Beauty Enamel was delivered to them, without explanation. This included products marked New Beauty Enamel and Nu Beauty Enamel, the former being the mark adopted by defendant some two months after this suit was brought. Other instances of confusion appear in the record. There was evidence of similarity in advertising, adoption of the slogans of the plaintiff and other acts, all bearing also heavily upon the issue of unfair competition."

The Court concluded (R. 137):

"The facts presented to us in the instant case persuade us that the defendant attempted to convert to its own use the property right which plaintiff had built up represented by the trade-mark."

#### THE STATUTE.

This case involves the Act of Congress March 19, 1920 (U. S. C. Tit. 15 Par. 121 and following). This statute incorporates by reference certain sections of the Trade Mark Act of February 20, 1905 (U. S. C. Tit. 15 Par. 81 and following). For convenience these sections are included in the statute which is printed in the appendix to this brief. To distinguish them they are indented and running side titles are inserted in the margin.

## SUMMARY OF ARGUMENT.

Respondents' mark in suit is registered in the "b" register provided by the Act of 1920. No attempt to cancel it has been made. It is admitted that the goods of the parties upon which the marks in question are used are merchandise of the same descriptive properties. It is admitted also that the goods of both parties bearing the marks in controversy are sold in interstate commerce (R. 4, 15). Petitioner adopted Nu-Beauty Enamel with intent to appropriate Respondents' business by misleading customers into accepting Petitioner's goods as Respondents' and its use has had this result. We submit that Nu-Beauty Enamel is a copy or colorable imitation of Respondents' registered trade-mark Nu-Enamel, within the meaning of the statute. (*Dauids v. Dauids*, 233 U. S. 461.)

The spit was brought in the District Court as authorized by Section 17 (U. S. C. Tit. 15 § 97):

"The district . . . courts of the United States . . . shall have original jurisdiction, . . . of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this act, arising under the present act without regard to the amount in controversy." (Feb. 20, 1905, c. 592, § 17, 33 Stat. 728; Mar. 3, 1911, c. 231, § 291, 36 Stat. 1167; June 7, 1934, c. 426, 48 Stat. 926.)

Trade-marks are not monopolistic grants like patents and copyrights. (*Trade-Mark Cases*, 100 U. S. 82; *Prestonettes v. Coty*, 264 U. S. 359, 368; *United Drug Co. v. Reetanus*, 248 U. S. 90, 97-98.) To protect trade-marks is to secure good will against appropriation and is sound public policy. (*McLean v. Fleming*, 96 U. S. 245, 246.)

The protection which is accorded to trade-marks is protection against misrepresentation as to the origin of the goods. (*Howe Scale Co. v. Wyckoff*, 198 U. S. 118, 137.)

The wrong is the same whether designated trade-mark infringement or unfair competition. (*United Drug Co. v. Rectanus*, 248 U. S. 90, 97; *Hanover Star Milling Co. v. Metcalf*, 240 U. S. 403, 412; *G. & C. Merriam Co. v. Saalfeld*, (C. C. A. 6) 198 Fed. 369, 372.)

A trade-mark is "a distinguishable token devised or picked out" (*Beechnut v. Lorillard*, 273 U. S. 629, 632). A trade-mark is a mark which either inherently or by association distinguishes the goods of one trader from those of another. (*Canal Co. v. Clark*, 13 Wall. 311, 322; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537, 564; *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51, 54.) It is expressly admitted in this case that the word Nu-Enamel is a mark by which the goods of Respondents are distinguished from other goods of the same class (R. 13). It is therefore a trade-mark.

None of our National trade-mark statutes purport to confer substantive rights. They deal with jurisdictional and procedural matters only. (*American Trading Co. v. Heacock*, 285 U. S. 247, 258; *Dauids v. Davids*, 233 U. S. 461.)

The Trade-Mark Act of March 19, 1920 (U. S. C. Tit. 15 § 121) authorizes the registration of descriptive marks on the "b" register which is analogous to the "ten year proviso" of the Act of 1905 construed by this court in *Dauids v. Davids*, 233 U. S. 461-467. This analogy is demonstrated by the legislative history of the Act of 1920. (*Ex parte Chr. Hansen's Laboratory*, 18 T. M. Rep. 594, 151 M. D. 794.)

The Act in terms confers on Federal courts jurisdiction of cases involving marks registered under it. (Sec. 6, Trade-Mark Act of March 19, 1920 (U. S. C. Tit. 15, Sec. 126).)

Respondents' trade-mark Nu-Enamel is registered under



this Act, and Respondents are entitled to the jurisdictional advantages which the Act confers. In any event whether the wrong committed against Respondents by Petitioner is described as trade-mark infringement or unfair competition, the act is the same. It is the act, not the epithet applied to it which is important. The District Court had jurisdiction to determine the whole controversy no matter whether the wrong is called trade-mark infringement or unfair competition. This is so even if there is a legal difference between trade-mark infringement and unfair competition. (*Recamier v. Harriet Hubbard Ayer, Inc.*, (D. C. N. Y.) 59 Fed. (2d) 802, 806; *Vogue Co. v. Vogue Hat Co.*, (C. C. A. 6) 12 Fed. (2d) 991, 992; *Waterman Co. v. Gordon*, (C. C. A. 2) 72 Fed. (2d) 272; *Hurn v. Oursler*, 289 U. S. 238, 246.)

The name Nu-Beauty Enamel, used by Petitioner, was adopted to enable it to divert to itself the good will of Respondents' business, by appropriation of the mark by which that good will is symbolized (R. 137). Petitioner's use of the name Nu-Beauty Enamel, causes Petitioner's goods to be sold as and for Respondents'. Nu-Beauty Enamel is therefore a colorable imitation of Respondents' trade-mark, within the meaning of the Act. The rights to be considered are those of the parties to this proceeding as between themselves. (*International News v. Associated Press*, 248 U. S. 215, 239, 63 L. Ed. 211.) The question is specific and concrete. (*American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85.)

## ARGUMENT.

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THERE IS NO LEGAL DIFFERENCE BETWEEN INFRINGEMENT OF  
A TRADE-MARK AND THE COMMON CASE OF UNFAIR COM-  
PETITION.

Trade-marks are not monopolistic grants like patents and copyrights (*Trade-Mark Cases*, 100 U. S. 82). In *Prestonettes v. Coty*, 264 U. S. 359, Mr. Justice Holmes said (368):

“It (a trade-mark) does not confer a right to prohibit the use of the word or words. It is not a copyright. \* \* \* A trade-mark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his.”  
(Interpolation ours.)

In *United Drug Co. v. Rectanus*, 248 U. S. 90, 97-98, Mr. Justice Pitney said:

“The owner of a trade-mark may not, like the proprietor of a patented invention, make a negative and merely prohibitive use of it as a monopoly.”

In truth, a trade-mark confers no monopoly whatever in a proper sense \* \* \*.”

Trade-marks are merely a convenient way of distinguishing the goods of one trader from those of another. By furnishing a means of identification, they perpetuate good will, and enable purchasers, by recognizing the marks, to buy again the goods which have pleased them before (*McLean v. Fleming*, 96 U. S. 245, 252). The public is thus assured of identity, and is given an opportunity to choose between competing articles. To protect trade-marks, i. e., marks which permit the goods of different makers to be distinguished from each other, is to promote competition and is sound public policy.

The protection, which is accorded is security against

misrepresentation as to the origin of goods, by suppressing imitations which are calculated to mislead buyers into the belief that the goods of one maker are those of another.

There is no essential difference between trade-mark infringement and what is loosely called unfair competition. Unfair competition is the genus of which trade-mark infringement is one of the species; "the law of trade-marks is but a part of the broader law of unfair competition" (*United Drug Co. v. Rectanus*, 248 U. S. 90, 97). All trade-mark cases are cases of unfair competition and involve the same legal wrong. As Mr. Justice Pitney observed in *Hanover Star Milling Co. v. Metcalf*, 240 U. S. 403, 412:

"The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another. \* \* \*

"This essential element is the same in trade-mark cases as in cases of unfair competition unaccompanied with trade-mark infringement."

The only difference between a trade-mark infringement case and a case of what we, in this country, sometimes call unfair competition and the English "passing off", is in the matter of evidence. A trade-mark, as commonly conceived, is a mark having no reference to the character of the goods. Any unauthorized use of it on competing goods is presumed to be for the purpose of passing them off as the goods of the original user of the mark. The use of a name or device which may have reference to the character of the goods, raises no such initial presumption; but when it is shown that the mark in fact identifies the plaintiff's goods and that the unauthorized use or imitation of it on competing goods, in fact represents them as coming from the trader with whose goods the mark identifies, there is the same misrepresentation of origin as in the case of a technical trade-mark and the same relief is called for. In the one case, identification and the consequent passing off of goods

is presumed; in the second case, there is no presumption, but if the facts are proved which equal the presumption, the same legal consequences follow. The wrong is the false representation that the goods of one trader are those of another. And as this Court (quoting Lord Justice Turner) said in *Howe Scale Co. v. Wyckoff*, 198 U. S. 118, 137:

“‘It is a question of evidence in each case whether there is false representation or not.’”

Whether the wrong is termed trade-mark infringement or unfair competition, “the ultimate offense always is that defendant has passed off his goods as and for those of the complainant” (*G. & C. Merriam Co. v. Saalfeld*, (C. C. A. 6) 198 Fed. 369, 372). This is the offense which Petitioner committed.

NU-ENAMEL IS RESPONDENTS' TRADE-MARK, BECAUSE IN FACT IT DISTINGUISHES RESPONDENTS AND THEIR GOODS.

It seems irrational to argue that Nu-Enamel is not a good trade-mark as a matter of law when the admitted fact is that Nu-Enamel is understood to mean Respondents and Respondents' products only, and that the word Nu-Enamel is a mark by which the goods of Respondents are distinguished from other goods of the same class (R. 13). Nu-Enamel represents a valuable good will which is Respondents' property. In Mr. Justice Holmes' phrase in *Beech-ut v. Lorillard*, 273 U. S. 629, 632, it is:

“a distinguishable token devised or picked out with the intent to appropriate it to a particular class of goods and with the hope that it will come to symbolize good will.”

It is a contradiction in terms to say that a mark which admittedly does indicate origin, cannot do so. Thinking realistically, a mark which in fact distinguishes Respondents' goods from others in the same class, is Respondents' trade-mark. By association, the word Nu-Enamel points

distinctly to the origin of the article to which it is applied. Hence, by definition it is a trade-mark.

In *Canal Co. v. Clark*, 13 Wall. 311, 323, Mr. Justice Strong said:

"Hence the trade-mark must either by itself, or by association, point distinctively to the origin or ownership of the article to which it is applied."

This statement was quoted with approval by Mr. Chief Justice Fuller in *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537, 546, and cited by Mr. Justice Field in *Amoskeag Mfg. Co. v. Trainer*, 101 U. S. 51, 54, where the principle was restated:

"The object of the trade-mark is to indicate, either by its own meaning or by association, the origin or ownership of the article to which it is applied."

All of our National trade-mark legislation implicitly recognizes these fundamental principles. The existing Federal trade-mark statutes do not involve the substantive law but deal with jurisdictional and procedural matters only. Mr. Chief Justice Hughes pointed this out in *American Trading Co. v. Heacock*, 285 U. S. 247, 258, in speaking of the provisions of the Trade-Mark Act of February 20, 1905 (U. S. C. A. Title 15, Secs. 81, *et seq.*), but those provisions as to jurisdiction and procedure have been carried over into the Trade-Mark Act of March 19, 1920 (U. S. C. A. Title 15, Sec. 121 *et seq.*) under which Respondents' mark is registered.

The Act of 1905 permits the registration of arbitrary marks and marks which are presumed to have become identifying by continuous and exclusive use as trade-marks for ten years prior to February 20, 1905 (*Dauids v. Dauids*, 233 U. S. 461). The "b" register of the Act of 1920 is merely an extension of the so-called ten-year proviso of the Act of 1905.



ONE OF THE PURPOSES OF THE ACT OF 1920 WAS TO PERMIT REGISTRATION OF DESCRIPTIVE TERMS, FUNCTIONING AS TRADE-MARKS, WHICH HAVE BEEN IN USE FOR ONE YEAR.

The Act of March 19, 1920, authorizes the registration of marks under the Buenos Aires Convention with which we are not here concerned. It also establishes a (b) register of marks not registrable under the 1905 Act (except those of an immoral or scandalous nature, and certain public insignia, which are excluded from both Acts). Descriptive marks are registrable on the (b) register provided by the 1920 Act. The Solicitor of the Department so advised the Secretary of the Interior (Appendix, *post*, 42). This is the construction followed by the Patent Office. In *Ex parte Chr. Hansen's Laboratory*, 18 T. M. Rep. 594, 151 Ms. Dec. 794, the Assistant Commissioner of Patents said of an application under the 1920 Act:

"The trade-mark act under which registration is here sought was intended to afford registration of descriptive names or terms which were not registrable under the 1905 Act, and this fact is made clear enough by the record of the proceedings leading up to the enactment of this law of March 19, 1920."

#### THE LEGISLATIVE HISTORY OF THE ACT OF 1920.

The bill which finally became the Act of March 19, 1920, was originally H. R. 9203, introduced at the request of the Treasury to carry out the provisions of the Inter-American Convention by authorizing the registration of marks transmitted by the International Bureau which the Convention created (Hearings, October 15, 1919, on H. R. 9023 before the House Committee on Patents, p. 3). H. R. 9023 was identical with the bill passed by the Senate a year before (p. 12). It provided only for what is the "a" register of the Act of 1920.

On Jan. 21, 22, 1920, the House Committee held hearings on H. R. 7175, which was a bill to amend section five of the trade-mark act of February 20, 1905, so as to permit the

registration under the so-called ten-year proviso of that act of marks applied to new goods in the same class as those included in the original registration. In the course of these hearings it was pointed out that the ten-year proviso, by fixing the arbitrary period, ten years prior to Feb. 20, 1905, worked injustice by excluding from registration marks used as trade-marks for a shorter period and equally worthy of protection (Hearings on H. R. 7157, p. 7). It was suggested that two years' use as a trade-mark ought to entitle a mark to registration whether it was descriptive of the article or not (Hearings, p. 7). These hearings resulted in the amendment to Section 5 of the Act of 1905.\*

It then appeared that this amendment would not meet the difficulty: that there were marks functioning as trade-marks but which could not be registered under the 1905 Act even with the amendment to the ten year proviso. The Commissioner of Patents proposed adding to the bill authorizing the registration of Pan-American marks, a new section as follows (Hearings, p. 30):

"All other marks not registrable under the Act of February 20, 1905 (as amended) but which for not

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\* "And if any person or corporation shall have so registered a mark upon the ground of said use for ten years preceding February 20, 1905, as to certain articles or classes of articles to which said mark shall have been applied for said period, and shall have thereafter and subsequently extended his business so as to include other articles not manufactured by said applicant for ten years next preceding February 20, 1905, nothing herein shall prevent the registration of said trade-mark in the additional classes to which said new additional articles manufactured by said person or corporation shall apply, after said trade-mark has been used on said article in interstate or foreign commerce or with the Indian tribes for at least one year provided another person or corporation has not adopted and used previously to its adoption and use by the proposed registrant, and for more than one year such trade-mark or one so similar as to be likely to deceive in such additional class or classes." (U. S. C. Tit. 15, § 85.)

less than two years have been bona fide used in interstate or foreign commerce, or commerce with the Indian tribes, by the proprietor thereof, upon or in connection with any goods of such proprietor and upon which the fee of \$10 has been paid and such formalities as are prescribed by the Commissioner of Patents have been complied with, may be registered."

This bill then became H. R. 9023 and this section, with only verbal changes, became paragraph (h). The period of use was reduced to one year in the Senate (Congressional Record, Feb. 21, 1920, p. 3225). The Assistant Commissioner of Patents, in the hearings on H. R. 9023 on Jan. 21, 22, 1920, pointed out that, apparently by oversight, the registration of immoral and scandalous marks and public insignia might be possible and suggested that the bill be amended by inserting after the words "all other marks not registrable under the Act of February 20, 1905", the words "except those specified in paragraphs (a) and (b) of Section 5 of that act or words to that effect." (Hearings, H. R. 9023, p. 34.)\* This was done.

It is apparent from the legislative history of the Act of 1920 that the register provided by it was considered the exact parallel of the ten-year proviso of the 1905 Act, the only differences being the period of use required and that registration carried no presumption of ownership. In every other respect it had the same effect. The only marks intended to be excluded from the benefits of the 1920 Act were immoral and scandalous marks and certain public insignia. The registration of descriptive, personal and geographical names if used bona fide as trade-marks, for one year, was expressly contemplated.

\* Mr. Whitehead: One or two slight amendments ought, it seems to me, be made to the bill. The bill as it stands is broad enough to put any mark on the register. Section 5 of the act of February 20, 1905, outlaws—if I may use that expression—two classes of marks—one, scandalous and immoral marks, and the other marks consisting of the flag or

THE "B" REGISTER PROVIDED BY THE ACT OF 1920 IS ANALOGOUS TO THE TEN-YEAR PROVISIO OF THE ACT OF 1905.

There is an exact analogy between the general purposes of the 1920 Act authorizing the registration of marks used as trade-marks for one year and the ten-year proviso of the 1905 Act (U. S. C. Tit. 15 § 85) which authorizes the registration of marks used as trade-marks for ten years prior to Oct. 20, 1905.\* A side by side comparison is a demonstration of this. The ten-year proviso is as follows:

That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States or with Indian tribes which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding February twentieth, nineteen hundred and five.

The corresponding section of the 1920 Act is as follows:

"(b) All other marks not registerable under the Act of February 20, 1905, as amended, except those specified in paragraphs (a) and (b) of section 5 of

coat of arms of the United States, etc., and it seems as if this Senate amendment ought to be amended to exclude those marks specified in paragraphs (a) and (b) of that section. Otherwise there can be put on the register scandalous marks and the flag of the United States. I think it must have been overlooked. I do not think Mr. Merritt or Mr. Newton thought that they were including those two types of marks. It seems as if that could be accomplished by inserting in the amendment, after the words "all other marks not registerable under the act of February 20, 1905," the words, "except those specified in paragraphs (a) and (b) of section 5 of that act," or words to that effect.

\* The Patent Office takes this view. In *Ex parte Pillsbury Flour Mills Co.*, 23 U. S. P. Q. 168, 169, 159 M. D. 347. Assistant Commissioner Spencer said:

"Of course, at common law, even descriptive marks

that Act, but which have been in bona fide use for not less than one year in interstate or foreign commerce, or commerce with the Indian tribes by the proprietor thereof, upon or in connection with any goods of such proprietor upon which a fee of \$15 has been paid to the Commissioner of Patents and such formalities as required by the said commissioner have been complied with."

The "b" register of the 1920 Act, like the ten-year proviso, is designed to afford registration to marks actually used as trade-marks although they may be descriptive, geographical or personal names. The observations of the Chief Justice in *Thaddeus Davids Co. v. Davids*, 233 U. S. 461, 468-9, in discussing this aspect of the Act of 1905 are equally applicable to the Act of 1920. He remarked that to accept the defendant's argument that registration, although authorized, was ineffective was to say "that registration was expressly permitted but that protection to the registrant was denied," and that this would render the law meaningless by stripping it of practical effect; that "It was not the intention of Congress thus to provide for a barren notice of an ineffectual claim, but to confer definite rights."

Petitioner says that descriptive terms and the like even when used as trade-marks for a year are excluded from registration under the Act of 1920. This contention, it seems to us, ignores and if sustained, would frustrate the purpose of the statute and render it not only useless but mean-

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which had acquired a secondary meaning were awarded recognition and, since the trade-mark statutes are patterned after the common law, both the Act of 1905 and the Act of 1920 permit the registration of certain descriptive terms. The first of these Acts provides for the registration of descriptive terms that had been in exclusive use more than ten years prior to the passage of the Act and the second provides for the registration of descriptive terms that have been in exclusive use for a period of one year prior to the date of application for registration."



ingless. Such a construction would exclude from the register all of the marks excluded by the Act of 1905 and leave nothing to the statute. (See *Thaddæus Davids v. Davids*, 233 U. S. 461, 467.)

Congress evidently intended, by including the jurisdictional provisions in the 1920 Act, to "confer a definite right" to bring in the Federal Court suits concerning marks registered under that Act. If this right was not conferred, the provision means nothing. The jurisdictional provisions and the remedies in the Acts of 1905 and 1920 are identical. Indeed Sec. 6 of the Act of 1920 incorporates these sections of the Act of 1905 by reference (U. S. C. Tit. 15, Sec. 126).

The Nu-Enamel mark now before the Court is not only registered under the 1920 Act, but meets all the tests prescribed by the statute and imposed in Patent Office practice. The record shows that it is susceptible of trade-mark use; that it has actually been so used; is regarded even by Petitioner as a trade-mark; (R. 76) and that the trade-mark significance of the word Nu-Enamel as an identification of Respondents and Respondents' goods is fully recognized by the public (R. 134-136). These being the facts, the mark was clearly registrable under the 1920 Act. Being so registered, it is entitled to all the protection afforded by that Act, including, of course, the right of access to the Federal Courts in cases involving it.

Both the 1905 Act and the 1920 Act provide for the registration of trade-marks used in commerce with foreign nations among the several states and with the Indian tribes. They give the Federal Courts jurisdiction of cases concerning trade-marks registered thereunder. The intent no doubt was that marks used in commerce which is within the sole control of the Federal Government are a proper subject matter for Federal regulation and that cases respecting

them are appropriate ones for the Federal Courts to adjudicate.

The only prerequisite for Federal jurisdiction under either Act is registration, and the District Courts have recognized their authority to act on that ground alone. In *Recamier v. Harriet Hubbard Ayer, Inc.*, (D. C. N. Y.) 59 Fed. (2d) 802, Judge Patterson said (806):

"There being no diversity, jurisdiction rests solely upon section 17 of the Trade-Mark Act (15 U. S. C. A. Sec. 97), by virtue of which the district court may hear cases involving trade-marks which are registered under the act. If there is no registry of the Ayer name as the trade-mark by the plaintiff or any of its predecessors, there is no jurisdiction.

"The defendant, however, saw fit to put in a counterclaim wherein it appears that it registered a trade-mark covering the Ayer signature. Due to the counterclaim, the case does involve a registered trade-mark covering the Ayer signature and the United States courts have jurisdiction. The merits of the conflicting claims to the Harriet Hubbard Ayer trade-mark will therefore be considered."

Section 17, to which Judge Patterson refers, is transferred into the 1920 Act.

**JURISDICTION. ONCE ATTACHING, THE COURT HAS POWER TO  
DECIDE ALL QUESTIONS INVOLVED.**

When by virtue of the registration, the Federal Courts have authority to act, they have authority to deal fully with all aspects of the case. In *Vogue Co. v. Vogue Hat Co.*, (C. C. A. 6), 12 Fed. (2d) 991, Judge Denison held (992):

"It is a familiar principle that, when the jurisdiction of a federal trial court is invoked upon the ground that the plaintiff presents a right arising under federal laws, the court thereby acquires jurisdiction of the case, and it examines and decides all questions involved, even though the federal question may be resolved against the plaintiff or may be passed without decision.

(995):

"Accordingly we conclude that since the acts which in this case constitute the claimed infringement of a registered trade-mark and the claimed unfair competition are, at least in sufficient degree, the same acts, and since it is to be assumed that the trade-mark registry was valid, the court had jurisdiction to enjoin the unfair competition, although it had decided that the registered trade-mark was not infringed \* \* \*"

As we see it, it is of no importance whether the acts complained of in this case are called trade-mark infringement or unfair competition. Their characterization is merely epithetical. The act is the same. But even if it should be held that Respondents' registration of Nu-Enamel is invalid, still the District Court had jurisdiction to restrain the use of Nu-Beauty Enamel which results in the passing off of Petitioner's goods as Respondents'.

In *Waterman Co. v. Gordon*, (C. C. A. 2) 72 Fed. (2d) 272, 273, Judge Learned Hand stated:

"Registry does not create the cause of suit; it merely gives jurisdiction to the District Court, and certain procedural advantages.

(274):

"In the case at bar it is only necessary that we should hold that the cause of suit upon the registered trademark was substantial enough to support the jurisdiction of the District Court. If it was, *Hurn v. Oursler*, *supra*, 289 U. S. 283, 53 S. Ct. 586, 77 L. Ed. 1148, rules."

The facts bring the present case, like that one, clearly within the doctrine of *Hurn v. Oursler*, 289 U. S. 238. There Mr. Justice Sutherland expressed this Court's view that (246) "where the federal question averred is not plainly wanting in substance, the federal court, even though the federal ground be not established, may nevertheless retain and dispose of the case upon the non-federal ground \* \* \*." He indicated that there, as here (246):

"the claims of infringement and unfair competition so precisely rest upon identical facts as to be little more than the equivalent of different epithets to characterize the same group of circumstances. The primary relief sought is an injunction to put an end to an essentially single wrong, however differently characterized, not to enjoin distinct wrongs constituting the basis for independent causes of action."

In any event in this case diversity of citizenship existed at the time of the trial in the District Court (R. 22-25).

There is no reason why Congress should not designate the misuse or imitation of registered marks as trademark infringement or as unfair competition. It is both or either. As Mr. Justice Sutherland indicated, it does not matter what epithet is used; the wrong is the same. It is the misuse of a name or device in such circumstances as to result in the passing off of goods.

With these considerations in mind the present case is simple. The name Nu-Enamel is registered as a trademark under the Act of 1920. Granting there is no presumption either of validity or ownership resulting from regis-

tration under this Act as under the Act of 1905, in this case the lack of presumption is supplied by the admitted fact (R. 13) that Nu-Enamel distinguishes Respondents' goods only.

If Nu-Enamel were wholly meaningless except as an identification, there would be a further presumption that its appropriation or imitation by a later comer would have a tendency to represent that his goods came from the trader whose goods it connotes. But if there is here no such presumption, the lack of it is met by the fact that the use by Petitioner of the mark Nu-Beauty Enamel was intended to represent Petitioner's goods as coming from Respondents and in fact had this result.

A proved fact is at least as good as a presumption. Moreover, infringement is a fact. The wrong in this case committed by the Petitioner against Respondents is the successful diversion to itself of the good will of Respondents' business by the intentional appropriation of a name by which that good will in fact is symbolized. As this Court observed in *International News v. Associated Press*, 248 U. S. 215, 239, 63 L. Ed. 211:

"The fault in the reasoning lies in applying as a test the right of the complainant as against the public, instead of considering the rights of complainant and defendant, competitors in business, as between themselves."

As Mr. Justice Holmes remarked in *American Waltham Watch Co. v. United States Watch Co.*, 173 Mass. 85, the question is specific and concrete.

#### PETITIONER'S INFRINGEMENT IS ESTABLISHED BY THE EVIDENCE.

The case being specific and concrete and the District Court having, as we think, jurisdiction to stop a manifest wrong which Petitioner perpetrated against Respondents,



it may be appropriate to consider the facts which impelled the Circuit Court of Appeals to hold (R. 137) that Petitioner "attempted to convert to its own use the property right which Plaintiff (Respondent) had built up represented by the trade-mark." The outline of this property right is shown, in Mr. Justice Holmes' phrase, "by the law of torts of which the right is a prophetic summary."

The evidence of Petitioner's bad motive is overwhelming and this in itself is almost conclusive on the issue of infringement. Petitioner knew of Respondent's trade-mark before adopting Nu-Beauty Enamel as a name for its goods designed to compete with Respondents'. Petitioner deliberately went out to "get its share of that business created by the demand for Nu-Enamel" (R. 66). It employed a man, formerly with Respondents, to "put the proposition over" (R. 64). Petitioner copied Respondents' advertising, solicited their customers (R. 65), and established retail outlets as near to Respondents' as it could (R. 65).

Petitioner's advertising manager, Milton C. Fisher, stated (R. 74) that in 1933 Petitioner put out a product called "Nu-Beauty Furniture Cream"; that in August, 1934, it brought out "Nu-Beauty Enamel"; and that the other items of the line under the name "Nu-Beauty" were later; and (R. 75): "Prior to 1934, when we adopted the name Nu-Beauty Enamel, our company had been putting out enamels and varnishes under some other trade-mark. . . . The product which we put out in 1934, was not a new product; we didn't at that time add enamels and varnishes to our line of products, we had been putting those out previously." Again, "I had heard of Nu-Enamel before I suggested the name Nu-Beauty for this furniture polish and for this line of products" (R. 74). Speaking of "Nu-Enamel", the witness said (R. 73): "It is a well known product. I have seen it on sale in stores, in and about Chi-

cago, by the name of Nu-Enamel." Again (R. 76): "When we adopted Nu-Beauty for cream, furniture cream, and enamel and varnish, I was familiar or was aware of the trade-mark Nu-Enamel."

So we have the fact, admitted by the Petitioner's advertising manager, that when Petitioner adopted the name Nu-Beauty Enamel, it knew of the Respondents' trade-mark Nu-Enamel and that the Respondents' goods were well known, and, as this witness said (R. 73):

"I am familiar with a product sold under the trade-mark Nu-Enamel. It is a well known product. I have seen it on sale in stores, in and about Chicago, by the name of Nu-Enamel. I have known of Nu-Enamel since 1932 or 1933, I have no definite way of fixing it in my mind."

But Petitioner was not content merely with adopting a name for a competing line which it knew was a well known designation of a competitor's goods. Not satisfied with this, which makes the Petitioner's intent plain enough, it hired W. J. Nelson, who had been an employee as district manager in the east of Nu-Enamel Company of New York, an affiliated company of the Respondents. This employment began on June 1, 1935 (R. 91). Mr. Van Antwerp, his immediate superior, speaking of Mr. Nelson, said (R. 92):

"He engaged new distributors, new outlets for us. I don't know how I would qualify many and few. I would say that he did a very good job. . . . He did a good job of engaging new accounts. He never managed the department. I wouldn't credit the growth of the department to his salesmanship."

Nelson testified (R. 64):

"I was hired to devote all of my time and effort to the promotion, development and sale of New-Beauty Enamel. At the time he (Van Antwerp) employed me he told me he was not quite ready to start it at that time, that he had some changes he was making and some things were not in quite the shape to proceed,

and we set the date for June 3rd to start my employment.

"I was told that they were not capable of instructing me, with the experience I had in developing Nu-Enamel, but told me they were going to look to me for suggestions and instructions. They told me I would have to use my own initiative and they were depending on me to put this proposition over in the same manner Nu-Enamel had been put over. I was told that they had no definite policy outlined, and that Nu-Enamel had done an outstanding job in that specialty field, and that I knew more about that than they did, that I should use my own judgment, develop it and put it over on the same basis if necessary." (Interpolation ours.)

Nelson turned over Nu-Enamel sales material to Petitioner. He proceeded to develop the department on the same lines used by Respondents. He solicited and engaged new distributors, which were most always in the vicinity of a Nu-Enamel store or Nu-Enamel dealer (R. 65). The Nu-Enamel advertising matter was copied and adapted. Nelson testified (R. 65): "I mentioned to Mr. Fisher, the advertising manager, the similarity of these two, the design on those two color cards. I said 'That is copy of the Nu-Enamel girl.' He said 'We just straightened her up a little bit and gave her the sign to hold.'" Indeed, Petitioner's establishment was so permeated with Nu-Enamel ideas that (R. 66):

"Mr. Sappington (Petitioner's assistant sales manager) said several times that Nu-Enamel had made the public enamel conscious, and that we were going out to get their share of that business created by the demand for Nu-Enamel. It was the custom in and around the offices of the Armstrong Paint & Varnish works in referring to New-Beauty Enamel to call it Nu-Enamel as often as it was called New-Beauty Enamel. It was general unless one was specific in his conversation to distinguish between the two." (Interpolation ours.)

Also, the prices of Nu-Enamel, which were unusual, were adopted by Petitioner (R. 65). The witness carried around

in calling on the trade his identification credential from the Nu-Enamel Corporation which the Petitioner's officers knew and did not object to (R. 67). Every step was taken with Nu-Enamel in view, and (R. 69), "They compared it to Nu-Enamel, Nu-Enamel was used as the standard of comparison of all enamels in the Armstrong laboratory."

When the suit was brought, Mr. Nelson testified (R. 66):

"Mr. Goldsmith (Petitioner's president) told me, as well as Mr. Van Antwerp (vice president and sales manager) and Mr. Sappington (assistant sales manager), that we had to soft pedal these New-Beauty merchandising ideas until this suit was over, and that Mr. Goldsmith hesitated to go ahead with the proposition. They called Mr. Armstrong the skipper. They said the skipper was very much worried about it. They told me to tone down in carrying on the New-Beauty establishment of dealers and distributors and asked me to go into the full line, sell the full line of Armstrong products under other brand names. At one time Mr. Van Antwerp said 'I don't want this copying of Nu-Enamel ideas too evident.'" (Interpolation ours.)

It may be said in passing that none of these statements was denied. Mr. Goldsmith, Petitioner's president, Mr. Van Antwerp, its vice president and sales manager, and Mr. Sappington, assistant sales manager, testified, and did not deny any of them. Indeed, they spoke rather well of Mr. Nelson. Mr. Van Antwerp said (R. 92) that he did a "good job."

So we have this situation. Nu-Enamel was a well known product under a well known name and was well known to Petitioner who, as its advertising manager put it, was "going out to get their share of that business created by the demand for Nu-Enamel" (R. 66). It is perfectly obvious that Petitioner's copying was not only of sales methods but of Respondents' identifying name, its advertising schemes, its color cards, and everything else. In short, there was a conscious effort to appropriate every-

ag distinctive of Respondents' business so that Petitioner's purpose to appropriate the Nu-Enamel good will might be successfully carried out. There are definite legal implications from the intent which, in this case, so clearly appears from the evidence.

In *Enoch Morgan's Sons Co. v. Ward* (C. C. A. 7) 152 Fed. 690, 693, Judge Baker said:

"Of course, an actual infringer is answerable, irrespective of his intent; but there is a view in which intent has a bearing on the fact of infringement. Appellee's intent to profit by appellant's marks is quite apparent, we think, even when each of his acts is regarded separately; when taken together, his acts are unmistakable, just as the plea of ignorance on the part of one who passes counterfeit money becomes untenable in the face of successive instances. If appellee had desired to build up an honest independent trade in his product, he would have selected, as did appellant's fair-minded competitor's, marks as distinct from appellant's as possible. Appellee's purpose being established, from it his opinion as an expert may be accepted that the steps he took were well adapted to injure the appellant company in its property rights."

The Circuit Court of Appeals of the Second Circuit has recently taken the same view (*My-T Fine Corporation v. Muels, et al.*, (C. C. A. 2) 69 Fed. (2d) 76, 77), Judge Learned Hand stating:

"We need not say whether that intent is always a necessary element in such causes of suit; probably it originally was in federal courts. *McLean v. Fleming*, 96 U. S. 245, 24 L. Ed. 828; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 138 U. S. 537, 11 S. Ct. 396, 34 L. Ed. 997; *Elgin National Watch Co. v. Illinois Watch Case Co.*, 179 U. S. 665, 21 S. Ct. 270, 45 L. Ed. 365. But when it appears, we think that it has an important procedural result; a late comer who deliberately copies the dress of his competitors already in the field, must at least prove that his effort has been futile. *Prima facie* the court will treat his opinion so disclosed as expert and will not assume that it was erroneous. *Fairbank Co. v. R. W. Bell Mfg. Co.*, 77 F. 869, 877 (C. C.



A. 2); *Capewell Horse Nail Co. v. Green*, 188 F. 20, 24 (C. C. A. 2); *Wolfe Bros. & Co. v. Hamilton*, 165 F. 413, 416 (C. C. A. 8); *Thum Co. v. Dickinson*, 245 F. 609, 621, 622 (C. C. A. 6); *Wesson v. Galef*, (D. C.) 286 F. 621, 626."

In *Wesson v. Galef*, 286 Fed. 621, 625, the same judge said:

"The defendants argue that revolvers are expensive articles, and that men buy them only after examination. That is undoubtedly true in many instances, and it is never the hope of simulators to do more than catch the unwary. Since I am satisfied that the makers of these revolvers tried to do so, I do not see that I need weigh too nicely the probabilities of their success. We are accustomed to speak of a deliberate imitation of this sort as a fraud, and indeed the earlier cases thought fraud an essential of the case. Whatever other legal result fraud may have, at least it relieves the injured party from the need of showing that the imitator was successful. He may take him at his own belief, and assume that, if he thought some buyers would be careless enough not to notice the distinguishing marks, he was right."

In *Capewell Horse Nail Co. v. Green*, (C. C. A. 2) 188 Fed. 20, 24, Judge Lacombe said:

"If it is apparent that he is undertaking closely to approach to a well-known mark, it is generally a pretty safe assumption that he thinks the differences are not sufficiently great to prevent confusion."

In view of this, we might well have dispensed with proof of the fact that there had been passing off of Petitioner's goods for the Respondents'. But in this case there is testimony of actual deception (R. 43). Dr. Teschan of Milwaukee (R. 43) had heard of Nu-Enamel. He wanted to refinish his office furniture. He bought a can of paint thinking it was Nu-Enamel at Gimbel's in Milwaukee and painted his furniture with it. A friend came in to see the completed job. Dr. Teschan said he had refinished his

urniture with Nu-Enamel. The friend "spotted the can and said, 'Why this is not Nu-Enamel, it is New-Beauty Enamel.'" Dr. Teschan had seen the Nu-Enamel displays and saw the New-Beauty Enamel display at Gimbel's and supposed that what was being displayed was Nu-Enamel. He said (R. 44):

"The display and demonstration was similar to that I had seen in the Nu-Enamel store."

And again,

"I had seen this type of can. I was not cognizant of the color at the time. I had paid attention to the Nu-Enamel name only."

Being a scientific man, he attempted to analyze his own impressions, saying (R. 45):

"When I was using this can of New-Beauty Enamel I did not notice the name New-Beauty Enamel. I thought that I had bought Nu-Enamel probably because of an unconscious auditory recording of the term 'Nu'. In Gimbel's I saw the word 'New-Beauty' displayed in and about that counter. I understood that the products that were being displayed there were the same products that I had seen displayed in the Nu-Enamel store."

Earl Seifert, the friend who visited Dr. Teschan, corroborated this testimony. Here is a clear case of deception from the use of the name "New Beauty Enamel" without any contributory passing off on the part of the dealer.

Mr. Nelson testified that during his sales efforts for the Petitioner (R. 65):

"I have been in the stores of dealers handling New-Beauty Enamel when customers came in and asked for Nu-Enamel. Dealers would sell Nu-Beauty Enamel on calls for Nu-Enamel. I saw that myself. I saw dealers in stores handling New-Beauty Enamel sell New-Beauty Enamel on calls for Nu-Enamel. I saw that, I would say by most of the dealers I called back on during the promotion of the business. The dealers that I saw do this were the Walker Company in Oak

Park; Riverside Electric in Riverside; the Latsis Drug Store in Oak Park. I don't remember all of the various dealers. McBreen Electric particularly, Home Appliance; Anderson Company Hardware in Sycamore; and Mochel Hardware Company in Downers Grove, who was formerly a Nu-Enamel dealer. When customers came in and asked for Nu-Enamel, they sold New Beauty Enamel."

But there is much additional testimony in the record (R. 47-62). Forty-four instances of passing off Petitioner's product for Respondents' at twenty-seven stores on fifty-one calls were proved. The witnesses testified that they asked distinctly for Nu-Enamel. Of the twenty-seven stores visited, one substituted Nu-Beauty Enamel on calls for Nu-Enamel five times to different shoppers; two stores passed off three times; and nine stores passed off twice. The remaining fifteen stores each passed off once. In every instance the passing off was of Petitioner's product, some labeled Nu-Beauty Enamel, some New Beauty Enamel.

Petitioner, by furnishing to dealers the instrument of fraud, is responsible for the use that is made of it. *Federal Trade Commission v. Winsted Hosiery Company*, 258 U. S. 483, where Mr. Justice Brandeis said (494):

"That a person is a wrongdoer who so furnishes another with the means of consummating a fraud has long been a part of the law of unfair competition."

#### CONCLUSION.

Petitioner asserts that, after this suit was brought, it stopped using the name Nu-Beauty Enamel and now is designating as New Beauty Enamel only one article which, Petitioner says, is enamel. It may be pointed out that Petitioner's use of Nu-Beauty Enamel or New Beauty Enamel is not as a description but as a name. This court has clearly indicated the distinction in *Baglin v. Cusenier*, 221 U. S. 580, 601. Respondents do not claim that Petitioner may not sell enamel and so describe it. The deception in this case does not arise from the use of the word

enamel as a description but results from the unnecessary and misleading juxtaposition of the syllable Nu or New and the word Enamel—at the top of the label as a name or designation for Petitioner's goods. As the court said in *Davidson v. Davidson*, 233 U. S. 461, 471:

"The distinction between permissible and prohibited uses may be a difficult one to draw in particular cases, but it must be drawn in order to give effect to the act of Congress. That the distinction may readily be observed in practice is apparent. In this case, for instance, if the defendants had so chosen, they could have adopted a distinct mark of their own, which would have served to designate their inks and completely to distinguish them from those of the complainant. It was not necessary that, in exercising the right to use their own name in trade, they should imitate the mark which the complainant used, and was entitled to use under the statute, as a designation of its wares; or that they should use the name in question upon their labels without unmistakably differentiating their goods from those which the complainant manufactured and sold."

It is implicit in Petitioner's argument that it claims the right to sell its goods as Nu-Enamel. Petitioner suggests that there is some rule of law which permits it to apply to goods not coming from Respondents a name which Petitioner admits identifies Respondents' products only. In short that Petitioner has discovered a variety of fraud that equity cannot reach.

In view of Petitioner's past conduct, if it should succeed in this action and it should be held that it may appropriate Respondents' trade-mark with impunity, Petitioner's piracy would no doubt be resumed and extended. This is not a baseless fear. Petitioner's president admonished its sales-manager Nelson (R. 66):

"Mr. Goldsmith told me . . . that we had to soft pedal these New Beauty merchandising ideas until this suit was over . . . At one time Mr. Van

Antwerp (petitioner's vice-president) said, 'I don't want this copying of Nu-Enamel ideas too evident.'"

Respectfully submitted,

EDWARD S. ROGERS,

*For Respondents.*

WILLIAM T. WOODSON,

JAMES H. ROGERS,

*Of Counsel.*



## APPENDIX.

## ACT OF MARCH 19, 1920.

ACT TO GIVE EFFECT TO CERTAIN PROVISIONS OF THE CONVENTION FOR THE PROTECTION OF TRADE-MARKS AND COMMERCIAL NAMES, MADE AND SIGNED IN THE CITY OF BUENOS AIRES, IN THE ARGENTINE REPUBLIC, AUGUST 20, 1910, AND FOR OTHER PURPOSES.

*Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,*

That the Commissioner of Patents shall keep a register of (a) all marks communicated to him by the international bureaus provided for by the convention for the protection of trade-marks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, in connection with which the fee of \$50 gold for the international registration established by article 2 of that convention has been paid, which register shall show a facsimile of the mark; the name and residence of the registrant; the number, date, and place of the first registration of the mark, including the date on which application for such registration was filed and the term of such registration, a list of goods to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark.

(b) All other marks not registerable under the Act of February 20, 1905, as amended, except those specified in paragraphs (a) and (b) of section 5 of that Act,

(a) Consists of or comprises immoral or scandalous matter.

Act of February  
20, 1905.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of

Act of February  
20, 1908.

any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: *Provided*, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant:

but which have been in bona fide use for not less than one year in interstate or foreign commerce, or commerce with the Indian tribes by the proprietor thereof, upon or in connection with any goods of such proprietor upon which a fee of \$15 has been paid to the Commissioner of Patents and such formalities as required by the said commissioner have been complied with: *Provided*, That trade-marks which are identical with a known trade-mark owned and used in interstate and foreign commerce, or commerce with the Indian tribes by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, shall not be placed on this register.

SEC. 2. That whenever any person shall deem himself injured by the inclusion of a trade-mark on this register, he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question, and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the exclusive use of the mark at or since the date of his application for registration thereof, or that the mark is not used by the registrants or has been abandoned, and the examiner shall so decide, the commis-

sioner shall cancel the registration. Appeal may be taken to the commissioner in person from the decision of the examiner in charge of interferences.

SEC. 3. That any person who shall willfully and with intent to deceive, affix, apply, or annex, or use in connection with any article or articles of merchandise, or any container or containers of the same, a false designation of origin, including words or other symbols, tending to falsely identify the origin of the merchandise, and shall then cause such merchandise to enter into interstate or foreign commerce, and any person who shall knowingly cause or procure the same to be transported in interstate or foreign commerce or commerce with Indian tribes, or shall knowingly deliver the same to any carrier to be so transported, shall be liable to an action at law for damages and to an action in equity for an injunction, at the suit of any person, firm, or corporation doing business in the locality falsely indicated as that of origin; or in the region in which said locality is situated, or at the suit of any association of such persons, firms, or corporations.

SEC. 4. That any person who shall without the consent of the owner thereof reproduce, counterfeit, copy, or colorably imitate any trade-mark on the register provided by this Act, and shall affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff the

court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

SEC. 5. That it shall be the duty of a registrant under this Act of a mark falling within class (a) of section 1, to comply with the law of the country in which his original registration took place, in respect to giving notice to the public that the trade-mark is registered, in connection with the use of such trade-mark in the United States of America, and in any suit for infringement by a party failing to do this, no damages shall be recovered except on proof that the defendant was duly notified of the infringement and continued the same after such notice.

SEC. 6. That the provisions of sections 15, 17, 18, 19, 20, 21, 22, 23, 25, 26, 27, and 28 (as to class (b) marks only) of the Act approved February 20, 1905, entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States, or with Indian tribes, and to protect the same," as amended to date,

SEC. 15. U. S. C., title 15, sec. 95. That section forty-nine hundred and thirty-five and forty-nine hundred and thirty-six of the Revised Statutes, relating to the payment of patent fees and to the repayment of fees paid by mistake, are hereby made applicable to trade-mark fees.

SEC. 17. U. S. C., title 15, sec. 97. That the district and territorial courts of the United States and the supreme court of the District of Columbia shall have original jurisdiction; and the circuit courts of appeals of the United States and the court of appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this act arising under the present act, without regard to the amount in controversy.



SEC. 18. U. S. C., title 15, sec. 98. That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this act in the same manner as provided for patent cases by the act creating the circuit court of appeals.

Act of Feb.  
20, 1905.

SEC. 19. U. S. C., title 15, sec. 99. That the several courts vested with jurisdiction of cases arising under the present act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under this act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed.

Act of Feb.  
20, 1905.

SEC. 20. U. S. C., title 15, sec. 100. That in any case involving the right to a trade-mark registered in accordance with the provisions of this act, in which the verdict has been found for the plaintiff, or an injunction issued, the court may order that all labels, signs, prints, packages, wrappers, or receptacles in the possession of the defendant, bearing the trade-mark of the plaintiff or complainant, or any reproduction, counterfeit, copy, or colorable imitation thereof, shall be delivered up and destroyed. Any injunction that may be granted upon hearing, after notice to the defendant, to prevent the violation of any right of the owner of a trade-mark registered in accordance with the provisions of this act, by any circuit court of the United States, or by a judge thereof, may be served on the parties against whom such injunction may be granted anywhere in the United States where they may be found, and shall be operative, and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other

Act of Feb.  
20, 1905.



circuit court, or judge thereof, in the United States, or by the Supreme Court of the District of Columbia, or a judge thereof. The said courts, or judges thereof, shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had been granted by the circuit court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office.

SEC. 21. U. S. C., title 15, sec. 101. That no action or suit shall be maintained under the provisions of this act in any case when the trade-mark is used in unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained.

SEC. 22. U. S. C., title 15, sec. 102. That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation.

SEC. 23. U. S. C., title 15, sec. 103. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.

SEC. 25. U. S. C., title 15, sec. 104. That any person who shall procure registration of a trade-mark, or entry thereof, in the office of the Commissioner of Patents by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered by an action on the case.

SEC. 26. U. S. C., title 15, sec. 105. That the Commissioner of Patents is authorized to make rules and regulations, not inconsistent with law, for the conduct of proceedings in reference to the registration of trade-marks provided for by this act.

Act of February  
20, 1906.

SEC. 27. U. S. C., title 15, sec. 106. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of this act or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States; and, in order to aid the officers of the customs, in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration or agreement between the United States and any foreign country, to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark, and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

Act of February  
20, 1906.

SEC. 28. U. S. C., title 15, sec. 107. That it shall be the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or

abbreviated thus, "Reg. U. S. Pat. Off.," or when, from the character or size of the trade-mark, or from its manner of attachment to the article to which it is appropriated, this cannot be done, then by affixing a label containing a like notice to the package or receptacle wherein the article, or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement and continued the same after such notice.

and the provisions of section 2 of the Act entitled "An Act to amend the laws of the United States relating to the registration of trade-marks," approved May 4, 1906, are hereby made applicable to marks placed on the register provided for by section 1 of this Act.

SEC. 2. That the Commissioner of Patents shall establish classes of merchandise for the purpose of trade-mark registration, and shall determine the particular descriptions of goods comprised in each class. On a single application for registration of a trade-mark the trade-mark may be registered at the option of the applicant for any or all goods upon which the mark has actually been used comprised in a single class of merchandise, provided the particular descriptions of goods be stated.

SEC. 7. That written or printed copies of any records, books, papers, or drawings belonging to the Patent Office and relating to trade-marks placed on the register provided for by this Act, when authenticated by the seal of the Patent Office and certified by the commissioner thereof, shall be evidence in all cases wherein the originals could be evidence, and any person making application therefor and paying the fee required by law shall have certified copies thereof.

SEC. 8. That the same fees shall be required for certified and uncertified copies of papers and for records, transfers, and other papers, under this Act, as are required by law for

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in filing an appeal under this Act to the Commissioner  
of Patents from the decision of the examiner in charge of  
interferences, awarding ownership of a trade-mark, can-  
celing or refusing to cancel the registration of a trade-mark,  
a fee of \$15 shall be payable.

(277 O. G. 181)

Department of the Interior,  
Office of the Solicitor,  
Washington, D. C.,  
July 13, 1920.

*The honorable the Secretary of the Interior,*

DEAR MR. SECRETARY:

By letter of June 17, 1920, the Commissioner of Patents requested my opinion respecting certain questions arising under the recent act of March 19, 1920, (Public No. 163), entitled "An Act to Give Effect to Certain Provisions of the Convention for the Protection of Trade-Marks and Commercial Names, Made and Signed in the City of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other Purposes."

Section 1 of said act provides:

"That the Commissioner of Patents shall keep a register of (a) all marks communicated to him by the international bureaus provided for by the Convention for the Protection of Trade-Marks and Commercial Names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, in connection with which the fee of \$50 gold for the international registration established by article 2 of that convention has been paid, which register shall show a facsimile of the mark; the name and residence of the registrant; the number, date, and place of the first registration of the mark, including the date on which application for such registration was filed and the term of such registration, a list of goods to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark.

(b) All other marks not registrable under the Act of February 20, 1905, as amended, except those specified in paragraphs (a) and (b) of section 5 of that act, but which have been in bona fide use for not less than one year in interstate or foreign commerce, or commerce with the Indian tribes by the proprietor thereof,



upon or in connection with any goods of such proprietor upon which a fee of \$10 has been paid to the Commissioner of Patents and such formalities as required by the said Commissioner have been complied with: *Provided*, That trade-marks which are identical with a known trade-mark owned and used in interstate and foreign commerce, or commerce with the Indian tribes by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, shall not be placed on this register.

The questions asked are, in effect, as follows:

(1) Whether marks registerable under the act of February 20, 1905, can be registered under section (b) of the act of March 19, 1920?

(2) What is the scope or limitation of paragraph (b) of section 5 of the act of February 20, 1905, (33 Rev. Stat., 724), as amended, when considered in connection with the interpretation of the recent act?

(3) Whether the filing fee of ten dollars paid in connection with an application under the act of February 20, 1905, may be transferred to an application for registration under the act of March 19, 1920, or must a new fee be required?

(4) Must a trade-mark be "identical" with a known trade-mark to be subject to rejection, or need it be only so nearly similar to a registered or known trade-mark to justify rejection?

Section 5 of the said act of February 20, 1905, has been amended by the following acts: March 2, 1907, (34 Rev. Stat., 1251); February 18, 1911, (36 Rev. Stat., 918); January 8, 1913, (37 Rev. Stat., 649), and section 9 of the recent act, now under consideration.

My answer to the first question is in the negative, as no reason has been called to my attention, and I see none, for

ignoring the express provision of this law that the (b) register shall be kept for—

all other marks not registerable under the act of February 20, 1905, as amended, except those specified in paragraphs (a) and (b) of section 5 of that act, etc.

The doubt pertaining to the second question is expressed by the Commissioner, as follows:

Paragraph (b) after referring to State, national or society insignia goes on to specify what marks shall not be registered as well as some that may be registered. Hence the act is not clear as to what is referred to in paragraph (b).

In my opinion the recent act of March 19, 1920, as applied to register (b) therein provided should be construed as if it more specifically read as follows:

All other marks not registerable under the act of February 20, 1905, as amended, except those specified as *not registerable* in paragraphs or schedules (a) and (b) of section 5 of that act, etc.

This is the plain meaning of the law, as it was undoubtedly the intention to continue to deny registration to those marks prohibited registration by paragraphs or schedules (a) and (b) of section 5 of the act of February 20, 1905. In other words, my view is that register (b) provided by the recent act is not intended for any trade-mark registerable under any part of the act of February 20, 1905, nor for registration of any mark not registerable as specified in paragraphs or schedules (a) and (b) of section 5 of that act. The doubt will be relieved and a rational construction of the law will be subserved by considering the reference in the recent act to "paragraphs (a) and (b)" of section 5 of the amended act of February 20, 1905, as meaning *schedules a and b* rather than paragraphs strictly and as comprising the following matters specified as *not registerable*, viz.:

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag or coat-of-arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: *Provided*, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant.

his was the evident intention, as shown by the congressional hearings on the recent act, and with such construction a field will exist for the operation of the new law; otherwise none would remain.

Replying to question 3, I can see no objection to applying the fee paid in connection with an application under the law to an application under the new law. The amount of the fee is the same in either case, and it would seem it should be applied in perfecting the registration even though the applicable law be other than that originally invoked. It would be deemed necessary to amend the application, that would be merely a detail of procedure.

The fourth question arises from the language of the proviso to section 1 of the recent act above quoted. The word "identical" in its strictest sense means "exactly alike" or "the same in all respects." It is apparent that the word should not properly be used in this sense as applied in two different objects, because it is axiomatic that no two things are exactly alike; but the word is sometimes used more loosely to mean very similar or the same in essential characteristics. I have no doubt that it is to be so understood in this case. The language of the said proviso would per-

have justify the conclusion that a comparative term, as "so nearly," was intended to accompany the positive term "identical," so as to harmonize with the further expression "as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers." This view is strongly supported by a similar provision contained in the act of 1905, which prohibits registration of names identical or which so nearly resemble a registered or known trade-mark as to be likely to cause confusion, etc.

Cordially yours,

CHARLES D. MAHAFFIE,  
/ Solicitor.





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IN THE  
Supreme Court of the United States

OCTOBER TERM, A. D. 1938.

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No. 51

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ARMSTRONG PAINT AND VARNISH WORKS,  
*Petitioner,*  
*vs.*

ENAMEL CORPORATION, an Illinois Corporation,  
*and*

ENAMEL CORPORATION, a Delaware Corporation,  
*Intervener,*  
*Respondents.*

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PETITIONER'S PETITION FOR REHEARING AND  
MOTION FOR STAY OF MANDATE.

---

to the Honorable The Chief Justice and to the Associate  
Justices of the Supreme Court of the United States:

Now comes the petitioner above named and respectfully  
presents this, its petition for a rehearing of the above en-  
d cause, in which an opinion was rendered on De-

ember 5, 1938, affirming the judgment of the Circuit Court of Appeals for the Seventh Circuit.

We are filing this petition for re-hearing, of course, in the interests of our client, but we feel that we also owe an obligation to the Court to call its attention to the matters contained in its opinion herein, which we believe may result in confusion on the law of trade-marks and therefore require clarification and revision.

Bearing in mind that the Court is here concerned with domestic rights to an alleged trade-mark registered under the Trade-Mark Act of 1920, and not with a foreign infringement, we respectfully submit that the opinion of the Court contains the following contradictory and irreconcilable findings and conclusions:

1. The Court holds with petitioner that the effect of registration of "Nu-Enamel" under the 1920 Trade-Mark Act on domestic rights is nil (p. 11), and that such registration did not create any substantial rights in the registrant (p. 3).

Yet the Court has apparently decided that by registering "Nu-Enamel" under the 1920 Act, respondent acquired the substantial and domestic right to protection of the mark under the Act by injunction and triple damages.

2. The Court holds with petitioner that "Nu-Enamel" is descriptive of the enamels in issue (p. 11), and that a mark which is descriptive is not a good trade-mark at common law (p. 12).

Yet the Court has apparently decided, contrary to the previous decisions of this Court, that "Nu-Enamel" is a technical trade-mark, for the alleged infringement of which respondent may sue and obtain redress under the Trade-Mark Laws of the United States.

3. The Court holds that the 1905 Trade-Mark Act alone affects domestic rights.

Yet the Court's apparent decision has made unnecessary the 1905 Trade-Mark Act as far as domestic rights are concerned, by nullifying its effect. Under the Court's decision, anything may now be registered under the 1920 Trade-Mark Act (after one year's use) and domestic rights thereunder asserted in the Federal Courts, either directly under the Act, or, by the mere allegation of registration under this "ineffective" act, sue for unfair competition.

4. The Court holds with the petitioner that

"Nu-Enamel" is descriptive of a type of paint long familiar to manufacturers" (p. 7).

Yet the Court, without distinguishing its previous decisions to the contrary,\* has decided that, in spite of its common use in the paint industry before respondent commenced business, "Nu-Enamel" can become the exclusive private property of respondent.

5. The Court holds that (p. 12):

"The rights of Nu-Enamel Corporation to be free of the competitive use of 'Nu-Enamel' may be vindicated, also, through the challenge of unfair competition, as set out in the bill."

Yet the opinion fails to point out where in the bill is unfair competition alleged.

# I.

With reference to the effect of registration under the 1920 Trade-Mark Act on the domestic rights of the registrant, we quote the following from the Court's opinion therein:

"This enables the (b) marks to be registered abroad." (p. 4)

"The Committee on Patents in the Senate was quite positive that the effect of the act on domestic rights was nil." (p. 11)

"The legislation has no effect on the domestic rights of anyone. It is simply for the purpose of enabling manufacturers to register their trade-marks in this country for the purpose of complying with legislation in foreign countries, which necessitates registration in the United States as a necessary preliminary for such foreign registration." (p. 11, note 21)

"The registration of 'Nu-Enamel' does not create any substantial rights in the registrant." (p. 3)

The Court is concerned here only with an alleged *domestic* infringement. *Domestic* rights only being involved, there can, therefore, we submit, be no basis whatsoever for a suit grounded on the 1920 Act, *even if a valid trade-mark were involved herein*. The decision herein, however, contrary to the above quotations from the opinion, holds that, by registering "Nu-Enamel" under the 1920 Act, the respondent thereby acquired the *domestic* right to sue thereunder for an alleged domestic infringement, and the *substantial* right to recover under said act triple damages for such alleged domestic infringement. The property right to an incorporeal thing like a trade name or a trade-mark consists only in the right to exclude others from using it. In giving that right to respondent under the 1920 Act, the Court has contradicted its holding above that "the registration of Nu-Enamel does not create any substantial rights in the registrant."

We submit that in this respect the decision is also in conflict with this Court's recent decision and opinion in *Kellogg Co. v. National Biscuit* (decided November 14, 1938) and the decision of the Circuit Court of Appeals for the 2nd Circuit, in *Rouss v. Winchester*, 300 F. 706



(certiorari denied 266 U. S. 607). The Court's decision apparently nullifies and makes unnecessary the Trade-Mark Act of 1905, which alone was enacted for the protection of domestic trade-marks, and registration under which Act alone confers domestic rights on the registrant.

In view of the recognition by the Court in its opinion herein, and in the *Kellogg* case, that the 1920 Act was enacted solely for the purpose of foreign registration, that "on rights it is as though there had been no registration" (p. 3, note 2), and that *domestic* rights are therefore in no way affected, we do not believe that this Court intends to hold (as it apparently holds) that the registration of "Nu-Enamel" under the 1920 Act gave to respondent, the registrant thereof, the *domestic* right to sue under said Act for an alleged domestic infringement, and to assert under said act the *substantial* right to triple damages.

May we again call the court's attention to the fact that, as was the fact in *Kellogg Co. v. National Biscuit Co.* (p. 4), the respondent herein had attempted to acquire these domestic rights by registration under the 1905 Trade-Mark Act, and, as in the *Kellogg* case, registration was rejected because the mark ("Nu-Enamel") was descriptive of the product (Petitioner's brief, p. 5, R. 32).

## II.

The Court in its opinion says (p. 4):

"Unless plainly unsubstantial, the allegation of registration under the act is sufficient to give jurisdiction of the merits."

We respectfully submit that the court's holding that (p. 5):

"Registration of 'Nu-Enamel' furnished a substantial ground for federal jurisdiction,"

is inconsistent with and contradicts the Court's decision

that registration under the 1920 Act is "as though there had been no registration" (p. 3, note 2) and with its holding that "the effect of the Act on domestic rights was nil." (p. 11) What is a *nullity* is obviously wanting in substance—for it has no substance. We respectfully submit, that the allegation of registration under the 1920 act, is, in so far as concerns the *domestic rights* herein involved, "plainly unsubstantial" and insufficient to give a federal court jurisdiction in the absence of diversity of citizenship.

### III.

The Court in its opinion says (p. 11):

"The registrant acquires by the acceptance of his mark under the 1920 act the right to proceed in the Federal courts against infringers and to recover triple damages if he can establish his ownership of the trade-mark at common law.

'Nu-Enamel' is descriptive of the enamels in issue  
\* \* \* (p. 12)

"But a mark which is descriptive is not a good trade-mark at common law." (Italics ours.)

Among others, the Court cites as authority for the above, *Elgin v. Illinois Watch Co.*, 179 U. S. 665. As does the case at bar, so did the *Elgin* case involve the question of secondary meaning, in that case of the geographic word "Elgin". This Court in the *Elgin* case held that, while secondary meaning may afford protection against unfair competition because it is a trade-name, "*this geographical name could not be employed as a trade-mark and its exclusive use vested in appellant.*" (*Elgin v. Illinois Watch Co.*; 179 U. S. 665, 667, Petitioner's brief p. 18.)

In *Warner v. Lilly Co.*, 265 U. S. 526, 528, also cited by

this Court in its opinion herein (p. 12, note 22), this Court held:

"A name which is merely descriptive of the ingredients, qualities or characteristics of an article of trade cannot be appropriated as a trade-mark and the exclusive use of it afforded legal protection." (Petitioner's brief, p. 22.)

In *Rouss v. Winchester*, (300 F. 706) (Certiorari denied, 266 U. S. 607), the Court discussed this subject at length and said (p. 714):

"the fact that a geographic term has come to have a secondary meaning does not constitute it a valid trade-mark at common law."

We submit that the authorities establish, *without qualification*, that the doctrine of secondary meaning cannot be invoked to give to a descriptive word or term the effect of a technical trade-mark as distinguished from a trade-name. (See cases cited in Petitioner's Brief, pp. 18-21.)

The Trade-Mark Acts of the United States (both of 1905 and 1920, 41 Stat. 524, Sec. 4, Opinion p. 4, note 5), provide remedies only for infringement of a trade-mark—a technical trade-mark as distinguished from a trade-name. Where a descriptive word or term has acquired a secondary meaning, it results only in the acquisition of a trade-name. "An action based on unfair competition is the only remedy where a trade-name, as distinguished from a technical trade-mark is involved. (*Elgin Watch v. Illinois Watch Case Co.*, 179 U. S. 665, and cases cited in Petitioner's Brief, pp. 18-21.)

We respectfully submit, therefore, that the court's holding that "Nu-Enamel" is descriptive, and its decision that respondent is entitled to relief for its alleged *infringement* under the Trade-Mark Laws of the United States, are irreconcilable and contradictory, and that the latter

holding is in conflict with the previous decisions of this Court, and the universal holdings of the Circuit Courts of Appeals. We submit that it is also in conflict with the recent decision of this Court in *Kellogg Co. v. National Biscuit Co.* (decided November 14, 1938), where this Court held (p. 5) that if the words "shredded wheat" (descriptive of the product as is "Nu-Enamel" herein), had acquired a secondary meaning, that fact would have established the words "shredded wheat," not as a trade-mark, but only as a *trade-name*.

#### IV.

In its opinion herein, the Court says (p. 7):

*"It seems clear that the mark 'Nu-Enamel' is descriptive of a type of paint long familiar to manufacturers, with the addition of the adjective new, phonetically spelled or misspelled. Obviously this slight variation from the orthographic normal is not unusual. Numerous illustrations of such use by paint and varnish manufacturers are given by petitioner in its answer (brief)."* (Italics ours.)

This Court, therefore, confirms the finding of fact of the District Court that:

*"'Nu' was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of 'new' to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name 'Nu-Enamel.'"* (Opinion, p. 2; R. 108.)

We submit that the Court's holding that "Nu-Enamel" is a trade-mark, and that respondent has the exclusive right to the use of "Nu" with "Enamel" cannot be reconciled with the above finding and is in conflict with the previous decisions of this Court. We refer particularly

to *Hanover Milling Co. v. Metcalf*, 240 U. S. 403, 415, and *Columbia Mill v. Alcorn*, 150 U. S. 460, both cited in Petitioner's Brief, p. 25. In the latter case this Court said (464):

"The alleged trade-mark cannot, for many reasons, be made the subject of an exclusive private property. First, because it is clearly shown from the proof in the cause that the word 'Columbia,' as a brand upon sacks or barrels of flour, was in use long before its appropriation by the complainant."

The Court has apparently overlooked the above *material finding*, which it confirmed, and the decisions of this Court aforesaid, applicable thereto, which decisions the Court neither mentions nor distinguishes in its opinion herein.

We again quote the following words of counsel for respondent:

"The courts do not protect a trader in the use of things which are common to the trade, because being common to the trade, they cannot indicate commercial origin with any one producer." (Rogers "Good Will, Trade-Marks and Unfair Trading," p. 83.) (Petitioner's Brief, p. 25.)

We respectfully submit that in view of the above "Nu-Enamel" cannot become the exclusive property of respondent.

## V.

**As to the construction of Paragraph (b) of Section 5 of the 1905 Act incorporated in the 1920 Act.**

In discussing whether or not Section (b) of the 1920 Act. (which specifically incorporates paragraph (b) of Section 5 of the 1905 Act), prohibits the registration of descriptive marks, the Court in its opinion (referring to



*In re Chas. R. Long, Jr. Co.* (C. C. A. D. C.), 280 F. 975, 977), says (p. 9):

"A dictum<sup>o</sup> has expressed a view contrary to that of the Patent Office."

We submit that the view expressed in the *Long* case was not contrary to that of the Patent Office in that case. *It was the view of the Patent Office* and because of which the registrant therein appealed. It will be noted from a reading of the *Long* case (p. 976), that the Patent Office, holding that a descriptive word was not registerable under the 1920 Act, required the registrant therein "*to file a disclaimer of the descriptive word 'Stabrite.'*" We also respectfully submit that the Court's construction of the 1920 Act in the *Long* case was not a dictum but was a necessary part of its decision upholding the ruling of the Patent Office and in answer to appellant's contention therein.

The Court moreover, has apparently overlooked the construction, identical with that in the *Long* case, placed on the 1920 Act by the Circuit Court of Appeals for the 2nd Circuit in *Rouss v. Winchester*, 300 F. 706, 713, in which this Court denied certiorari (266 U. S. 607) (Petitioner's Brief, p. 17, Reply Brief, p. 7). The view thus expressed and the construction placed on the 1920 Act in that case were not dicta. They were necessary and essential to the decision therein, namely, that personal names and geographic and descriptive words were, under the construction contended for by the petitioner herein, *expressly barred from registration under the 1920 Act.*

We respectfully submit that the construction and interpretation placed on the 1920 Act by the Courts in *Rouss v. Winchester*, and *In re Chas. R. Long, Jr.*, should not be overthrown, but should be adopted here. Any other construction, involving as it does the deletion by a Court of an unambiguous portion of the Act, a deletion deter-

ained largely through conjecture from Committee discussions and correspondence, is, we submit, a strained and unreasonable one, a construction which does violence to clear and unambiguous language, and in our opinion, constitutes judicial legislation. If the Act is badly drawn, the remedy for its rectification lies with Congress and not with the Court.

We submit, therefore, that descriptive words like "Nu-Enamel" are not registerable under the 1920 Trade-Mark Act.

## VI.

### As to the issue of unfair competition.

In its opinion the court says (p. 12):

"The rights of Nu-Enamel Corporation to be free of the competitive use of 'Nu-Enamel' may be vindicated, also, through the challenge of unfair competition, as set out in the bill."

Petitioner has consistently maintained that the issue of unfair competition is not involved herein, because unfair competition is nowhere alleged in the bill—that the bill confines itself *in specific terms entirely* to the allegation of infringement of a registered trade-mark. No relief against unfair competition was prayed for. Unfair competition was, therefore, not raised as an issue herein and the court, therefore, had no jurisdiction over the issue of unfair competition, as the District Court held.

We are still of that opinion. Nowhere in the court's opinion is it pointed out that unfair competition was pleaded other than the court's statement that (p. 5),

"The facts supporting a suit for infringement and one for unfair competition are substantially the same. They constitute and make plain the wrong complained of, the violation of the right to exclusive use."

We submit that even in the light of the above pronouncement by the court, respondent cannot introduce evidence of facts other than those pleaded, and to the introduction of which evidence, petitioner objected on the trial hereof (R. 67). Because of petitioner's position on this point and which was adopted by the District Court, petitioner did not at the trial hereof attempt in any way to meet evidence introduced by the respondent on the issue of unfair competition. We submit, therefore, that even if the Court should deny petitioner's motion for a rehearing, and adhere to its present decision, this cause should be remanded with instructions to the District Court to hear evidence on the issue of unfair competition. Thereby only will petitioner be afforded an opportunity to meet the evidence on this issue introduced by the respondent.

We contend that there is no infringement, first, because as we have attempted to point out above (page 6), this case involves not a technical trade-mark, but a trade-name, and secondly, because petitioner did not use respondent's mark "Nu-Enamel" but used the words "Nu-Beauty" together with the word "Enamel" on the product commonly known as enamel. The only remedy available to respondent, if the Federal Court has jurisdiction, is for unfair competition, and not under the Trade-Mark Statutes. As the Court itself points out in its opinion (p. 5) "that jurisdiction should be continued to determine, on substantially the same facts, the issue of unfair competition."

## VII

**Practical consequences of the Court's opinion.**

Let us consider also the economic and practical consequences of the court's decision. In many industries, and in the paint industry in particular, as this Court recognizes in its opinion (p. 7), overlapping marks (such as "Nu") are the rule rather than the exception, and as the Court says (p. 7), "the mark 'Nu-Enamel' is *descriptive of a type of paint long familiar to manufacturers.*" In fact, as we pointed out in oral argument, the mark "Nu-Name!" had previously been used by a paint manufacturer in New Orleans where respondents commenced business. (Supplement to petitioner's brief, p. 37.)

If the court's decision is to stand, no manufacturer or dealer in enamels may use the word "Nu", for the Court has apparently held that "Nu-Enamel" is a valid trade-mark. We do not believe the Court intended such a far-reaching and drastic result. We do not believe that this Court intended to overrule and to disregard the long established fundamental rules enunciated by this Court and all other Federal courts relative to the limitations of monopolies on descriptive words and terms, and of words, terms and symbols which are common to an industry.

If, as this Court held in *Kellogg Co. v. National Biscuit Co.*, anyone may use the words "shredded wheat" because it is descriptive, it is difficult to comprehend that a seller of enamel may not describe his product as "Nu-Beauty" because a competitor has acquired a trade-name in the words "Nu-Enamel". Particularly does such a view seem drastic and contrary to all previous pronouncements by this Court in the light of the utter lack of similarity in

the color of the labels, type of print, and every other item constituting the respective labels of petitioner and respondent. We again reiterate what we stated in our brief (p. 34):

"An inspection of petitioner's and respondents' cans and labels clearly discloses that he would have to be an extremely careless person and color-blind, who would mistake and confuse the two. We submit that petitioner's cans of enamel bear no greater resemblance to respondents' cans, than do other cylindrical cans of enamel of the same size which may bear on their labels the word 'enamel'. If there are any isolated instances of confusion, as the Court said in *Richmond Remedies Co. v. Dr. Miles Medical Co.* 'such things will happen in the ordinary course of business, no matter how great the difference is.'"

The Court, in its opinion (p. 2) refers to the fact that respondent used its mark with the slogan "The coat of enduring beauty". Does the Court intend by its decision to imply that every word aptly describing the attributes and characteristics of paint may by user be appropriated to the exclusion of all other competitors? This the Court has apparently said as to the descriptive word "new" spelled, "Nu", as to the descriptive word "enamel" and as to the descriptive word "beauty". Why not as to every word on the label, including the directions for use? We put the above rhetorical question only to illustrate our contention that the court's apparent decision that "Nu-Enamel" can be appropriated as a valid trade-mark cannot be reconciled with the Court's holdings that "Nu-Enamel" is descriptive of the product, and that it has long been used in the paint industry.



## CONCLUSION.

It is submitted that since this Court found that the claims of the respondent do not rest upon any federal ground, because there was only a nullity upon which to base any federal ground, the District Court was clearly right in dismissing the bill. This conclusion squares precisely with the holding of this Court in *Hurn v. Oursler*, 229 U. S. 238, 248. Furthermore, the decision in the instant case on the point under discussion, overrules the opinions of this Court in *Leschen Rope Co. v. Broderick*, 201 U. S. 166, *Standard Paint Co. v. Trinidad Asphalt Co.*, 220 U. S. 446, and *Elgin Watch Co. v. Illinois Watch Co.*, 179 U. S. 665. Respectfully, it is submitted that the overruling of these decisions, in addition to many other like decisions of Circuit Courts of Appeals, opens the door to grave abuse. By registering a notoriously invalid trademark under the Act of 1920, and by calling two or three witnesses to prove secondary meaning, the registrant has in his power to compel the federal courts to determine his common law claims even though there is no diversity of citizenship.

We submit that in other respects the decision herein is a marked departure from and an abandonment of the previous decisions of this Court (even as recent as *Kellogg Co. v. National Biscuit Co.*), and of other federal courts. We submit that it is a decision which will profoundly affect not only the paint industry, but other industries in the United States as well, in that all marks in use for one year or more, regardless of their nature, may now apparently be registered under the 1920 Trade-Mark Act, which was passed only for the purposes of foreign registration, and substantial domestic rights asserted thereunder. If

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the Court is correct in its construction of the 1920 Act, it will no longer be necessary for any trade-mark to be registered under the 1905 Act, since all marks, regardless of whether they are descriptive, personal or geographic, may, after one year's use, be registered under the 1920 Act, and the registrant may under said Act, even for an alleged domestic infringement, have every remedy which he would have under the 1905 Act.\* We cannot believe that this Court intended such a result or consequence.

WHEREFORE, your petitioner prays that this petition for rehearing be granted and that the mandate of this Court be withheld pending the determination of the Court upon this petition, and for such further time as the Court may order if this petition be granted.

Respectfully submitted,

GEORGE A. CARPENTER,

GEORGE I. HAIGHT,

MOSES LEVITAN,

*Counsel for Petitioner.*

I, Moses Levitan, counsel for the above named petitioner, do hereby certify that the foregoing petition for rehearing of this cause is presented in good faith and not for delay.

MOSES LEVITAN,

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\* With the exception that the registrant would be required in the first instance to prove ownership of the mark.

# SUPREME COURT OF THE UNITED STATES.

No. 51.—OCTOBER TERM, 1938.

Armstrong Paint and Varnish Works,  
Petitioner,  
vs.  
Nu-Enamel Corporation, an Illinois  
Corporation, and Nu-Enamel Cor-  
poration, a Delaware Corporation.

On Writ of Certiorari to  
the United States Cir-  
cuit Court of Appeals  
for the Seventh Circuit.

[December 5, 1938.]

Mr. Justice REED delivered the opinion of the Court.

The Nu-Enamel Corporation, of Illinois filed its bill of complaint in a District Court of the United States in Illinois to enjoin the Armstrong Paint and Varnish Works, a corporation of the same state, from using in the sale of paints, varnishes and similar goods the words "Nu-Beauty Enamel" or any name including the words "Nu-Enamel" or other colorable imitation of plaintiff's registered trade-mark Nu-Enamel or otherwise infringing it; to require an accounting of profits, and to recover treble damages. Pending the litigation, the plaintiff sold its assets to the other respondent Nu-Enamel Corporation of Delaware but continued its own corporate existence. The purchaser was permitted to intervene.

The bill showed the registration by the plaintiff of Nu-Enamel under the Act of March 19, 1920, Trade-Mark 308,024, for mixed paints, varnishes, paint enamels, prepared shellacs, stains, lacquers, liquid cream furniture polishes and colors ground in oil. It set out that the name "Nu-Enamel" through wide use by plaintiff had come to mean "plaintiff and plaintiff's products only" and the "word 'Nu-Enamel' is a mark by which the goods of the plaintiff are distinguished from other goods of the same class." There were further allegations that defendant had adopted the name "Nu-Beauty Enamel" with full knowledge of prior and extensive use by plaintiff of "Nu-Enamel"; that as a result of defendant's use of the mark "Nu-Beauty Enamel", merchants passed off defendant's products for plaintiff's, and that the products of both manufac-

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turers were sold in interstate commerce. An exhibit showed that plaintiff used its mark with this slogan printed above it "The cost of enduring beauty."

Defendant admitted "that the name 'Nu-Enamel' has come to mean and is understood to mean, throughout the United States, including the State of Illinois and the City of Chicago, the plaintiff and plaintiff's products only, and the word 'Nu-Enamel' is a mark by which the goods of the plaintiff are distinguished from other goods of the same class"; denied the validity but not the fact or extent of the coverage of the registration; asserted "Nu-Enamel" was a descriptive and generic term and that it had adopted "Nu-Beauty" in connection with enamel and kindred products before it heard of the trade-mark or trade name "Nu-Enamel." Defendant answered specifically that it marketed only enamels under the designation "Nu-Beauty Enamel" and that it did not market paints and varnishes under this name. The jurisdiction of the court over the subject matter was denied.

The District Court made the following material findings of fact:

"1. Plaintiff and defendant at the time of the filing of the bill of complaint herein were and are now both citizens of the State of Illinois. The intervener, Nu-Enamel Corporation, is a corporation of the State of Delaware.

2. 'Nu' in 'Nu-Enamel', appearing on plaintiff's label, is a phonetic spelling or misspelling of the English word 'new' and means 'new'.

3. 'Enamel' is a common English word describing a paint which flows out to a smooth coat when applied and which usually dries with a glossy appearance, and has long been known as such in the paint industry and to the public in general.

4. 'Nu-Enamel' used in connection with paint or enamel sold by plaintiff means 'new enamel' and is a common and generic term descriptive of the product to which it is applied and of its new or recent origin.

5. 'Nu' was commonly used in the paint and other industries in combination with other words as a misspelling or phonetic spelling of 'new' to designate brands and kinds of enamel, paint and other commodities before plaintiff and its predecessors adopted the name 'Nu-Enamel.'"

It determined that "Nu-Enamel" was not a valid trade-mark under the Trade-Mark Acts or at common law and, having so determined, refused jurisdiction of unfair competition.



The Circuit Court of Appeals reversed.<sup>1</sup> That court held the trade-mark non-descriptive, valid and infringed. It was of the opinion that the mark had acquired a secondary meaning. It found that the petitioner's conduct enabled merchants to palm off the Armstrong product for "Nu-Enamel" and concluded that the District Court had jurisdiction of the issue of unfair competition. We granted certiorari on account of the importance in trade-mark law of the issues of the descriptive character of the mark and the effect of its acquired meaning under the Trade-Mark Act of 1920, — U. S. —.

As the petitioner concedes by answer that "Nu-Enamel" has acquired the meaning of respondent and respondent's products only and is a mark which distinguishes respondent's goods from others of the same class, no evidence or finding is needed to establish that fact. It may be noted, also, that the allegation of the use of "Nu-Beauty Enamel" by Armstrong on products other than enamels, fails of proof. Armstrong uses this mark on enamels only. On other products, there is the mark "Nu-Beauty," followed by some descriptive word, such as paint, varnish or brush.

*Federal Trade-Mark Act of 1920.* The registration of "Nu-Enamel" does not create any substantive rights in the registrant.<sup>2</sup> Trade-marks registered under the 1920 act may be attacked collaterally. *Kellogg Co. v. National Biscuit Co.*, 71 F. (2d) 662, 666. The act forbids the unauthorized use of the registered mark in foreign and interstate commerce and adopts the procedural provisions of the Trade-Mark Act of 1905.<sup>3</sup> Through the inclusion of these procedural sections the lower Federal courts are given original and appellate jurisdiction of "all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this Act, arising under the present Act" and this Court was given jurisdiction for certiorari "in the same manner as provided for patent cases."<sup>4</sup> Section nineteen of the 1905 act vesting

<sup>1</sup> 95 F. (2d) 448.

<sup>2</sup> *Kellogg Co. v. National Biscuit Co.*, Nos. 2 and 56, this term, decided November 14, 1938, advance sheet 4, note 3; *Charles Broadway Rouss, Inc. v. Winchester Co.*, 300 Fed. 706, 713, 714; *Sleight Metallic Ink Co. v. Joseph P. Marks*, 52 F. (2d) 664, on rights it is "as though there had been no registration," p. 665; *Neva-Wet Corp. v. Never Wet Processing Corp.*, 277 N. Y. 163, 13 N. E. (2d) 755, 759; *Slaymaker Lock Co. v. Reese*, 24 F. Supp. 69, 72.

<sup>3</sup> Trade-Mark Act of March 19, 1920, Section 6, 41 Stat. 535.

<sup>4</sup> Secs. 17 and 18, Fed. Trade-Mark Act of February 20, 1905, 33 Stat. 728-29; Secs. 5 and 6, Act of March 3, 1891, 26 Stat. 827-28; Sec. 240a of the Judicial Code confirms this jurisdiction. *Street & Smith v. Atlas Mfg. Co.*, 231 U. S. 348, 352. Cf. *Forsyth v. Hammond*, 166 U. S. 506, 513.

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power to grant injunctions in trade-mark cases is applicable to proceedings under the 1920 act. By section twenty-three former remedies in law and equity are left available. The significant distinction between the two acts is the omission in the 1920 act of provision of section sixteen of the earlier act making the registration of a trade-mark prima facie evidence of ownership.

On its face the act shows it was enacted to enable American and foreign users of trade-marks to register them in accordance with the provisions of the convention for the protection of trade-marks and commercial names, signed at Buenos Aires in 1910. In addition section one, paragraph (b), provides, without limitation on the export trade, for the registration of marks not registrable under section 5 of the Trade-Mark Act of 1905, after one year of use in interstate or foreign commerce. This enables the (b) marks to be registered abroad.

While the act of 1920 does not vest any new substantive rights, it does create remedies in the Federal courts for protecting registrations and authorizes triple damages for infringement.<sup>5</sup> As a consequence of these remedial provisions, when a suit is begun for infringement, bottomed upon registration under the 1920 act, the district courts of the United States have jurisdiction. Unquestionably unsubstantial, the allegation of registration under the act is sufficient to give jurisdiction of the merits. In this case the trial court concluded that the invalidity of the trade-mark did not divest it of jurisdiction over unfair competition. This was erroneous.<sup>6</sup> Once properly obtained, jurisdiction of the one cause of

<sup>5</sup> 41 Stat. 534, Sec. 4. "That any person who shall without the consent of the owner thereof reproduce, counterfeit, copy, or colorably imitate any trade-mark on the register provided by this Act, and shall affix the same to merchandise of substantially the same descriptive properties as those set forth in registration; or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use, or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff the court may enter judgment therein for a sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of the verdict, together with the costs."

<sup>6</sup> Although we determine later that "Nu-Enamel" is registrable under the 1920 act; it seems appropriate to discuss jurisdiction of unfair competition on a different assumption so that the conclusion of the trial court, corrected and not discussed by the appellate court, will not become a precedent on issue of jurisdiction in trade-mark law. Cf. *Hurn v. Oursler*, 289 U. S. 238, 240.

tion, the alleged infringement of the trade-mark, persists to deal with all grounds supporting it, including unfair competition with the marked article.<sup>7</sup> The cause of action is the interference with the exclusive right to use the mark "Nu-Enamel." If it is a properly registered trade-mark, a ground to support the cause of action is violation of the Trade-Mark Act. If it is not a properly registered trade-mark, the ground is unfair competition at common law. The facts supporting a suit for infringement and one for unfair competition are substantially the same. They constitute and make plain the wrong complained of, the violation of the right to exclusive use.

In the *Oursler* case there was a valid copyright which was held not infringed. Here the trial court determined the trade-mark was invalid. The *Oursler* case held that where the causes of action are different, the determination that the federal cause fails calls for dismissal.<sup>8</sup> But where there is only one cause of action we do not consider that the holding of the invalidity furnishes any basis for a distinction between this and the *Oursler* case. Registration of "Nu-Enamel" furnished a substantial ground for federal jurisdiction. That jurisdiction should be continued to determine, on substantially the same facts, the issue of unfair competition.<sup>9</sup>

*Registration of Descriptive Mark under 1920 Trade-Mark Act.* Even though under the facts alleged and the admission that respondent's mark has acquired a secondary meaning the Federal courts have jurisdiction to determine whether petitioner is chargeable with unfair competition, it becomes necessary to determine whether registration of "Nu-Enamel" is permissible or impermissible under the Act of 1920 in order that it may be known whether section four, the basis of the prayer in the bill for triple dama-

<sup>7</sup> *Hurn v. Oursler*, 289 U. S. 238.

<sup>8</sup> *Hurn v. Oursler*, 289 U. S. 238, 248.

<sup>9</sup> Two cases cited in the *Oursler* opinion deal with trade-marks: *Leschen Rope Co. v. Broderick Co.*, 201 U. S. 166, and *Elgin Watch Co. v. Illinois Watch Co.*, 178 U. S. 665. They are there treated as out of line with the cases holding that facts supporting substantial federal and non-federal questions give jurisdiction to federal courts. Both state categorically that without a lawfully registered trade-mark a federal court loses jurisdiction when the jurisdiction depends on the trade-mark act.

Where diversity of citizenship exists the issue does not arise. *Warner & Co. v. Lilly & Co.*, 265 U. S. 526. While the diversity is not made plain in the opinion it appears in the record. No. 32, 1923 Term, Vol. 13, Transcripts of Record 1689.

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ges, is applicable.<sup>10</sup> Section one (b) of the 1920 act permits registration of the marks used for one year in interstate commerce which were not registerable under the Act of 1905 "except those specified in paragraphs (a) and (b) of section 5" of the Act of 1905. That section is set out below.<sup>11</sup> The point raised is whether the phrase "except those specified in paragraphs (a) and (b) of section 5" of the 1905 act is effective to bar not only marks,

<sup>10</sup> See Note 5, *supra*.

When the trial court concluded the trade-mark was not registerable under the 1920 Act, it dismissed the bill which also sought damages for unfair competition. When the Circuit Court of Appeals concluded the trade-mark was registerable as non-descriptive, it declared that the issue of unfair competition was cognizable in the trial court. It does not appear whether the reason for this holding was because the mark was registerable or because it had acquired a secondary meaning, through extensive use. The lower court does not consider whether the bill alleges registration under the 1920 Act. If the mark is not descriptive it is registerable under the 1905 Act. A mark registerable under the 1905 Act is not registerable under the 1920 Act. <sup>16</sup> Trade Mark Reporter, 93, 530. The language of the 1920 Act permits registration only of marks communicated by the international bureau and those not registerable under the 1905 Act.

<sup>11</sup> "No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: *Provided*, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant: *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association not written, printed, impressed, or woven in some particular or distinctive manner, or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this subdivision of this chapter: *Provided further*, That no portrait of a living individual may be registered as a trade-mark except by the consent of such individual, evidenced by an instrument in writing, nor may the portrait of any deceased President of the United States be registered during the life of his widow, if any, except by the consent of the widow evidenced in such manner. *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States or with Indian tribes which was in actual and exclusive use as a trade-mark of

contra bonos mores, under (a) and marks, infra dignitatem, under (b) but also the following provisos, particularly the one concerned with descriptive words or devices.

It seems clear that the mark "Nu-Enamel" is descriptive of a type of paint long familiar to manufacturers,<sup>12</sup> with the addition of the adjective new, phonetically spelled or misspelled. Obviously this slight variation from the orthographic normal is not unusual. Numerous illustrations of such use by paint and varnish manufacturers are given by petitioner in its answer. The trade-mark is registered by the Nu-Enamel Corporation for a variety of products from enamels through paint brushes to glue, solder and tack rags. It is quite true that the mark is not descriptive as applied to many of respondent's products but the use by petitioner, the Armstrong Company, of which the Nu-Enamel Corporation complains is the use of "Nu-Enamel" or "Nu-Beauty Enamel." This use, Armstrong answers and the evidence supports the assertion, is confined to the enamels. We must therefore consider the case as though the

the applicant, or his predecessors from whom he derived title for ten years next preceding February 20, 1905: *Provided further*, That nothing herein shall prevent the registration of a trade-mark otherwise registerable because of its being the name of the applicant or a portion thereof. And if any person or corporation shall have so registered a mark upon the ground of said use for ten years, preceding February 20, 1905, as to certain articles or classes of articles to which said mark shall have been applied for said period, and shall have thereafter and subsequently extended his business so as to include other articles not manufactured by said applicant for ten years next preceding February 20, 1905, nothing herein shall prevent the registration of said trade-mark in the additional classes to which said new additional articles manufactured by said person or corporation shall apply, after said trade-mark has been used on said article in interstate or foreign commerce or with the Indian tribes for at least one year provided another person or corporation has not adopted and used previously to its adoption and use by the proposed registrant, and for more than one year such trade-mark or one so similar as to be likely to deceive in such additional class or classes." U. S. C. A., Title 15, § 85.

<sup>12</sup> "Enamel or Varnish Paint.—These types of paints dry with a brilliant glossy surface. They are made by grinding the selected pigment, or mixture of pigments, in a varnish medium, and their nature and properties depend on the type of varnish used. A quick-drying variety is made by using a cheap resin varnish as the vehicle, it dries with a high gloss surface in about 2-4 hours, but owing to the brittle and non-durable nature of the varnish used it is only suitable for interior use. High-class durable enamels, suitable for both inside and outside use, are made by using mixtures of heat-treated linseed oil (stand oil) and elastic copal varnishes as the vehicle. They are slow-drying, taking from 12-18 hours, and are very tough under the severest climatic conditions.

"Flat Paint.—This type of paint is really a flat-drying enamel. It is made in much the same way as the high class glossy enamels, except that it contains less varnish and more turpentine than ordinary enamel. Some varieties contain a proportion of wax dissolved in the varnish so as to give a more perfect mat or flat finish. Owing to their pleasing decorative effect they are used for interior decorations, but are not suitable for outside use." 17 Encyclopedia Britannica (14th Ed.) 35.



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only products of Nu-Enamel Corporation were enamels. As applied to them it is descriptive.

That the mark is descriptive of paint enamels does not bar it from registration as to them under the 1920 act. This has been the construction of the Patent Office.<sup>13</sup> To construe (b) of the 1920 act to bar names, descriptive marks and merely geographical terms would make the subsection useless. The obvious purpose of its in-

<sup>13</sup> *Wright Co. v. Sar-A-Lee Co.*, 328 Official Gazette 787, 788; *Postum Cereal Co. v. Cal. Fig Nut Co.*, 313 O. G. 454; Opinion of Solicitor, Interior Department, July 13, 1920, 277 O. G. 181, 182:

"In my opinion the recent act of March 19, 1920, as applied to register (b) therein provided should be construed as if it more specifically read as follows:

"All other marks not registerable under the act of February 20, 1905, as amended, except those specified as not registerable in paragraphs or schedules (a) and (b) of section 5 of that act, etc."

"This is the plain meaning of the law, as it was undoubtedly the intention to continue to deny registration to those marks prohibited registration by paragraphs or schedules (a) and (b) of section 5 of the act of February 20, 1905. In other words, my view is that register (b) provided by the recent act is not intended for any trade-mark registerable under any part of the act of February 20, 1905, nor for registration of any mark not registerable as specified in paragraphs or schedules (a) and (b) of section 5 of that act. The doubt will be relieved and a rational construction of the law will be subserved by considering the reference in the recent act to 'paragraphs (a) and (b)' of section 5 of the amended act of February 20, 1905, as meaning *schedules a and b* rather than paragraphs strictly and as comprising the following matters specified as not registerable, viz.:

"(a) Consists of or comprises immoral or scandalous matter.

"(b) Consists of or comprises the flag or coat-of-arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: *Provided*, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant."

"This was the evident intention, as shown by the congressional hearings on the recent act, and with such construction a field will exist for the operation of the new law; otherwise none would remain."

Rule 19 of the Rules of the Patent Office Governing Registration of Trade-marks, issued July 1, 1937, reads as follows:

"A trade-mark must have been actually used in commerce before an application for its registration can be filed in the Patent Office.

"No trade-mark will be registered . . . under the act of February 20, 1905, which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term . . . No trade-mark will be registered under section 1(b), act of March 19, 1920, which is registrable under the act of February 20, 1905, as amended, or which has not been in *bona fide* use as a trade-mark for one year in international or interstate commerce or commerce with Indian tribes."

clusion was to widen the eligibility of marks. A dictum has expressed<sup>14</sup> a view contrary to that of the Patent Office.

This administrative interpretation, contemporary with the legislation, and the legislative history have weight "when choice is nicely balanced."<sup>15</sup> We construe section 1(b) of the 1920 act to be applicable to the categories expressed in Section 5 of the Act of 1905 under (a) and (b) including the first proviso but not to include the other provisos of (b). This conclusion is fortified by the addition of the proviso to section one (b) of the 1920 act, relating to identical trade-marks. The proviso in section 5(b) of the 1905 act refusing registration to identical marks in much the same language was construed in *Thaddeus Davids Co. v. Davids*, 233 U. S. 461, as not permitting the registration of such marks when used for ten years under the fourth, now fifth, proviso of that section. We

<sup>14</sup>In re Chas. R. Long, Jr., Co., (C. C. A., D. C.) 280 F. 975, 977.

<sup>15</sup>*Fox v. Standard Oil Co.*, 294 U. S. 87, 96.

On January 21 and 22, 1920, the Committee on Patents of the House of Representatives was considering H. R. 7157 of the 66th Congress, 2nd Session, a bill to amend section 5 of the Trade-Mark Act of 1905. The Commissioner of Patents discussed with the Committee an amendment applicable to H. R. 9023 of the 66th Congress entitled "A bill to give effect to certain provisions of the convention for the protection of trade-marks." The applicable language is as follows:

"Mr. Newton. Yes. The amendment we propose is this:

"All other marks not registerable under the act of February 20, 1905 (as amended), but which for not less than two years have been bona fide used in interstate or foreign commerce, or commerce with Indian tribes, by the proprietor thereof, upon or in connection with any goods of such proprietor and upon which the fee of \$10 has been paid and such formalities as are prescribed by the Commissioner of Patents have been complied with, may be registered."

"Anything may be registered. That is an amendment to the bill that was passed yesterday. That bill does not give prima facie validity to the mark that is registered, the bill that passed yesterday, and this amendment does not give it. That is the reason we put this proposed amendment into the bill. But Mr. Merritt's bill wants to give them prima facie evidence of ownership, so we put that under the 1905 statute where it naturally belongs." Hearings on H. R. 7157 before the Committee on Patents, 66th Congress, 2d Session, p. 30.

Later in the hearing on the bill which became the act of March 19, 1920, this discussion was continued by Mr. Whitehead, Assistant Commissioner of Patents, who discussed the Commissioner's suggested language quoted above and said:

"One or two slight amendments ought, it seems to me, to be made to the bill. The bill as it stands is broad enough to put any mark on the register. Section 5 of the act of February 20, 1905, outlaws—if I may use that expression—two classes of marks—one, scandalous and immoral marks, and the other marks consisting of the flag or coat of arms of the United States, etc., and it seems as if this Senate amendment ought to be amended to exclude those marks specified in paragraphs (a) and (b) of that section. Otherwise there can be put on the register scandalous marks and the flag of the United States. I think it must have been overlooked. I do not think Mr. Merritt or Mr. Newton thought that they were including those two types of marks. It seems as if that could be accomplished by inserting in the amendment, after the

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think that Congress in adopting the corresponding proviso in subsection (b) of the 1920 act, must be taken to have adopted the accepted construction of the similar proviso of the 1905 act. If the language of the 1920 act had been intended to exclude from registration all the classes excluded by the provisos of section five of the 1905 act, it would have been unnecessary to include this proviso.<sup>16</sup>

This Court has had several occasions within the last few years to construe statutes in which conflicts between reasonable intention and literal meaning occurred. We have refused to nullify statutes, however hard or unexpected the particular effect, where unambiguous language called for a logical and sensible result.<sup>17</sup> Any other course would be properly condemned as judicial legislation. However, to construe statutes so as to avoid results glaringly absurd, has long been a judicial function.<sup>18</sup> Where, as here, the language is susceptible of a construction which preserves the usefulness of the section, the judicial duty rests upon this Court to give expression to the intendment of the law.

*Remedies.*<sup>19</sup> Registration under the 1920 act conferred no substantive rights in the registered mark but it does permit suits in the Federal courts to protect rights otherwise acquired in the marks. The 1905 act, section one, authorizes the "owner" to obtain registration of eligible trade-marks; section two requires the applicant to make oath that he "believes himself . . . to be the owner of the trade-mark"; section five refers to the "owner of the

words 'all other marks not registerable under the act of February 20, 1905,' the words, 'except those specified in paragraphs (a) and (b) of section 5 of that act,' or words to that effect."

After discussion of other matters:

"The Chairman. If you will in your brief just make those suggestions, we will be glad to take them up with the conferees.

"Mr. Whitehead. I will be glad to do that. I think the only really important one is to exclude those of paragraphs (a) and (b) of section 5. These others are minor matters." Hearings on H. R. 9023 before the Committee on Patents, 66th Congress, 2nd Session, Part 2, pp. 33-35.

The precise language adopted came from the conference report. Congressional Record, 66th Congress, 2nd Session, p. 4160.

<sup>16</sup> The variations between the two provisos have been treated in practice as immaterial. 277 O. G. 181, 182. Cf. *Thaddeus Davids Co. v. Davids*, 233 U. S. 461, 467.

<sup>17</sup> *Caminetti v. United States*, 242 U. S. 470, 485; *Crooks v. Harrelson*, 232 U. S. 55, 58-59; *Taft v. Commissioner*, 304 U. S. 351, 359.

<sup>18</sup> *Sorrells v. United States*, 287 U. S. 435, 446, *et seq.* and cases cited; *United States v. Ryan*, 284 U. S. 167.

<sup>19</sup> Since neither party has relied upon state law, we do not consider any effect it might have on our conclusions. Cf. *Kellogg v. National Biscuit Co.*, Nos. 2 and 56, this term, decided November 14, 1938.

mark"; section sixteen then declares "that the registration of a trade-mark under the provisions of this Act shall be prima facie evidence of ownership"; section 23 reserves all remedies at law or in equity which any party aggrieved by the wrongful use of his trade-mark would have had without the Act of 1905.

The 1920 act omits the quoted portion of section sixteen as to the effect of registration as prima facie evidence of ownership. Under section one the register includes all marks communicated to the Commissioner of Patents by the international bureaus provided for by the Buenos Aires convention of 1910 and all other marks not registerable under the Trade-Mark Act of 1905, with the exceptions discussed in the preceding section of this opinion, in bona fide use by the proprietor thereof for one year in commerce other than intrastate. Section four,<sup>20</sup> which protects the trade-mark, is substantially the same as section sixteen of the 1905 act, except for the omission of the prima facie presumption of ownership. It is the owner who has the rights of action under this act, unaided by any presumption from registration. The owner, on the other hand, is not limited in any way by the act, as section 23 of the Act of 1905 is made specifically applicable. This section preserves the legal and equitable remedies to an aggrieved owner. The Committee on Patents in the Senate was quite positive that the effect of the act on domestic rights was nil.<sup>21</sup> The registrant acquires by the acceptance of his mark under the 1920 act the right to proceed in the Federal courts against infringers and to recover triple damages if he can establish his ownership of the trade-mark at common law.

"Nu-Enamel" is descriptive of the enamels in issue. The use on the numerous other articles of respondent's manufacture, in its advertising, on store window valances, on electric and other displays, and as the name of many stores and the sign of several thousand dealers, justify petitioner's concession that the name

<sup>20</sup> See Note 5, *supra*.

<sup>21</sup> "This legislation has no effect on the domestic rights of anyone. It is simply for the purpose of enabling manufacturers to register their trade-marks in this country for the purpose of complying with legislation in foreign countries, which necessitates registration in the United States as a necessary preliminary for such foreign registration. As the law now stands, it enables trade-mark pirates in foreign countries to register as trade-marks, the names and marks of the American manufacturers, and thus levy blackmail upon them." Senate Report No. 432, 66th Congress, 2nd Session, p. 2. Cf. *Charles Broadway Rouss, Inc. v. Winchester Co.*, 300 Fed. 706, 714.

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means respondent and respondent's products only and the word distinguishes its goods from others of the same class. But a mark which is descriptive is not a good trade-mark at common law.<sup>22</sup>

It was said in *Thaddeus Davids Co. v. Davids*<sup>23</sup> that names registered under the last proviso of section 5 of the 1905 act became technical trade-marks upon valid registration under that act. Assuming that descriptive terms in this respect would be analagous to proper names, there are clear distinctions between the acts. The 1920 act does not define "trade-mark" to include any mark registered under its terms, as does section 29 of the 1905 act. Remedies are afforded registrants under the 1920 act but these remedies are for "owners," and actual and exclusive use, short of a secondary meaning,<sup>24</sup> does not qualify a registrant under the 1920 act as an owner. That ownership must be established by proof.<sup>25</sup> Unless this ownership is established, no rights of action under the 1920 act for infringement exist. Here we have a secondary meaning to the descriptive term, "Nu-Enamel." This establishes, entirely apart from any trade-mark act, the common law right of the Nu-Enamel Corporation to be free from the competitive use of these words as a trade-mark or trade name.<sup>26</sup> As was pointed out in the *Davids* case, in considering the ten-year clause of the 1905 act, this right of freedom does not confer a monopoly on the use of the words. It is a mere protection against their unfair use as a trade-mark or trade name by a competitor seeking to palm off his products as those of the original user of the trade name. This right to protection from such use belongs to the user of a mark which has acquired a secondary meaning. He is, in this sense, the owner of the mark. We agree with the conclusion of the Circuit Court of Appeals that infringement is shown.

The rights of Nu-Enamel Corporation to be free of the competitive use of "Nu-Enamel" may be vindicated, also, through the

<sup>22</sup> *Warner & Co. v. Lilly & Co.*, 265 U. S. 526, 528; *Standard Paint Co. v. Trinidad Asphalt Co.*, 220 U. S. 446, 453; *Elgin Nat. Watch Co. v. Illinois Watch Co.*, 179 U. S. 665, 673.

<sup>23</sup> 233 U. S. 461, 466, 468, 469, 470.

<sup>24</sup> Cf. *Standard Paint Co. v. Trinidad Asphalt Co.*, 220 U. S. 446, 461. The language in that case, denying to a descriptive term the effect of a trade-mark, is inapplicable for the reason that the descriptive term had not acquired a secondary meaning.

<sup>25</sup> Cf. *Charles Broadway Rouss, Inc. v. Winchester Co.*, 300 Fed. 706, 713.

<sup>26</sup> *Thaddeus Davids Co. v. Davids*, 233 U. S. 461, 470, 471.



challenge of unfair competition, as set out in the bill. The remedy for unfair competition is that given by the common law. The right arises not from the trade-mark acts but from the fact that "Nu-Enamel" has come to indicate that the goods in connection with which it is used are the goods manufactured by the respondent. When a name is endowed with this quality, it becomes a mark, entitled to protection. The essence of the wrong from the violation of this right is the sale of the goods of one manufacturer for those of another.<sup>27</sup>

The questions as to damages, profits, and the form of the decree will be passed upon more appropriately by the trial court. The decree of the Circuit Court of Appeals reversing the decree of the District Court is affirmed and this cause is remanded to the District Court with directions to proceed in conformity with the opinion of this Court.

*It is so ordered.*

A true copy.

Test:

*Clerk, Supreme Court, U. S.*

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<sup>27</sup> *Elgin Nat. Watch Co. v. Illinois Watch Co.*, 179 U. S. 665, 674.

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